TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1907.

No. 210.

GLOBE NEWSPAPER COMPANY, PLAINTIFF IN ERROR,

vs.

GEORGE H. WALKER AND OSCAR W. WALKER, CO-PARTNERS, DOING BUSINESS UNDER THE FIRM NAME AND STYLE OF GEORGE H. WALKER & COMPANY.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF MASSACHUSETTS.

FILED JANUARY 25, 1907.

(20,544.)

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INDEX.

	Original.	Print.
Writ of error	1	1
Return on writ of error	2	2
Transcript of record No. 1412, law docket	3	2
Court and title of cause	3	2
Writ	3	2
Officer's return on writ	4	3
Plaintiff's declaration	5	4
Demurrer	8	5
Plaintiff's bill of exceptions	10	6
Judgment	10	6
Opinion	12	7
Transcript of record No. 37, law docket	21	11
Court and title of cause	21	12
Mandate	22	12
Answer	24	13
Motion to dismiss	28	16
Motion that court direct jury to render verdict for defendant on ground that court has no jurisdiction, etc	28	16

JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., JUNE 17, 1907.

	Original.	Print
Motion that court direct jury to render verdict for defendant on ground that court has no jurisdiction to assess profits, etc	29	16
Motion that court direct jury to render verdict for defendant on ground that court has no jurisdiction, etc	29	16
Motion that court direct jury to render verdict for defendant on ground that upon the evidence submitted the plaintiff's copyrighted map is invalid	29	17
Motion that court direct jury to render verdict for plaintiffs for nominal damages only, etc	30	17
Motion that court direct jury to render verdict for defendant on ground that court has no jurisdiction, etc	30	17
Verdict	31	18
Defendant's bill of exceptions	31	18
Exhibit A—Declaration	35	20
Motion for judgment	38	21
Judgment	38	21
Petition for writ of error	39	22
Order on petition for writ of error	40	22
Bond on writ of error	41	23
Citation on writ of error	42	24
Acknowledgment of service on citation on writ of error	43	24
Clerk's certificate	44	24

1 *Writ of Error.*

UNITED STATES OF AMERICA, *ss:*

[Seal of the Circuit Court, Massachusetts.]

The President of the United States to the Honorable the Judges of the Circuit Court of the United States for the District of Massachusetts, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Circuit Court, before you, between George H. Walker of Needham, in the County of Norfolk, in the Commonwealth of Massachusetts, and Oscar W. Walker of Newton Centre, in the County of Middlesex, in said Commonwealth, copartners doing business under the firm name and style of George H. Walker and Company, and having their usual place of business in Boston, in the District of Massachusetts, plaintiffs, and the Globe Newspaper Company, a corporation duly organized and established under the laws of the Commonwealth of Massachusetts, and having an usual place of business in Boston, in said District of Massachusetts, defendant, in an action of tort, a manifest error hath happened, to the great damage of the said defendant, as by its complaint appears. We being willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same at the city of Washington, D. C., on the *first day of February next, in the said Supreme Court, to be then and there held, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done herein to correct that error, what of right, and according to the laws and customs of the United States, should be done.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the third day of January, in the year of our Lord one thousand nine hundred and seven.

L. C. TUCKER,
Deputy Clerk of the Circuit Court of the United States, District of Massachusetts.

Allowed by
FREDERIC DODGE,
U. S. District Judge.

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*Not exceeding 30 days from the day of singing the citation. Rule 14, Sec. 5.

2 *Return of Circuit Court on Writ of Error.*

Circuit Court of the United States, District of Massachusetts, *ss.*

And now, here, the Judges of the Circuit Court of the United States, in and for the District of Massachusetts, make return of this writ by annexing hereto and sending herewith, under the seal of the said Circuit Court a true and attested copy of the record and proceedings in the suit within mentioned, with all things concerning the same, to the Supreme Court of the United States, as within commanded.

In Testimony Whereof, I, L. C. Tucker, Deputy Clerk of said Circuit Court of the United States, in and for the District of Massachusetts have hereto set my hand and the seal of said Court this twenty third day of January, A. D. 1907.

[Seal of the Circuit Court, Massachusetts.]

L. C. TUCKER,
Deputy Clerk.

3 *Transcript of Record of Circuit Court.*

UNITED STATES OF AMERICA,
District of Massachusetts, ss:

At a Circuit Court of the United States for the First Circuit begun and holden at Boston within and for the District of Massachusetts on the third Tuesday of October, being the eighteenth day of October, in the year of our Lord one thousand nine hundred and four.

Before the Honorable Francis C. Lowell, Circuit Judge.

No. 1412, Law Docket.

GEORGE H. WALKER ET AL., Plaintiffs,
v.
GLOBE NEWSPAPER COMPANY, Defendant.

Writ.

(Filed Dec. 16, 1903.)

MASSACHUSETTS DISTRICT, *ss:*

[L. S.] The President of the United States of America to the Marshal of our District of Massachusetts or his deputy, Greeting:

We command you to attach the goods or estate of the Globe Newspaper Company, a corporation duly organized and established
4 under the laws of the Commonwealth of Massachusetts, and having an usual place of business in Boston in the County

of Suffolk, in our District of Massachusetts, to the value of Three thousand dollars, and summon the said defendant (if it may be found in your District) to appear before our Judges of our Circuit Court of said United States, for the First Circuit, next to be holden at Boston, within and for our said District of Massachusetts, on the third Tuesday of October next: Then and there in our said Court to answer unto George H. Walker of Needham in the County of Norfolk, said Commonwealth, and Oscar W. Walker of Newton Centre in the County of Middlesex, said Commonwealth, co-partners and doing business under the firm name and style of George H. Walker and Company and having their usual place of business in said Boston, plaintiffs.

In an action of tort.

To the damage of the said plaintiffs as they say, the sum of Three thousand dollars, which shall then and there be made to appear, with other due damages. And you have there this writ, with your doings therein.

Witness, The Honorable Melville W. Fuller, Chief Justice of the United States, at Boston, the twenty-sixth day of September, in the year of our Lord one thousand nine hundred and three.

BENJ. H. BRADLEE,
Deputy Clerk.

Return on Writ.

UNITED STATES OF AMERICA, *Massachusetts District, ss:*

BOSTON, *September 30th*, 1903.

Pursuant hereunto I have this day attached a chip as the property of the within named defendant corporation, and afterwards on the same day I summoned the said defendant corporation to appear at court as herein directed by giving in hand at Boston, to William O. Taylor, Assistant Treasurer of said defendant corporation, an original summons to this writ.

J. H. WATERS,
Deputy United States Marshal.

Fees.

Service	$2.00
Travel	.12
	$2.12

This cause was entered late by agreement of parties and was duly entered at the October Term of this court, A. D. 1903, when and where the parties appeared by their respective attorneys.

At the entry of said cause the following Plaintiffs' Declaration was filed:

Plaintiffs' Declaration.

(Filed Dec. 16, 1903.)

And the plaintiffs say that they are citizens of the United States and residents of the Commonwealth of Massachusetts; that they are the authors, designers, inventors or proprietors of a certain map known as "Map of the Electric Railways of the State of Massachusetts, Accompanying the Report of the Railroad Commissioners, 1899;" that before the publication of said map and for the purpose of copyrighting the same, the plaintiffs in conformity with the provisions of the Revised Statutes of the United States on the twenty-sixth day of February, A. D. 1900, deposited in the office of the Librarian of Congress at Washington in the District of Columbia,
6 a printed copy of the title of said map for which they demanded a copyright and that they also not later than the date of the publication thereof, to wit, on the tenth day of March, A. D. 1900, deposited in the mail within the United States, addressed to the Librarian of Congress at Washington in the District of Columbia, two complete copies of such map, of the best edition issued, and at the time of the mailing of such printed copies of said map they forwarded to said Librarian of Congress at Washington in the District of Columbia, the sum of fifty cents for recording the title of said map, and that said Librarian of Congress did record said title of said copyrighted map in a book kept for that purpose as required by Section 4597 of the Revised Statutes of the United States; that the plaintiffs gave notice of their copyright of said map entitled "Map of the Electric Railways of the State of Massachusetts, Accompanying the Report of the Railroad Commissioners, 1899" by printing and inscribing upon some portion of the face or front of each of the several copies of the said map "Copyrighted by Geo. H. Walker & Co., Boston;" that the plaintiffs complied with all the conditions and provisions of the Revised Statutes of the United States in such cases made and provided as aforesaid and thereby obtained a copyright of the United States for said map in due form of law and there was granted and secured to them and they had sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending for the term of twenty-eight years from the time of recording the title by the Librarian of Congress as above set forth.

That the defendant is a corporation organized under the laws of the Commonwealth of Massachusetts and having its usual place of
7 business at Boston in said Commonwealth; that the defendant well knowing the premises and the rights so secured to the plaintiffs and without the consent of the plaintiffs (the proprietors of said copyright) first obtained in writing signed in the presence of two or more witnesses and within two years before the commencement of this action and after the recording of the title of said map as aforesaid, did engrave, etch, work, copy, print, publish, or import either in whole or in part copies of said map en-

titled as aforesaid and knowing the same to be so printed, published or imported did sell and expose to sale a large number of copies of said map, contrary to the statute in such cases made and provided and contrary to Section 4952 of the Revised Statutes of the United States, and did on or about the eighth day of June, A. D. 1903, engrave, etch, work, copy, print, publish or import in whole or in part and sold or exposed for sale a very large number of the copies in whole or in part of said map, to wit, Two Hundred Thousand, and thereby unlawfully, wrongfully and injuriously deprived the plaintiffs of the rights secured to them as aforesaid and the gain and profits which they might and otherwise would have derived from the publication and sale of the copies of said map.

By reason of all which the plaintiffs were deprived of the benefits from the publication and sale of the copies of said map and were otherwise greatly injured and damaged.

By Their Attorney, H. L. BOUTWELL.

8 At the same term the following Demurrer was filed:

Demurrer.

(Filed Jan. 11, 1904.)

The Demurrer of the Globe Newspaper Company, Defendant, to the Declaration of George H. Walker, the above named Plaintiff.

The defendant, the Globe Newspaper Company, comes by its attorney and demurs to the declaration of the plaintiff in this case, and for causes of demurrer shows:

I. That the statutes relating to copyrights provide no remedy by a civil action on behalf of the owner of the copyright of a map.

II. That the declaration confuses two separate and distinct causes of action, neither of which is authorized by the statutes relating to the copyright of maps.

III. That the declaration contains no allegation that any copy or copies of the alleged infringing map complained of was or were found in the possession of the defendant.

IV. That the declaration contains no allegation that the alleged infringing map complained of, or any copy thereof, was published with the knowledge or consent of the defendant, or any of its officers, or with any intent to evade the statutes for the protection of the copyright for a map.

V. That the alleged copyright is invalid and void on its face and in violation of the express inhibition of the statutes as to government publications, as by reference to 28 Statutes at Large, p. 608, relating to copyrights, will more fully and at large appear.

9 VI. That the declaration contains no allegation that the alleged author of the alleged copyrighted map made the said map from any data or information worked out or collected by him.

VII. That the allegations of the declaration are irregular and in-

sufficient to support any claim for a valid or legal copyright, or any claim against this defendant whatever.

VIII. That the declaration fails to set out any cause of action whatever.

Wherefore, this defendant demurs and prays judgment of the court on each and all the grounds of demurrer herein taken.

GLOBE NEWSPAPER COMPANY,
By WILLIAM QUINBY, *Its Attorney.*

This cause was thence continued to the February Term, A. D. 1904, when the same came on to be heard and was fully heard by the court, on demurrer, the Honorable Clarence Hale, District Judge for the District of Maine, duly assigned to hold said Circuit Court, sitting.

On the twenty-fifth day of May, A. D. 1904, the Opinion of the Court was announced sustaining the demurrer, and adjudging the declaration insufficient at law.

This cause was thence continued to the present October Term A. D. 1904, when the following Plaintiffs' Bill of Exceptions is filed and allowed by the court:

10 *Plaintiffs' Bill of Exceptions.*

(Filed and allowed Nov. 16, 1904.)

In the above entitled case the following proceedings were had:

The plaintiffs filed their declaration December 16, 1903. To the said declaration of the plaintiffs the defendant demurred. The case came on to be heard the seventeenth day of May, A. D. 1904, before Hon. Clarence Hale, District Judge, and was fully argued by counsel. Upon consideration whereof the court on the twenty-fifth day of May, A. D. 1904, sustained said demurrer of the defendant, adjudging the said declaration to be insufficient at law. To this ruling sustaining the said demurrer, etc., the plaintiffs except and pray that their bill of exceptions may be allowed.

By Their Att'ys, BOUTWELL & HASTINGS.

Nov. 16, 1904.

Exceptions allowed.
CLARENCE HALE,
District Judge.

Also on the sixteenth day of November, A. D. 1904, the following Judgment is entered:

Judgment.

November 16, 1904.

It is thereupon considered by the court, to wit, Nov. 16, 1904, the Honorable Clarence Hale, District Judge for the District of Maine, duly assigned to hold said Circuit Court sitting, that the said George

H. Walker and Oscar W. Walker, plaintiffs, take nothing by their said writ, and that the said Globe Newspaper Company, defendant, recover of the said plaintiffs its cost of suit taxed at ——

11 A Writ of Error to the United States Circuit Court of Appeals for the First Circuit was thereupon sued out by the plaintiffs.

A true record:

Attest:

ALEX. H. TROWBRIDGE, *Clerk.*

12 Circuit Court of the United States, District of Massachusetts.

No. 1412, Law Docket.

GEORGE H. WALKER ET AL.
v.
GLOBE NEWSPAPER COMPANY.

Opinion of the Court.

May 25, 1904.

HALE, *J.:*

This case comes before the court on the defendant's demurrer to the plaintiffs' declaration. That declaration charges infringement of the plaintiffs' copyrighted map, known as "Map of the Electric Railways of the State of Massachusetts, Accompanying the Report of the Railway Commissioners, 1899;" under this declaration the plaintiffs seek to recover damages for an invasion of their copyright; they do not seek a forfeiture and penalty under section 4965 of the Revised Statutes of the United States.

The defendant sets out eight causes of demurrer: The vital question raised by demurrer is stated in the first ground: "That the statutes relating to copyrights provide no remedy by civil action on behalf of the owner of the copyright of the map."

The plaintiffs admit that section 4965, relating to copyrights, does not give any action for damages for the piracy of any map or any other article therein mentioned; that section 4964 provides such remedy only in case of books; that this form of action is not

13 expressly given by the statutes of the United States relating to copyrights. But the plaintiffs urge with great force and ability, that where a right, previously existing by the common law, is secured by a statute which provides no remedy for its protection, common law remedies are available. They insist upon the application of the rule that their ordinary common law remedy is not taken away because a special one is given by the statute. Plaintiffs' declaration is drawn, then, for the purpose of enforcing their common law rights. The question is thus brought clearly before the court whether they have any rights under the common law. The plaintiffs found their right of recovery under a common law declaration upon principles laid down by the English courts. They urge that

the statute of 8 Anne was a law similar to our copyright law in this respect, that it enacted that an author should have the sole right and liberty of printing his book for a limited number of years, and then affixed penalties for transgressing the law; that the act therefore vested property in literary works in the author for a limited period; and that it provided penalties for those who infringed the property; but plaintiffs urge that in addition to these statute penalties, the courts of England allowed an action on the case for damages, on the ground that the law confers no right without a remedy to enforce it; and that, while forfeitures and penalties were provided for by the act, the provision for such forfeitures and penalties did not prevent an injured author, whose copyright had been infringed, from having damages at the common law. Plaintiffs base their contention largely upon Beckford *v.* Hood, 7 T. R. 620, in which Lord Kenyon, in an elaborate and famous decision, supported the common law rights under an infringed copyright. Lord Kenyon said: "Then,
14 the statute having vested the right in the author the common law gives the remedy by action on the case for the violation of it. Of this there could have been no doubt made, if the statute had stopped there. But it has been argued that, as the statute in the same clause that creates the right has prescribed a particular remedy, that and no other can be resorted to. And if such appeared to have been the intention of the Legislature, I should have subscribed to it however inadequate it might be thought.

But their meaning in creating the penalties in the latter part of the clause in question certainly was to give an accumulative remedy; nothing could be more incomplete as a remedy than those penalties alone; for without dwelling upon the incompetency of the sum, the right of action is not given to the party aggrieved, but to any common informer.

I cannot think that the Legislature would act so inconsistently as to confer a right and leave the party whose property was invaded without redress. * * * On the fair construction of this act therefore I think it vests the right of property in the authors of literary works for the times therein limited, and that consequently the common law remedy attaches if no other be specifically given by the act."

The learned counsel for the plaintiffs urges that all the reasoning of Lord Kenyon in this famous decision applies in full force to the common law rights of an author under section 4965 of the Revised Statutes of the United States. It is clear that our copyright law provides a remedy by civil action to the owner of the copyright of a book, but does not provide any remedy in favor of the owner
15 of the copyright of a map, under section 4965. Section 4964 provides that a person who infringes the copyright in a book shall forfeit every copy of his offending publication, "and shall also forfeit and pay such damages as may be recovered in a civil action." But section 4965 has no such provision. The portion of this section which is important in this case reads as follows: "If any person, after the recording of the title of any map, chart, dramatic or musical composition, print, cut, engraving, or photograph, or chromo, or of

the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts, as provided by this act, shall, within the term limited, contrary to the provisions of this act, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, engrave, etch, work, copy, print, publish, dramatize, translate, or import, either in whole or in part, or by varying the main design, with intent to evade the law, or, knowing the same to be so printed, published, dramatized, translated, or imported, shall sell or expose to sale any copy of such map or other article, as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied, and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale; and in case of a painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his possession, or by him sold or exposed for sale." It will be observed that this section provides for no action of damages, but provides for the forfeiture of every sheet of the offending map,
16 chart, or drawing, and for the further forfeiture of one dollar for every sheet of the same found in the possession of the infringer; and this is the sum of all the relief provided by Congress for the infringement of a copyrighted map.

This section has been repeatedly before the courts. It is a penal statute and must receive a strict interpretation. This has been decided many years ago in Backus *v.* Gould, 7 Howard 798. In construing this statute in Sarony *v.* Ehrich, 28 Fed. Rep. 80, Judge Coxe said: "No authority has been cited to sustain the proposition that when the piratical prints are out of the possession and beyond the control of the infringer the proprietor of the copyright can recover of him their value in an action at law. It would require an exceedingly strained construction, almost a distortion of the act, to make it fit the present circumstances. It is no answer to say that the remedy provided by law is ineffective; that the wrong-doer may escape the consequences of his infringement; that the opportunity for redress diminishes in proportion to the success of the infringement, and ceases wholly when the wrong is fully consummated. These arguments might, with great propriety, be addressed to the law making power, and Congress could, perhaps, be induced to render effectual, by a few simple amendments, provisions, which, in their present form, are so obviously defective and inadequate. With these considerations, however, the courts have nothing to do. They must deal with the law as it is, not as it ought to be."

In Bolles *v.* Outing Company, 175 United States 262, the Supreme Court held that in an action under this statute to recover the penalty of one dollar provided for every copy of engraving
17 or photograph infringing the copyright of another, the plaintiff's recovery is limited to copies actually found in the possession of the defendant and does not extend to copies sold and put in circulation. In that very recent case the whole body of American law is reviewed.

But the learned counsel for the plaintiffs contends that, under the reasoning of Lord Kenyon in the English court, upon the statute of Anne, the rights of the plaintiffs, being secured by the statute which provides no adequate remedy, the common law remedies are available. The vital and conclusive answer to enforcing this proposition in the federal courts is, that there is no common law of the United States. In the famous case, Wheaton *v.* Peters, 33 United States 591, which is the leading and controlling case upon this whole subject, it is held, in construing the copyright law, that while a man is entitled to the fruit of his own labors, he can enjoy them only, except by statutory provision, under the rules of property which regulate society. Mr. Justice McLean, speaking for the Supreme Court, at page 657, said: "But if the common law right of authors were shown to exist in England, does the same right exist, and to the same extent, in this country? It is clear, there can be no common law of the United States. The federal government is composed of twenty-four sovereign and independent states; each of which may have its local usages, customs and common law. There is no principle which pervades the Union and has the authority of law, that is not embodied in the constitution or laws of the Union. The common law could be made a part of our federal system, only by legislative adoption. * * *

18 The question respecting the literary property of authors was not made a subject of judicial investigation in England until 1760; and no decision was given until the case of Millar *v.* Taylor was decided in 1769. Long before this time, the colony of Pennsylvania was settled. What part of the common law did Penn and his associates bring with them from England? The literary property of authors, as now asserted, was then unknown in that country. Laws had been passed, regulating the publication of new works, under license. And the king, as the head of the church and the State, claimed the exclusive right of publishing the acts of parliament, the book of common prayer, and a few other books. No such right at the common law had been recognized in England, when the colony of Penn was organized. Long afterwards, literary property became a subject of controversy, but the question was involved in great doubt and perplexity; and a little more than a century ago, it was decided by the highest judicial court in England, that the right of authors could not be asserted at common law, but under the statute. The statute of 8 Anne was passed in 1710. Can it be contended, that this common law right, so involved in doubt as to divide the most learned jurists of England, at a period in her history, as much distinguished by learning and talents as any other, was brought into the wilds of Pennsylvania by its first adventurers? Was it suited to their condition?

But there is another view, still more conclusive. In the eighth section of the first article of the constitution of the United States, it is declared, that congress shall have power 'to promote the progress of science and useful arts, by securing, for limited times, to

19 authors and inventors, the exclusive right to their respective writings and discoveries.' And in pursuance of the power

thus delegated, congress passed the act of the 30th of May, 1790. This is entitled 'an act for the encouragement of learning, by securing the copies of maps, charts and books, to the authors and proprietors of such copies, during the times therein mentioned.' In the first section of this act, it is provided, 'that from and after its passage, the author and authors of any map, chart, book or books, already printed within these United States, being a citizen, &c., who hath or have not transferred to any other person the copyright of such map, chart, book or books, &c., shall have the sole right and liberty of printing, reprinting, publishing and vending such map, book or books, for fourteen years.'

In behalf of the common law right, an argument has been drawn from the word *secure*, which is used in relation to this right, both in the constitution and in the acts of congress. This word, when used as a verb active, signifies to protect, insure, save, ascertain, &c. The counsel for the complainants insists that the term, as used, clearly indicates an intention, not to originate a right, but to protect one already in existence.

There is no mode by which the meaning affixed to any word or sentence, by a deliberative body, can be so well ascertained, as by comparing it with the words and sentences with which it stands connected. By this rule, the word *secure*, as used in the constitution, could not mean the protection of an acknowledged legal right. It refers to inventors, as well as authors, and it has never been pretended by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented. And if the word *secure* is used in the constitution, in reference to a future right, was it not so used in the act of congress?"

It will thus be observed then, that in this great case the Supreme Court has fully passed on all questions of common law rights under the copyright law. Further in the opinion, the court fully discusses Beckford *v.* Hood, *supra*, in which Lord Kenyon's decision was given, which is relied upon in the case at bar. We must therefore come to the conclusion that the courts of this country have long ago passed adversely upon the right to bring a common law action under the section of the copyright law which is now before us. Under the copyright laws that now exist there can be no such right. As Judge Coxe has said in Sarony *v.* Ehrich, *supra*, "we must deal with the law as it is, not as it ought to be." The decree must be, *Demurrer sustained; the declaration adjudged insufficient at law.*

A true copy:

Attest:

ALEX. H. TROWBRIDGE, *Clerk.*

21 *Transcript of Record of Circuit Court.*

UNITED STATES OF AMERICA, *District of Massachusetts, ss:*

At a Circuit Court of the United States for the First Circuit begun and holden at Boston within and for the District of Massa-

chusetts on the third Tuesday of October, being the sixteenth day of October, in the year of our Lord one thousand nine hundred and six.

Before the Honorable Francis C. Lowell, Circuit Judge.

No. 37, Law Docket.

GEORGE H. WALKER ET AL., Plaintiffs,
v.
GLOBE NEWSPAPER COMPANY, Defendant.

The Mandate of the United States Circuit Court of Appeals for the First Circuit in this cause was received and filed in the clerk's office at the October Term of this Court, A. D. 1905, and is in the words and figures following:

22 *Mandate.*

(Filed in Circuit Court Nov. 7, 1905.)

UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the Honorable the Judges of the Circuit Court of the United States for the District of Massachusetts, Greeting:

Whereas, lately in the Circuit Court of the United States for the District of Massachusetts, before you, or some of you, in a cause numbered and entitled:

No. 1412, Law Docket.

GEORGE H. WALKER ET AL., Plaintiffs,
v.
GLOBE NEWSPAPER COMPANY, Defendant,

the following judgment was entered on November 16, 1904:

Judgment.

November 16, 1904.

It is thereupon considered by the court, to wit, November 16, 1904, the Honorable Clarence Hale, District Judge for the District of Maine, duly assigned to hold said Circuit Court, sitting, that the said George H. Walker and Oscar W. Walker, plaintiffs, take nothing by their said writ, and that the said Globe Newspaper Company, defendant, recover of the said plaintiffs its costs of suit taxed at — as by the inspection of the record in said cause of the said Circuit Court, which was brought into the United States Circuit
23 Court of Appeals for the First Circuit, by virtue of a writ of error sued out by the said plaintiffs, George H. Walker *et al.*

agreeably to the act of Congress, in such cases made and provided, fully and at large appears.

And whereas, in the term of October, in the year of our Lord one thousand nine hundred and four, the said cause came on to be heard before the said Circuit Court of Appeals, on the said record, and was argued by counsel.

On consideration whereof, It is now, to wit, August 30, 1905, here ordered, adjudged and decreed as follows: The judgment of the Circuit Court is reversed; the case is remanded to that court for further proceedings according to law; and the plaintiffs in error recover their costs of appeal.

Costs in this United States Circuit Court of Appeals, for which execution is to issue in favor of said George H. Walker *et al.* and against the said Globe Newspaper Company, are taxed at seventy-nine dollars and sixty eight cents ($79.68).

You, therefore, are hereby commanded that such execution and further proceedings be had in said cause, as according to right and justice, and the laws of the United States, ought to be had, the said writ of error notwithstanding.

Witness, the Honorable Melville W. Fuller, Chief Justice of the United States, the thirty-first day of October, in the year of our Lord one thousand nine hundred and five.

JOHN G. STETSON,
Clerk of the United States Circuit Court of Appeals for the First Circuit.

Costs of Plaintiffs in Error:

Clerk	$34.05
Printing Record	25.63
Attorney	20.00
	$79.68

24 Also at the same term the following Answer was filed:

Answer.

(Filed by Consent Dec. 13, 1905.)

This defendant, without waiving its objections to the several defences of the plaintiffs' action, as set forth in the demurrer of the defendant heretofore filed and overruled, but insisting and relying upon the same, makes the following answer:

I. This defendant denies each and every material count, item, allegation, and particular in the plaintiffs' writ and declaration contained not hereinafter expressly admitted, controverted or denied.

II. This defendant admits that it is a corporation with a usual place of business in Boston, in this judicial district, as in said plaintiffs' writ and declaration contained.

III. Further answering, this defendant avers that the alleged copyright set out in the plaintiffs' writ and declaration is invalid and of no legal force or affect whatever, and as grounds for such invalidity sets out the following:

1. That the plaintiffs have not marked each and every copy of the alleged copyrighted map, as required by R. S. 4962.

2. That the said plaintiffs, neither individually nor jointly, were, was, are, or is the "author," "inventor," "designer," or "proprietor" of the alleged copyrighted map, or of any material or substantial part thereof, but that each and every material and substantial part and feature of said map had been repeatedly surveyed,
25 printed and published, and for many years prior to the date of the application for the alleged copyright, said prior publication relied upon being herein recited, together with the date and places of publication:

Date.	Place of publication.	Description.	Author.
		Commonwealth Maps.	
1844..	New York.....	Map of Commonwealth....	Simeon Borden.
1844..	Boston	Map of Massachusetts.....	Simeon Borden.
1852..	Boston	Map of Commonwealth....	Amasa Walker.
1876..	Boston	Map of Commonwealth....	Simeon Borden.
1876..	Boston	Map of Massachusetts.....	H. F. Walling.
1877..	Boston	Map of Massachusetts.....	Board of Railroad Commissioners.
1878..	"	" "	"
	(and yearly to date)		
1896..	Springfield	Map of Massachusetts.....	L. J. Richards.
1897..	Boston	Map of Massachusetts.....	Highway Commissioners.
1898..	"	" "	" "
	(and yearly to date)		
		City Map.	
1866..	Boston	Map of Boston & Vicinity..	Baker & Tilden.
		County Maps.	
1856..	Boston	Map of Essex County.....	
1857..	Boston	Map of Middlesex County..	
1857..	Boston	Map of Plymouth County..	
1858..	Boston	Map of Norfolk County...	
1871..	New York.....	Map of Franklin County...	F. W. Beers & Co.
1873..	New York.....	Map of Hampshire County.	" "
1874..	Phil.....	Map of Suffolk County....	G. M. Hopkins & Co.
1888..	New York.....	Map of Norfolk County....	E. Robinson.
26			
1894..	Springfield	Map of Hampden County..	L. J. Richards.
1895..	Phil.	Map of Bristol County.....	Evarts & Richards.
1896..	Springfield	Map of Worcester County..	L. J. Richards.
		Street Railway Maps.	
1886..	Boston	West End Street Ry. System	Sampson & Murdock Co.

Maps and Charts of the several Street Railways of the Commonwealth of Massachusetts in operation in the year 1899, or which had applied for franchise, said maps and said charts being on file at the State House and with the Board of Railroad Commissioners of the Commonwealth.

		Map of the World.	
1897..	.....	Atlas of the World.....	Bradley & Co.

And many others, the dates and precise data as to which are at present unknown to this defendant, but this defendant is making diligent search to ascertain the same, and when so ascertained this defendant asks permission to add the same to the foregoing list as a part of this subdivision of the answer.

IV. Further answering, this defendant avers that the alleged copyrighted map or matter was by the plaintiffs printed and delivered to the Board of Railroad Commissioners of the Commonwealth of Massachusetts with the express understanding that said map was to be made a part of public documents of the Commonwealth intended and designed for gratuitous distribution and for free and unrestricted use and enjoyment by the public.

27 V. Further answering, this defendant avers that the alleged matter covered by the alleged copyright was not a proper subject for copyright at the date of the alleged copyright and comprised at that time nothing beyond a servile copy of like maps printed and published at dates prior to the date of the alleged copyright, and as enumerated in Paragraph III., Section 2, of this answer.

VI. Further answering, this defendant says that there is no material or substantial difference between the alleged copyrighted map and a like uncopyrighted map printed and published by these plaintiffs as a part of the report of the Board of Railroad Commissioners of the Commonwealth of Massachusetts for the years 1900, 1899, 1898, and 1897, the lines upon the copyrighted map used to represent the location of electric railways indicating nothing more than the location of the highways that had existed and been delineated on maps of the Commonwealth for many years prior to the date of the alleged copyright, and been used for many years prior to the date of the alleged copyright by street railways having various forms of motive power.

VII. Further answering, this defendant avers that the delineation of the routes of the electric railways of Massachusetts, as set out in the alleged copyrighted map, did not at the date of the said alleged copyright, constitute copyrightable subject matter, but was the work of a mere copyist, and said map represents nothing more than the routes of the various railway systems that had been previously surveyed and charted and published, as set out in Paragraph III., Section 2, of this answer.

WILLIAM QUINBY,
Att'y for Defendant.

28 This cause was thence continued from term to term to the present October Term, A. D. 1906, when a jury is duly empanelled and sworn according to law to try the issue, the Honorable Frederic Dodge, District Judge for the District of Massachusetts, sitting.

On the seventh day of November, A. D. 1906, the following Motions are filed:

Motion to Dismiss.

(Filed Nov. 7, 1906.)

That the court dismiss the present action on the ground that the court has not jurisdiction to hear or determine the present action, the Copyright Act making no provision for civil action for damages for infringement of a copyrighted map.

WILLIAM QUINBY,
For Defendant.

Motion that Court Direct Jury to Render Verdict for Defendant on Ground that Court has no Jurisdiction, etc.

(Filed Nov. 7, 1906.)

That the jury be directed to render a verdict for the defendant, on the ground that the court has not jurisdiction to hear or determine the present action, the Copyright Act making no provision for civil action for damages for infringement of a copyrighted map.

WILLIAM QUINBY,
For Defendant.

29 *Motion that Court Direct Jury to Render Verdict for Defendant on Ground that Court has no Jurisdiction to Assess Profits, etc.*

(Filed Nov. 7, 1906.)

That the jury be directed to render a verdict for the defendant, on the ground that the court in this action has no jurisdiction to assess profits set up in the declaration.

WILLIAM QUINBY,
For Defendant.

On the same day the foregoing motions are heard and denied by the court, the Honorable Frederic Dodge, District Judge, as aforesaid, sitting.

On the ninth day of November, A. D. 1906, the following motions are filed:

Motion that Court Direct Jury to Render Verdict for Defendant on Ground that Court has no Jurisdiction, etc.

(Filed Nov. 9, 1906.)

That the jury be directed to render a verdict for the defendant, on the ground that the court has not jurisdiction to hear or determine the present action, the Copyright Act making no provision for civil action for damages for infringement of a copyrighted map.

WILLIAM QUINBY,
For Defendant.

Motion that Court Direct Jury to Render Verdict for Defendant on Ground that Upon the Evidence Submitted the Plaintiffs' Copyrighted Map is Invalid.

(Filed Nov. 9, 1906.)

That the jury be directed to render a verdict for the defendant on the ground that upon the evidence submitted the plaintiffs' copyrighted map is invalid.

WILLIAM QUINBY.

30 *Motion that Court Direct Jury to Render Verdict for Plaintiffs for Nominal Damages Only, etc.*

(Filed Nov. 9, 1906.)

That the jury be directed to render a verdict for plaintiffs for nominal damages, if any, only, on the ground that upon the evidence submitted no actual damages are made out or recoverable.

WILLIAM QUINBY,
Att'y for Defendant.

On the same day, the foregoing motions are heard and denied by the court, the Honorable Frederic Dodge, District Judge, as aforesaid, sitting.

On the fourteenth day of November, A. D. 1906, the following motion is filed:

Motion that Court Direct Jury to Render Verdict for Defendant on Ground that Court has no Jurisdiction, etc.

(Filed Nov. 14, 1906.)

That the jury be directed to render a verdict for the defendant, on the ground that the court has not jurisdiction to hear or determine the present action, the Copyright Act making no provision for civil action for damages for infringement of a copyrighted map.

WILLIAM QUINBY,
For Defendant.

On the same day, the foregoing motion is heard and denied by the court, the Honorable Frederic Dodge, District Judge, as aforesaid, sitting.

31 This cause is thereupon committed to a jury, who, after hearing all matters and things concerning the same, return the following verdict:

Verdict.

Nov. 14, 1906.

The jury find for the plaintiffs, and assess damages in the sum of two hundred fifty (250) dollars.

MOSES P. GREENWOOD, *Foreman.*

On the twenty-ninth day of December, A. D. 1906, the following defendant's bill of exceptions is filed and allowed by the court:

Defendant's Bill of Exceptions.

(Filed and Allowed Dec. 29, 1906.)

This was an action at law, brought in the Circuit Court of the United States for the District of Massachusetts, according to the practice and pleadings of common law, to recover damages for the alleged infringement, in June, 1903, of the plaintiffs' copyrighted map. On demurrer judgment was rendered for the defendant. (130 Fed. Rep. 593.)

Thereafter, the plaintiffs took out a writ of error to the Circuit Court of Appeals, for the First Circuit, which tribunal reversed the judgment of the Circuit Court and remanded the case to the latter court for further proceedings. (140 Fed. Rep. 305.)

Thereupon, the cause came on for trial in this court at the October Term, A. D. 1906, of said court, the Honorable Frederic Dodge, District Judge, presiding, and the following proceedings were
32 had, to wit: A jury was empanelled and sworn according to law. Thereupon, the plaintiffs read the declaration, a copy of which is hereunto annexed, marked "A," and made a part hereof.

At the close of the reading of the declaration, counsel for defendant moved the court to direct a verdict for the defendant, and moved the court to dismiss the present action, submitting the same and the reasons therefor in writing, in the words and figures following, to wit:

"1. That the jury be directed to render a verdict for the defendant, on the ground that the court has no jurisdiction to hear or determine the present action, the copyright act making no provision for a civil action for damages for infringement of a copyrighted map."

"2. That the court dismiss the present action on the ground that the court has no jurisdiction to hear or determine the present action, the copyright act making no provision for a civil action for damages for infringement of a copyrighted map."

The court overruled each of said motions, to which ruling of the court counsel for the defendant then and there excepted.

Thereupon, the plaintiffs, to sustain the issues upon their part offered testimony of witnesses as their evidence in chief, which testi-

mony is not material to the present bill of exceptions, and need not be referred to.

At the close of the foregoing specified evidence in chief offered by the plaintiffs, counsel for the defendant moved the court to direct a verdict for the defendant, submitting the same and the reasons therefor in writing, in words and figures following:

33 "Counsel for defendant moves that the jury be directed to render a verdict for the defendant, on the ground that the court has no jurisdiction to hear or determine the present action, the copyright act making no provision for a civil action for damages for infringement of a copyrighted map."

The court overruled said motion, to which ruling of the court counsel for defendant then and there excepted.

The defendant thereupon offered testimony to sustain the issue, upon its part, which was followed by rebuttal testimony on behalf of the plaintiffs, but as such testimony is not material to the questions raised by the present bill of exceptions, it is not herein included.

This was all the evidence in the case, and at its conclusion the defendant again renewed its motion in writing, as above printed, to direct a verdict in its favor, and after the arguments of counsel, both of plaintiffs and defendant, to the court upon said motion, the motion was by the court denied, and counsel for defendant then and there excepted.

After the arguments of counsel for defendant and plaintiffs, and after the charge by the court to the jury, the latter retired to consider their verdict; and returned their verdict in favor of the plaintiffs, assessing their damages $250., upon which, judgment was by the court entered against the defendant, to all of which defendant excepted.

That the denial by the court of the defendant's said motion to dismiss and the said motion to direct a verdict, was in each case based solely by the court on the ground that the cause set forth in the declaration was in the opinion of the court, one that arose under the Copyright Law of the United States, whereof this court had jurisdiction, and, in any event, such action and opinion of the court was controlled by the decision of the Circuit Court of Appeals, for the First Circuit, (140 Fed. Rep. 305), to which opinion and

34 action of the court the defendant did then and there in each instance except.

Thereupon, defendant tenders this, its bill of exceptions to the action of the court, upon the sole question of jurisdiction, in the various particulars therein set out, and prays that the same may be allowed.

WILLIAM QUINBY,
Atty. for Defendant.

Allowed December 29, 1906.
FREDERIC DODGE,
District Judge.

35 "A."

Declaration.

And the plaintiffs say that they are citizens of the United States and residents of the Commonwealth of Massachusetts; that they are the authors, designers, inventors or proprietors of a certain map known as "Map of the Electric Railways of the State of Massachusetts, Accompanying the Report of the Railroad Commissioners, 1899;" that before the publication of said map, and for the purpose of copyrighting the same, the plaintiffs in conformity with the provisions of the Revised Statutes of the United States, on the 26th day of February, A. D. 1900, deposited in the office of the Librarian of Congress at Washington in the District of Columbia a printed copy of the title of said map for which they demanded a copyright, and that they also, not later than the date of the publication thereof, to wit, on the 10th day of March, A. D. 1900, deposited in the mail within the United States, addressed to the Librarian of Congress at Washington in the District of Columbia, two complete copies of such map, of the best edition issued, and at the time of the mailing of such printed copies of said map they forwarded to said Librarian of Congress at Washington in the District of Columbia the sum of fifty cents for recording the title of said map, and that said Librarian of Congress did record said title of said copyrighted map in the book kept for that purpose as required by Section 4597 of the Revised Statutes of the United States; that the plaintiffs gave notice of their copyright of said map entitled, "Map of the Electric Railways of the State of Massachusetts, Accompanying the Report of the Railroad Commissioners, 1899," by printing and inscribing upon some
36 portion of the face or front of each of the several copies of the said map "Copyrighted by Geo. H. Walker & Co., Boston;" that the plaintiffs complied with all the conditions and provisions of the Revised Statutes of the United States in such cases made and provided as aforesaid, and thereby obtained a copyright of the United States for said map in due form of law, and there was granted and secured to them and they had sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending for the term of twenty-eight years from the time of recording the title by the Librarian of Congress as above set forth.

That the defendant is a corporation organized under the laws of the Commonwealth of Massachusetts, and having its usual place of business at Boston in said Commonwealth; that the defendant, well knowing the premises and the rights so secured to the plaintiffs and without the consent of the plaintiffs (the proprietors of said copyright) first obtained in writing, signed in the presence of two or more witnesses and within two years before the commencement of this action, and after the recording of the title of said map as aforesaid, did engrave, etch, work, copy, print, publish, or import, either in whole or in part, copies of said map entitled as aforesaid, and

knowing the same to be so printed, published or imported, did sell and expose to sale a large number of copies of said map, contrary to the Statute in such cases made and provided and contrary to Section 4952 of the Revised Statutes of the United States, and did on or about the 8th day of June, A. D. 1903, engrave, etch, work, copy, print, publish or import, in whole or in part, and sold or ex-

37 posed for sale a very large number of the copies in whole or in part of said map, to wit, two hundred thousand, and thereby unlawfully, wrongfully and injuriously deprived the plaintiffs of the rights secured to them as aforesaid and the gain and profits which they might and otherwise would have derived from the publication and sale of the copies of said map.

By reason of all which the plaintiffs were deprived of the benefits from the publication and sale of the copies of said map and were otherwise greatly injured and damaged.

(Signed) By Their Attorney, H. L. BOUTWELL.

38 On the same day the following motion for judgment is filed, and allowed by the court, the Honorable Frederic Dodge, District Judge, as aforesaid, sitting:

Motion for Judgment.

(Filed and Allowed Dec. 29, 1906.)

In the above entitled action the plaintiffs move that judgment be entered.

By Their Att'ys, BOUTWELL & HASTINGS.

Also on the same day the following judgment is entered:

Judgment.

Dec. 29, 1906.

It is thereupon considered by the court, to wit, Dec. 29, 1906, the Honorable Frederic Dodge, District Judge for the District of Massachusetts, sitting, that the said George H. Walker and Oscar W. Walker, plaintiffs, recover of the said Globe Newspaper Company, defendant, the sum of two hundred fifty-one dollars and eighty-seven cents ($251.87) damages.

A true record:

Attest:

ALEX. H. TROWBRIDGE, *Clerk.*

39 *Petition for Writ of Error.*

(Filed Jan. 2, 1907.)

Now comes the Globe Newspaper Company, defendant herein, and says:

That on or about the 29th day of December, 1906, the Circuit Court entered judgment herein in favor of the plaintiffs and against this defendant in which judgment and the proceedings had prior thereto in this cause, certain errors were committed to the prejudice of the defendant, said errors consisting in the holding by the court, contrary to defendant's requests, that the present action for damages for the infringement of a copyrighted map could be maintained under the copyright laws of the United States, and that said court had jurisdiction of said suit.

Wherefore, this defendant prays that a writ of error may issue in this behalf out of the Supreme Court of the United States for the correction of the said error so complained of, on the sole question of jurisdiction, that said question be certified by the court, and that a transcript of the record, proceedings and papers in this cause, duly authenticated, may be sent to the Supreme Court of the United States.

WILLIAM QUINBY,
Attorney for the Defendant.

40 *Order on Petition for Writ of Error.*

Jan. 2, 1907.

DODGE, *J.:*

This 2nd day of January, 1907, comes the defendant by *his* attorney and files herein and presents to the court *his* petition praying for the allowance of a writ of error, solely on the question of jurisdiction, praying also that a transcript of the record, proceedings and papers upon which the judgment herein was rendered, duly authenticated, may be sent to the Supreme Court of the United States, and that such other and further proceedings may be had as are proper in the premises.

On consideration whereof the court does allow the writ of error, solely on the question of jurisdiction, upon the defendant giving bond according to the law in the sum of five hundred dollars, which shall operate as a supersedeas bond.

By the Court:

BENJ. H. BRADLEE,
Deputy Clerk.

41 *Bond on Writ of Error.*

(Filed and Approved January 2, 1907.)

Know all Men by these Presents, That we, the Globe Newspaper Company, a corporation located at Boston in the Commonwealth of Massachusetts, as principal, and Fidelity and Deposit Company of Maryland, a corporation duly established under the laws of the State of Maryland, and having an usual place of business in Boston, in the County of Suffolk, and Commonwealth of Massachusetts, as surety, are held and firmly bound unto George H. and Oscar W. Walker, copartners as George H. Walker & Co., of said Boston, in the full and just sum of Five hundred dollars ($500) to be paid to the said Walkers, their certain attorney, executors, administrators or assigns; to which payment well and truly to be made, we bind ourselves, our heirs, executors, and administrators, successors and assigns, jointly and severally, by these presents.

Sealed with our seals and dated this third day of January, in the year of our Lord one thousand nine hundred and seven.

Whereas, lately at a Circuit Court of the United States for the District of Massachusetts in a suit depending in said Court between said Walkers, and the Globe Newspaper Company, principal herein, judgment was rendered against the said Globe Newspaper Company on December 29, 1906, and the said Globe Newspaper Company having obtained a writ of error and filed a copy thereof in the Clerk's Office of the said Court to reverse the judgment in the aforesaid suit, and a citation directed to the said George H. and Oscar W. Walker citing and admonishing them to be and appear in the Supreme Court of the United States, in the City of Washington, D. C., on the first day of February, A. D. 1907.

Now, the condition of the above obligation is such, That if the said Globe Newspaper Company shall prosecute its writ of error to effect, and answer all damages and costs if it fail to make its plea good, then the above obligation to be void; else to remain in full force and virtue.

THE GLOBE NEWSPAPER CO., [SEAL.]
By WM. O. TAYLOR, *Ass't Treas.*
FIDELITY AND DEPOSIT COMPANY
OF MARYLAND, [SEAL.]
By ARTHUR L. TASH,
Resident Vice President.

Sealed and delivered in presence of
JOHN EASTMAN.

Attest:
THOS. L. O'BRIEN,
Resident Assistant Secretary.

Approved:
FREDERIC DODGE,
Judge U. S. District Court.

42 *Citation on Writ of Error.*

UNITED STATES OF AMERICA, *ss:*

To George H. Walker, of Needham, in the County of Norfolk, in the Commonwealth of Massachusetts, and Oscar W. Walker of Newton Centre, in the County of Middlesex, in said Commonwealth, co-partners doing business under the firm name and style of George H. Walker and Company, and having their usual place of business in Boston, in the District of Massachusetts, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at Washington, D. C., on the* first day of February next, pursuant to a Writ of Error filed in the Clerk's Office of the† Circuit Court of the United States for the District of Massachusetts wherein the Globe Newspaper Company, a corporation duly organized and established under the laws of the Commonwealth of Massachusetts, and having an usual place of business in Boston, in said District of Massachusetts, is plaintiff in error, and you are defendants in error, to show cause, if any there be, why the judgment rendered against the said plaintiff in error as in the said writ of error mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable Frederic Dodge, Judge of the District Court of the United States for the District of Massachusetts this third day of January, in the year of our Lord, one thousand nine hundred and seven.

FREDERIC DODGE,
U. S. District Judge.

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*Not exceeding 30 days from the day of signing.
†Name of Court to which Writ of Error is directed.

43 *Acknowledgment of Service on Citation on Writ of Error.*

BOSTON, MASS., *Jan'y* 15, 1907.

Due and sufficient service of the within citation is hereby acknowledged.

BOUTWELL & HASTINGS,
Att'ys for Def'ts in Error.

44 *Clerk's Certificate.*

UNITED STATES OF AMERICA, *District of Massachusetts, ss:*

I, L. C. Tucker, Deputy Clerk of the Circuit Court of the United States for the District of Massachusetts, within the First Circuit, certify that the foregoing is a true copy of the record in the cause entitled,

No. 1412, Law Docket.

GEORGE H. WALKER ET AL., Plaintiffs,
v.
GLOBE NEWSPAPER COMPANY, Defendant.

together with the Opinion of the Court, announced May 25, 1904, sustaining the demurrer of the defendant to the plaintiffs' declaration,
and of the record in the same cause, upon receipt of the Mandate of the United States Circuit Court of Appeals for the First Circuit, entitled,

No. 37, Law Docket.

GEORGE H. WALKER ET AL., Plaintiffs,
v.
GLOBE NEWSPAPER COMPANY, Defendant.

in said Circuit Court determined, the Petition for Writ of Error, the Order on Petition for Writ of Error and the Bond on Writ of Error, and also the original Citation upon the Writ of Error issued in said cause, with the Acknowledgment of Service thereon.

In testimony whereof I hereunto set my hand and affix the seal of said Circuit Court, at Boston, in said District, this twenty third day of January, A. D. 1907.

[Seal of the Circuit Court, Massachusetts.]

L. C. TUCKER,
Deputy Clerk.

Endorsed on cover: File No. 20,544. Massachusetts. C. C. U. S. Term No. 210. Globe Newspaper Company, plaintiff in error, *vs.* George H. Walker and Oscar W. Walker, copartners, doing business under the firm name and style of George H. Walker & Company. Filed January 25th, 1907. File No. 20,544.

Supreme Court of the United States

OCTOBER TERM, 1907.

No. 210.

GLOBE NEWSPAPER COMPANY,

Plaintiff in Error,

v.

GEORGE H. WALKER and OSCAR W. WALKER,

Co-Partners, Doing Business Under the Firm Name and Style of GEORGE H. WALKER & COMPANY.

Decisions and Memoranda.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF MASSACHUSETTS.

WILLIAM QUIRBY, Esq.,
Attorney for Plaintiff in Error.

Alfred Mudge & Son Inc., 24 Franklin Street, Boston, Mass.

Supreme Court of the United States.

OCTOBER TERM, 1907.

No. 210.

GLOBE NEWSPAPER COMPANY,

PLAINTIFF IN ERROR,

v.

GEORGE H. WALKER AND OSCAR W. WALKER,

CO-PARTNERS, DOING BUSINESS UNDER THE FIRM NAME AND STYLE OF GEORGE H. WALKER & COMPANY.

Decisions and Memoranda.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF MASSACHUSETTS.

WILLIAM QUINBY, ESQ.,
Attorney for Plaintiff in Error.

ALFRED MUDGE & SON INC., 24 FRANKLIN STREET, BOSTON, MASS.

INDEX.

SUPPLEMENTAL MEMORANDA.

	PAGE
Opinion of Judge Hale (130 Fed. 594)	1
Opinion of Circuit Court of Appeals, First Circuit (140 Fed 305	9
American Copyright Acts	29
Colonial Congress and the Several States	29
United States	31
United States Cases	32
Supreme Court of the United States	32
State Courts	32
United States Circuit Court of Appeals	32
Circuit Court	33
English Copyright Acts	34
Early English Cases	35
(1769) Millar *v.* Taylor, 4 Burrows, 2303	36
(1774) Donaldson *v.* Becket, 4 Burrows, 2408	38
(1798) Beckford *v.* Hood, 7 T. R. 620	40

[*130 Fed. 593]

WALKER ET AL.

v.

GLOBE NEWSPAPER COMPANY.

(Circuit Court, District of Massachusetts, May 25, 1904.)

No. 1412.

At Law. Action to recover damages for infringement of copyright. On demurrer to declaration.

H. L. Boutwell, *for Plaintiffs.*

William Quinby *and* Charles T. Gallagher, *for Defendant.*

[*130 Fed. 594]

Hale, District Judge. This case comes before the court on the defendant's demurrer to the plaintiffs' declaration. That declaration charges infringement of the plaintiffs' copyrighted map, known as "Map of the Electric Railways of the State of Massachusetts, Accompanying the Report of the Railroad Commissioners, 1899." Under this declaration the plaintiffs seek to recover damages for an invasion of their copyright. They do not seek a forfeiture and penalty under Section 4965 of the Revised Statutes of the United States [U. S. Comp. St. 1901, page 3414]. The defendant sets out eight causes of demurrer. The vital question raised by demurrer is stated in the first ground: "That the statutes relating to copyrights provide no remedy by civil action on behalf of the owner of the copyright of the

map." The plaintiffs admit that Section 4965, relating to copyrights, does not give any action for damages for the piracy of any map or any other article therein mentioned; that Section 4964 [U. S. Comp. St. 1901, page 3413] provides such remedy only in case of books; that this form of action is not expressly given by the statutes of the United States relating to copyrights. But the plaintiffs urge with great force and ability that where a right, previously existing by the common law, is secured by a statute, which provides no remedy for its protection, common law remedies are available. They insist upon the application of the rule that their ordinary common law remedy is not taken away because a special one is given by the statute. Plaintiffs' declaration is drawn, then, for the purpose of enforcing their common law rights. The question is thus brought clearly before the court whether they have any rights under the common law. The plaintiffs found their right of recovery under a common law declaration upon principles laid down by the English courts. They urge that the Statute of 8 Anne was a law similar to our copyright law in this respect: that it enacted that an author should have the sole right and liberty of printing his book for a limited number of years, and then affixed penalties for transgressing the law; that the Act therefore vested property in literary works in the author for a limited period, and that it provided penalties for those who infringed the property. But plaintiffs urge that, in addition to these statute penalties, the courts of England allowed an action on the case for damages, on the ground that the law confers no right without a remedy to enforce it; and that, while forfeitures and penalties were provided for by the Act, the provision for such forfeitures and penalties did not prevent an injured

author, whose copyright had been infringed, from having damages at the common law. Plaintiffs base their contention largely upon Beckford *v.* Hood, 7 T. R. 620, in which Lord Kenyon, in an elaborate and famous decision, supported the common law rights under an infringed copyright. Lord Kenyon said: —

"Then the statute having vested the right in the author, the common law gives the remedy by action on the case for the violation of it. Of this there could have been no doubt made if the statute had stopped there. But it has been argued that as the statute, in the same clause that creates the right, has prescribed a particular remedy, that and no other can be resorted to. And if such appeared to have been the intention of the Legislature, I should have subscribed to it, however inadequate it might be thought. But their meaning in creating the penalties in the latter part of the clause in question certainly was to give an accumulative remedy. Nothing could be more incomplete as

[*130 Fed. 595]

a remedy than those penalties alone; for, without dwelling upon the incompetency of the sum, the right of action is not given to the party aggrieved, but to any common informer. I cannot think that the Legislature would act so inconsistently as to confer a right and leave the party whose property was invaded without redress. On the fair construction of this Act, therefore, I think it vests the right of property in the authors of literary works for the times therein limited, and that consequently the common law remedy attaches if no other be specifically given by the Act."

The learned counsel for the plaintiffs urges that all the reasoning of Lord Kenyon in this famous decision applies in full force to the common law rights of an author under Section 4964 of the Revised Statutes of the United States [U. S. Comp. St. 1901, page 3413]. It is clear that our copyright law provides a remedy by civil action to the owner of the copyright of a book, but

does not provide any remedy in favor of the owner of the copyright of a map, under Section 4965 [U. S. Comp. St. 1901, 3414]. Section 4964 provides that a person who infringes the copyright in a book shall forfeit every copy of his offending publication, "and shall also forfeit and pay such damages as may be recovered in a civil action." But Section 4965 has no such provision. The portion of this section which is important in this case reads as follows: —

"If any person, after the recording of the title of any map, chart, dramatic or musical composition, print, cut, engraving or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts, as provided by this act, shall, within the term limited, contrary to the provisions of this act, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, engrave, etch, work, copy, print, publish, dramatize, translate, or import, either in whole or in part, or by varying the main design, with intent to evade the law, or knowing the same to be so printed, published, dramatized, translated, or imported, shall sell or expose to sale any copy of such map or other article, as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied, and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale; and in case of a painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his possession, or by him sold or exposed for sale."

It will be observed that this section provides for no action of damages, but provides for the forfeiture of every sheet of the offending map, chart, or drawing, and for the further forfeiture of one dollar for every sheet of the same found in the possession of the

infringer; and this is the sum of all the relief provided by Congress for the infringement of a copyrighted map. This section has been repeatedly before the courts. It is a penal statute, and must receive a strict interpretation. This has been decided many years ago in Backus *v.* Gould, 7 How. 798, 12 L. Ed. 919. In construing this statute in Sarony *v.* Ehrich (C. C.), 28 Fed. 80, Judge Coxe said:—

"No authority has been cited to sustain the proposition that when the piratical prints are out of the possession and beyond the control of the infringer the proprietor of the copyright can recover of him their value in an action at law. It would require an exceedingly strained construction — almost a distortion — of the Act to make it fit the present circumstances. It is no answer to say that the remedy provided by law is ineffective; that the wrong-doer may escape the consequences of his infringement; that the opportunity for

[*130 Fed. 596]

redress diminishes in proportion to the success of the infringement, and ceases wholly when the wrong is fully consummated. These arguments might with great propriety be addressed to the law-making power, and Congress could, perhaps, be induced to render effectual by a few simple amendments provisions which, in their present form, are so obviously defective and inadequate. With these considerations, however, the courts have nothing to do. They must deal with the law as it is, not as it ought to be."

In Bolles *v.* Outing Company, 175 U. S. 262, 20 Sup. Ct. 94, 44 L. Ed. 156, the Supreme Court held that in an action under this statute to recover the penalty of one dollar provided for every copy of engraving or photograph infringing the copyright of another, the plaintiffs' recovery is limited to copies actually found in the possession of the defendant, and does not extend to copies sold and put in circulation. In that

very recent case the whole body of American law is reviewed.

But the learned counsel for the plaintiffs contends that under the reasoning of Lord Kenyon in the English court, upon the Statute of Anne, the rights of the plaintiffs, being secured by the Statute which provides no adequate remedy, the common law remedies are available. The vital and conclusive answer to enforcing this proposition in the Federal courts is that there is no common law of the United States. In the famous case, Wheaton *v.* Peters, 8 Pet. 591, 8 L. Ed. 1055, which is the leading and controlling case upon this whole subject, it is held, in construing the copyright law, that while a man is entitled to the fruit of his own labors, he can enjoy them only, except by statutory provision, under the rules of property which regulate society. Mr. Justice McLean, speaking for the Supreme Court, at page 657, 8 Pet. 8 L. Ed. 1055, said: —

"But if the common law right of authors were shown to exist in England, does the same right exist, and to the same extent, in this country? It is clear there can be no common law of the United States. The Federal government is composed of twenty-four sovereign and independent States, each of which may have its local usages, customs and common law. There is no principle which pervades the Union and has the authority of law that is not embodied in the Constitution or laws of the Union. The common law could be made a part of our Federal system only by legislative adoption. The question respecting the literary property of authors was not made a subject of judicial investigation in England until 1760; and no decision was given until the case of Miller *v.* Taylor was decided in 1769. Long before this time, the colony of Pennsylvania was settled. What part of the common law did Penn and his associates bring with them from England? The literary property of authors, as now asserted, was then unknown in that country. Laws had been passed regulating the publication of new

works under license. And the King, as the head of the church and the State, claimed the exclusive right of publishing the Acts of Parliament, the Book of Common Prayer, and a few other books. No such right at the common law had been recognized in England when the Colony of Penn was organized. Long afterwards literary property became a subject of controversy, but the question was involved in great doubt and perplexity; and a little more than a century ago it was decided by the highest judicial court in England that the right of authors could not be asserted at common law, but under the statute. The Statute of 8 Anne was passed in 1710. Can it be contended that this common law right, so involved in doubt as to divide the most learned jurists of England at a period in her history as much distinguished by learning and talents as any other, was brought into the wilds of Pennsylvania by its first adventurers? Was it suited to their condition? But there is another view still more conclusive. In the eighth section of the first article of the Constitution of the United States, it is declared that Congress shall have power to promote the progress of science and useful arts

[*130 Fed. 597]

by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries. And in pursuance of the power thus delegated, Congress passed the Act of the 31st of May, 1790 [1 Stat. 124, Chap. 15]. This is entitled 'An act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.' In the first section of this Act, it is provided 'that from and after its passage, the author and authors of any map, chart, book or books, already printed within these United States, being a citizen, etc., who hath or have not transferred to any other person the copyright of such map, chart, book or books, etc., shall have the sole right and liberty of printing, reprinting, publishing and vending such map, book or books, for fourteen years.' In behalf of the common law right, an argument has been drawn from the word 'secure,' which is used in relation to this right, both in the Con-

stitution and in the Acts of Congress. This word, when used as a verb active, signifies to protect, insure, save, ascertain, etc. The counsel for the complainants insist that the term, as used, clearly indicates an intention not to originate a right, but to protect one already in existence. There is no mode by which the meaning affixed to any word or sentence by a deliberate body can be so well ascertained as by comparing it with the words and sentences with which it stands connected. By this rule the word 'secure,' as used in the Constitution, could not mean the protection of an acknowledged legal right. It refers to inventors as well as authors, and it has never been pretended by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented. And if the word 'secure' is used in the Constitution in reference to a future right, was it not so used in the Act of Congress?"

It will thus be observed, then, that in this great case the Supreme Court has fully passed on all questions of common law rights under the copyright law. Further, in the opinion the Court fully discusses Beckford *v.* Hood, *supra*, in which Lord Kenyon's decision was given, which is relied upon in the case at bar. We must therefore come to the conclusion that the courts of this country have long ago passed adversely upon the right to bring a common law action under the section of the copyright law which is now before us. Under the copyright laws that now exist there can be no such right. As Judge Coxe has said in Sarony *v.* Ehrich, *supra*, "We must deal with the law as it is, not as it ought to be."

Demurrer sustained; the declaration adjudged insufficient at law.

WALKER ET AL.

v.

GLOBE NEWSPAPER COMPANY.

(CIRCUIT COURT OF APPEALS, FIRST CIRCUIT, AUG. 30, 1905.)

In Error to the Circuit Court of the United States for the District of Massachusetts.

(For Opinion below, see 130 Fed. 593.)

HARVEY L. BOUTWELL (A. W. LEVENSALER, *on the brief*), *for Plaintiffs in Error.*

WILLIAM QUINBY (CHARLES T. GALLAGHER, *on the brief*), *for Defendant in Error.*

BEFORE COLT, PUTNAM AND LOWELL, CIRCUIT JUDGES.

[*140 Fed. 305]

PUTNAM, Circuit Judge. In this case, the plaintiffs below are also the plaintiffs in error. Therefore, we may speak of plaintiffs and defendant without any qualification of the terms. The suit was brought in the Circuit Court, according to the practice and pleadings of the common law, to recover damages for the alleged infringement in June, 1903, of the plaintiffs' copyrighted map. On demurrer, judgment was rendered for the defendant. Thereupon the plaintiffs took out this writ of error.

The statutory provisions immediately applicable are two sections of the Revised Statutes as they stood before either was amended. The first is as follows: —

"SECTION 4952. Any citizen of the United States or resident therein who shall be the author, inventor, de-

signer or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators or assigns of any such person shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending the same." [U. S. Comp. St. 1901, p. 3406.]

The second is as follows: —

"SECTION 4965. If any person, after the recording of the title of any map, chart, musical composition, print, cut, engraving, or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of fine arts, as provided by this chapter, shall, within the term limited, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two

[*140 Fed. 306]

or more witnesses, engrave, etch, work, copy, print, publish, or import, either in whole or in part, or by varying the main design with intent to evade the law, or, knowing the same to be so printed, published, or imported, shall sell or expose to sale any copy of such map or other article, as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied, and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale; and in case of a painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his possession, or by him sold or exposed for sale; one-half thereof to the proprietor and the other half to the use of the United States." [U. S. Comp. St. 1901, p. 3414.]

Also, Section 4970 is as follows: —

"The circuit courts, and district courts having the jurisdiction of circuit courts, shall have power, upon

bill in equity filed by any party aggrieved, to grant injunctions to prevent the violation of any right secured by the laws respecting copyrights, according to the course and principles of courts of equity, on such terms as the court may deem reasonable." [U. S. Comp. St. 1901, p. 3416.]

The Revised Statutes provide in terms no other proceeding against the infringer of a copyrighted map; and on that topic, beyond what we have stated, they are silent. Subsequently, by the Act of March 2, 1895, Chap. 194, 28 Stat. 965, Section 4965 was amended so as to make a maximum and minimum penalty for infringement of photographs and works of art; but, so far as we perceive, this amendment does not concern this case, and there is no claim that it does. Also, there have been various other amendments recognizing specifically suits for damages under the copyright statutes, which suggest a possible implication that Congress considered that Section 4965 gave originally an exclusive proceeding at law; but we need not consider them, because, if that implication arises, it arose also out of Sections 4964 and 4970 of the Revised Statutes. We will find it necessary to return to this suggested implication.

Much has been said to us with reference to what is sometimes called the Federal common law. That all such discussion is useless is clearly settled by Wheaton *v.* Peters, 8 Pet. 591, 8 L. Ed. 1055, and Western Union Company *v.* Call Company, 181 U. S. 92, 101, 21 Sup. Ct. 561, 45 L. Ed. 765. As assumed in the latter case, and as said also by us in Brigham *v.* Brigham Hospital, 134 Fed. Rep. 513, 526, 67 C. C. A. 393, and as required by the various provisions of the Revised Statutes which, so far as rights are concerned, adopt the statutory or common law of the State where the cause of action

arose, and, so far as the remedy is concerned, the statutory or common law of the State where the litigation is pending, it is the laws of those States which we are to ascertain; although, in regard to the determination of what the laws are, the Federal courts are not always bound by the local decisions. It is enough, so far as this case is concerned, to say that the law is settled beyond all question, that no common law title is involved, and that the title of the plaintiffs depends wholly on the statutes of the United States. Wheaton *v.* Peters, 8 Pet. 591, 660, 661, 8 L. Ed. 1055; Copinger's Law of Copyright, 4th ed. (1904) 73. In view of the fact that the law is thus established in the United States, it is not necessary that we should consider the varying positions which have been

[*140 Fed. 307]

taken in England. Nor is it necessary that we should discuss the suggestion made in Holmes *v.* Hurst, 174 U. S. 82, 85, 19 Sup. Ct. 606, 43 L. Ed. 904, to the effect that, in this country and in England, a right to control publication did exist by the common law, now superseded by statute, because this was a mere *dictum*, while in Wheaton *v.* Peters, 8 Pet., at pages 654, 660, 661, 8 L. Ed. 1055, the question of a common law right was directly in issue, and it was solemnly adjudicated that Congress did not sanction any existing right, but created one.

The property right being established, the common law remedies attach, whether the right arises out of the common law or under a statute, unless there is something in the statute to the contrary. This rule is so firmly established in both the Federal courts and the State courts that it is not necessary that we should elaborate the topic. Frequently the statute is so

framed that the remedy arising thereon is by an action of debt. Chitty on Pleading, *125; but, under the statute of Westminster, and independently of it, the Register framed with the utmost liberality writs on the case to meet every emergency. Blackstone's Commentaries, Vol. 3, 51, 52, 53. It is, however, asserted that Section 4965 of the Revised Statutes is exclusive of all other proceedings at law. It is to be observed, first of all, that the property right is given by a separate provision of law, namely, Section 4952. This section and Section 4965 came through the Act of July 8, 1870, Chap. 230, 16 Stat. 198, entitled "An Act to Revise, Consolidate and Amend the Statutes relating to Patents and Copyrights." Of course, this was only a consolidation, as said in its title; so that both the Act of 1870 and the Revised Statutes are to be construed as not changing the law, except so far as they contain something clearly to that effect. McDonald *v.* Hovey, 110 U. S. 619, 4 Sup. Ct. 142, 28 L. Ed. 269, and many other authorities.

Therefore, applying the settled rules of construction, it is necessary to examine the entire Congressional legislation on this topic historically, and to go back to the original copyright statute, approved on May 31, 1790, 1 Stat. 124, Chap. 15. That gave no express remedy to the owner of any copyright, unless it was the same penalty and forfeiture found at present in Section 4965 of the Revised Statutes. It provided no remedy in equity or by action at common law. Section 1 of that Act was, so far as this case is concerned, the same as Section 4952 of the Revised Statutes, and Section 2 the same as Section 4965; so that, as what intervened between the Act of 1790 and the Revised Statutes was purely codification so far as these sections

are concerned, it becomes important to study the nature, construction and effect of the original legislation. In order that the whole position may be understood in all its aspects, it may be added that there was no further legislation until the Act approved on April 29, 1802 (2 Stat. 171, Chap. 36), which concerned nothing which could affect this litigation. The law stood in that way until the Act approved on Feb 15, 1819 (3 Stat. 481, Chap. 19), which declared the remedy in equity now found by codification in Section 4970 of the Revised Statutes, subsequent to which Act the bill in equity in Wheaton *v.* Peters, 8 Pet. 591, 8 L. Ed. 1055, was brought.

[*140 Fed. 308]

We should then consider whether the penalties and forfeitures provided by the second section of the Act of May 31, 1790, excluded such a remedy at common law as is asked in the present suit. This statute contained the provision found in Section 4965 of the Revised Statutes, to the effect that the penalties should go one half to the proprietor of the copyright and the other half to the use of the United States. The provision in the Revised Statutes giving larger penalties in cases of paintings, statues and statuaries came in at a later day by amendment. This was probably overlooked when a doubt was suggested in the opinion in Thornton *v.* Schreiber, 124 U. S. 612, 615, 8 Sup. Ct. 618, 31 L. Ed. 577, and in that in Bolles *v.* Outing Company, 175 U. S. 262, 265, 20 Sup. Ct. 94, 44 L. Ed. 156, whether the United States have any interest under the Revised Statutes except in the penalties to be recovered on account of paintings, statues and statuaries. Looking, then, at the history of the statutes, there can be no question that, as said by the Supreme Court, they provided

strictly *qui tam* suits. Backus *v.* Gould, 7 How. 798, *811, 12 L. Ed. 919. Section 4965 of* the Revised Statutes was expressly adjudicated a penal statute in Schreiber *v.* Sharpless, 110 U. S. 76, 3 Sup. Ct. 423, 28 L. Ed. 65. This is enough for our purposes.

In The King *v.* Harris, 4 T. R. 202, 205, it was adjudicated by the King's Bench that it is clearly an established principle that, when a new offence is created by a statute, and the penalty is annexed by a separate clause, the prosecutor may sue for the penalty or proceed on the prior clause on the ground of a misdemeanor as at common law. This case has been so frequently recognized as an authority that there would be no impropriety in holding that, as Section 1 of the Act of 1790 vested a title, the author, or other proprietor of a copyright, would be at liberty to proceed by his common law remedy, and would not be restricted to the specific proceeding authorized by the separate Section 2. However, we have no occasion to rely on the somewhat narrow rule of King *v.* Harris. The broader rule, everywhere admitted, is that given by Lord Kenyon, speaking for the King's Bench, in Beckford *v.* Hood, 7 T. R. 616, 623, decided in 1798. That arose on the statute from which the Act of May 31, 1790, was framed, that is, the original Copyright Act of the reign of Queen Anne. So far as this case is concerned, it was precisely the same as the Act of 1790. It vested a statutory right in the author, or proprietor, who had proceeded in accordance with its terms, and it provided a penalty for a violation of the copyright. The precise question arose in Beckford *v.* Hood which arises here. Lord Kenyon said that the penalties were cumulative, that they were given to a common informer, that nothing could be more incomplete as a remedy, and that he could not

think the Legislature would act so inconsistently as to confer the right and leave the party whose property was invaded without redress. It is true, as he said, that, in that particular case, the penalties might be sued for by a common informer, while, under our Statute of 1790, they could be sued for only by the proprietor of the copyright. However, that is a fact of no particular consequence, because the proceeding under the Federal Statutes is held by the Supreme Court to be strictly *qui*

[*140 Fed. 309]

tam, and quite as inadequate as the proceeding authorized by the Statute of Queen Anne.

This rule of Beckford *v.* Hood has always been admitted, alike in England and the United States; and it stands without ever being questioned. The reasons on which it was based were well explained in Barden *v.* Crocker, 10 Pick. 383, 389. In Vallance *v.* Falle, 13 Q. B. D. 109, 111, decided in 1884, Beckford *v.* Hood was recognized, but held not to apply where it was obvious that, taking the statute as a whole, the Legislature intended that there should be no proceeding except for the penalties. In Sedgwick on Statutory and Constitutional Law, 2d ed. (1874), 77, 342, and in Sutherland's Statutory Construction, 2d ed. (1904), 1057, 1058, Beckford *v.* Hood was fully recognized, and various decisions cited where its rule has been applied. Finally, as we have intimated, nowhere can any text-writer or authoritative case be found in which Beckford *v.* Hood has been refused application.

We may add that the plaintiffs rely on two Scotch decisions, Tennyson *v.* Forrester, 43 Scottish Jurist, 278, decided on Oct. 10, 1871, and Cadell *v.* Robertson, 5 Paton, 493, decided on July 16, 1811. Tennyson *v.* Forrester, however, clearly turned on the view of the

law in Scotland, that the right of an author to control publication exists independently of statute; and the earlier case apparently involved the same view. Each of them cited Beckford *v.* Hood, but not with reference to the point for which we are using it. Therefore, we cannot safely rely on these decisions.

As the proceeding under Section 2 of the Act of 1790, and likewise under Section 4965 of the Revised Statutes, is merely a *qui tam* action, it is subject to the arbitrary control of the Executive officers of the United States, until at least it is developed so far as to give a right beyond the mere possibility of suit. United States *v.* Morris, 10 Wheat. 246, 6 L. Ed. 314; The Laura, 114 U. S. 411, 5 Sup. Ct. 881, 29 L. Ed. 147. Also, the action does not survive. Schreiber *v.* Sharpless, 110 U. S. 76, 3 Sup. Ct. 423, 28 L. Ed. 65. Neither can an action of this kind be brought out of the jurisdiction where the statute was enacted. Wisconsin *v.* Insurance Company, 127 U. S. 265, 8 Sup. Ct. 1370, 32 L. Ed. 239. It is now held to be so narrow that suit will not lie except against some person in whose possession the infringing matter may be actually found; so that thereby the principal infringer may escape, and the penalty recovered will depend, not on any sound, reasonable discrimination, but on mere accident. Bolles *v.* Outing Co., 175 U. S. 262, 20 Sup. Ct. 94, 44 L. Ed. 156. Therefore, this proceeding for penalities is so far from affording a reasonable remedy that the statute must be said to be within the observations in that respect of Lord Kenyon in Beckford *v.* Hood.

Dealing thus with the Act of 1790, it seems to us the conclusion is clear that its second section did not exclude any suitable remedy, either according to the course of equity or of the common law. The corresponding pro-

visions of the Revised Statutes (Sections 4952 and 4965), as we have seen, are in substance the same as those of the Statute of 1790, and are only parts of a general codification. It is true, as we

[*140 Fed. 310]

have said, that there are amendatory acts with reference to remedies. So far as copyrighted maps are concerned, all there is in that direction is the Statute of 1819, already referred to, now found in Section 4970 of the Revised Statutes. This names a bill in equity in the usual course. The result of that is merely an injunction against future infringements, and an account of profits. Section 4921 of the Revised Statutes [U. S. Comp. St. 1901, p. 3395], authorizing equity courts to award damages, relates only to patents, and does not reach copyrights. This suit now before us illustrates that even the remedy given by Section 4970 is ineffectual, because, in this particular case, it would prove worthless. One newspaper after another throughout the entire territory of the United States might republish the complainants' maps, but each would only do it once, leaving no opportunity for an injunction. So far as profits are concerned, it is too plain for elaboration that the publication of a single illustration in a daily newspaper affords a very difficult basis for a computation in that direction. The only remedy of any value to which the owner of a copyrighted map could resort is a suit at law for damages.

In Vallance *v.* Falle, 13 Q. B. D. 103, 110, 111, already cited, it was observed that, in Beckford *v.* Hood, about which we have said so much, if "the penalty had been held to be the only remedy, the value of copyright would have been utterly destroyed." The general rule was stated to be in substance that "the provisions and objects

of the particular enactment must be looked at, in order to discover whether it was intended to confer a general right which might be the subject of an action, or to create a duty sanctioned only by a particular penalty, in which case the only remedy for breach of the duty would be by proceedings for the penalty." Fourth National Bank *v.* Francklyn, 120 U. S. 747, 752, 753, 7 Sup. Ct. 757, 30 L. Ed. 825, laid down no general rule, but was limited to the particular class of statutes then before the court, namely, statutes relating to the liability of stockholders, which are generally made conditional, and as to which it generally happens that special legislative provisions are necessary in order to secure a remedy. There are, of course, numerous other decisions which hold that the particular remedy pointed out by the statute which creates a statutory right must be pursued. Arnson *v.* Murphy, 109 U. S. 238, 3 Sup. Ct. 184, 27 L. Ed. 920, is one of this class, and, especially, many of them will be found in the decisions of the Supreme Judicial Court of Massachusetts; but, on being carefully examined, none of them will appear inconsistent with our propositions. In fact, the observation of Mr. Justice Miller in Dennick *v.* Railroad Company, 103 U. S. 11, 17, 26 L. Ed. 439, states what we have shown to be the governing rule: "It is difficult to understand how the nature of the remedy, or the jurisdiction of the courts enforcing it, is in any manner dependent on the question whether there is a statutory right or a common law right." Unless a statute is brought within the expressions contained in Vallance *v.* Falle, or within the necessities of Fourth National Bank *v.* Francklyn, or contains peculiar phraseology, there is no sound rule of construction which justifies a conclusion that, because it gives a special

remedy, the special remedy should be held to be exclusive.

[*140 Fed. 311]

Therefore, for the various reasons we have stated, we think the merits of this case are with the plaintiffs.

We have already referred to the possible implication arising out of Sections 4964 and 4970 of the Revised Statutes. We may also refer in this connection to Section 4966. Section 4964 provides for a forfeiture, and, also, for damages to be recovered in a civil action in any court of competent jurisdiction; but it is limited to infringements of the copyrights of books. Section 4966 provides for no penalty, but assesses damages as to the court shall appear just, the maximum being one hundred dollars. This section is limited to unauthorized representations of copyrighted dramatic compositions. Section 4970 declares a remedy in equity with reference to all copyrighted matter, and is the legitimate descendant of the Act of 1819 to which we have already referred. The two first named sections have been amended, but we have no particular occasion to refer to the amendments. It is to be noted that there are also special like provisions with reference to infringements of patents issued for inventions, but we are not aware that we have occasion especially to refer to them.

It is said that the sections of the Revised Statutes which we have named (4964, 4966 and 4970), the legislation out of which they arose and the legislation amendatory thereof, inasmuch as they expressly provide for actions for damages and suits in equity, bar, by implication, all such as are not included within their terms; and it is conceded that the suit before us is not thus included. If, however, the right in the owner of

a copyright to protect his title by all the means known to the general rules of law, by suits for damages or in equity, existed under the statute of 1790, as it did, this right is of too substantial a character to be annulled by any implication, unless so necessary as not to be done away with. Any general implication arising from such legislation as we have referred to can easily be met on the theory so often justified, and so often necessary, that the legislation was *ex majore cautelâ*, and was only a formal declaration of the common law. But this legislation as a whole can be met in a more emphatic manner. While, in the course of many and varied statutes, it has taken on different forms of expression, it originated in the necessity of securing jurisdiction to the courts of the United States, or of making it clear in regard to copyrights and patents. That was the seed from which all sprung, and, therefore, it must all, as a mass, be accounted for accordingly. Exactly how or why it got broken up in the way it did, or came to use for the same general purpose different forms of expression, may be difficult to explain; and we have no necessity therefor. The key to it all is found in the ninth paragraph of Section 629 of the Revised Statutes [U. S. Comp. Stat. 1901, p. 504], and in the fifth paragraph of Section 711 [U. S. Comp. Stat. 1901, p. 578], which, as the culmination of much legislation, vest original and exclusive jurisdiction in copyright and patent cases in the Circuit Courts of the United States. These provisions are believed to have originated, so far as copyrights are concerned, in Section 106 of the Act of July 8, 1870, 16 Stat. 215, Chap. 230. That Act did not use the word "exclusive," but it provided that all controversies at law or in equity should be originally cognizable by the Circuit

[*140 Fed. 312]

Courts, or Federal courts of equivalent jurisdiction. A like statute as to patents was early interpreted to vest those courts with exclusive jurisdiction, as is clearly explained in Hovey *v.* The Rubber Tip Pencil Company, 57 N. Y. 119, 123, 124, 15 Am. Rep. 470. When the Revised Statutes were enacted, this interpretation was adopted by the use in Section 711 of the words "exclusive of the courts of the several States."

That this last statutory declaration was deemed necessary carries with it the implication, which we have already stated, that common law remedies at once attach themselves to titles which are purely statutory, and to the further implication that, like ordinary trespasses on lands the title to which is held under patents of the United States, and even questions as to the boundaries of such patented lands, including as an extreme example questions of alluvion, suits against infringers, except for express statutory provisions, are entertainable by the State courts, and not by the Circuit Courts unless concurrently in cases of proper diversity of citizenship. Certainly, this was the early view, because it is apparent that it was understood that, under the Act of 1790, State courts had jurisdiction according to common law principles, both over suits for damages and proceedings in equity, against infringers of all copyrighted matter, and that the Circuit Courts had no jurisdiction in reference to the same, except for a penalty given by a Federal statute, and except also in cases of diversity of citizenship. Consequently, the State courts were resorted to accordingly. Indeed, this general view is expressed in Bumps' Patents, Trademarks, Labels and Copyrights, 2d ed. (1884), 18, where the author says that the legislation now found in Section

629 of the Revised Statutes did not extend or enlarge the powers of the Circuit Courts over the subject-matter of a bill or cause of action, but only extended their jurisdiction to parties not before falling within it. This is put more authoritatively by the Supreme Court in Evans *v.* Eaton, 3 Wheat. 454, 518, 4 L. Ed. 433, where, with reference to the patent granted to Oliver Evans by a special Act, the Court held that the Circuit Court had jurisdiction to protect his interests, and that he was not obliged to resort to the State courts, notwithstanding there was no diversity of citizenship, because, although his rights arose under a private Act, yet that Act was by implication, so far as relief was concerned, engrafted into the general statutes for the promotion of the useful arts.

The first enactment of the class which we are considering is the Statute of Feb. 15, 1819 (3 Stat. 481, 482, Chap. 19), to which we have already referred. That was entitled "An Act to extend the jurisdiction of the Circuit Courts," etc. It assumed nothing more than to give the Circuit Courts jurisdiction "of all actions, suits, controversies and cases arising under the laws granting authors and inventors exclusive rights." It then proceeded that, on any bill in equity, the Circuit Courts should have authority to grant injunctions. It thus clearly recognized jurisdiction in equity to grant injunctions in all copyright cases; but it is true that it does not specify the kind of suits at law which authors, as well as inventors, were entitled to bring. It must be said, however, that if, under the Act of 1790 (the only statute

[*140 Fed. 313]

on this topic until that of 1819 so far as copyrights were concerned), no action for damages at common law would

lie, so much of the Act of 1819 as related to suits in behalf of authors was waste material, because the Federal courts already had jurisdiction over suits for penalties. However, it was always declared that this statute was intended simply to extend the jurisdiction of the Circuit Courts, and not to create new rights. Sullivan *v.* Redfield, decided in 1825, 1 Paine, 441, 447, Fed. Cas. No. 13,597; Pierpont *v.* Fowle, decided in 1846, 2 W. & M. 23, 27, Fed. Cas. No. 11,152. Therefore, as the purpose of this Act was peculiar and clear, it carries no possible implication against the view we take of the Act of 1790. What remains of this statute is distributed between Sections 629 and 4970 of the Revised Statutes. It is the legitimate source of Section 4970, and the proper origin thereof; and, therefore, it removes that section from further consideration. There was no materially new legislation on this particular topic, so far as concerns copyrights, until the Act of Aug. 18, 1856, 11 Stat. 138, 139, which we will refer to again.

Meanwhile, it is plain from Atwill *v.* Ferrett, 2 Blatch. 39, 40, 41, 47, 48 (1846), Fed. Cas. No. 640, that suits at common law for infringements of copyrights were advised and brought by the legal profession, and that, in the opinion of judges of such unquestioned experience and ability as Mr. Justice Nelson and Judge Betts, such suits might be maintained if laid in case, which is the substance of the suit at bar, and its form so far as under the Massachusetts Practice Act a question of form of that character can arise. Of course, in view of the difficulty of proving damages, and also, in view of the desirability of coming into Federal courts, it may well be assumed that formerly a favorite method of procedure was for the

penalties given by the Act of 1790, and that common law suits were but little resorted to until the statute remedy for penalties received its final blow in 1899 in Bolles *v.* Outing Company, 175 U. S. 262; 20 Sup. Ct. 94, 44 L. Ed. 156. It is true that this decision relies to a certain extent on Backus *v.* Gould, 7 How. 798, 12 L. Ed. 919, decided as early as 1849; but the fact that Bolles *v.* Outing Company is found in the Supreme Court Reports in 1899, shows that the profession did not wholly acquiesce in Backus *v.* Gould, which, after all, as appears by its including sentence at page 812, of 7 How. 12 L. Ed. 919, was justiciable on a mere question of pleading. At any rate, until Backus *v.* Gould, a liberal rule prevailed, to such an extent that the statutory words "found in his possession," relied on in Bolles *v.* Outing Company, were construed to mean "found to have been in his possession"; and this as late as the decision of Chief Justice Taney in Reed *v.* Carusi, Taney's Decisions, 72, 75 (1845), Fed. Cas. No. 11,642.

If we have occasion for any further investigation, Section 4966 of the Revised Statutes is easily disposed of. This originated in the Act of Aug. 18, 1856, to which we have already referred, and it is traced from that Act through the Act of July 8, 1870, Sect. 101, 16 Stat. 214. The purpose of that legislation was peculiar and clear. It was simply to give a practical rule of damages in behalf of the owners of copyrighted dramatic compositions, which peculiar and clear purpose removes it from the field of further consideration. This leaves only Section 4964

[*140 Fed. 314]

of the Revised Statutes, which finds its origin in Section 99 of the Act of July 8, 1870, 16 Stat. 214.

It gives a fixed sum to the proprietor of a copyrighted book, and it is limited to books. In its form as found in the Act of 1870, or in the Revised Statutes, it is difficult of construction and its purpose is not plain. It may well be assumed that it was intended to obviate some of the disadvantages arising under the penal provisions of the Act of 1790, as now found in Section 4965 of the Revised Statutes. The portion, however, of Section 4964 relied on by the defendant is the provision that the infringer "shall also forfeit and pay such damages as may be recovered in a civil action by such proprietor in any court of competent jurisdiction." This gave a specific remedy to the proprietor of the copyright of a book, and it might well be considered that the particular relief so given was not penal, nor in the nature of a *qui tam* suit, but remedial; so that it was necessary to remove all implication against the possible taking away thereby of other remedial proceedings. The fact that the word "forfeit" is used in connection with the damages to be recovered in a civil action, as well as in connection with each copy of the infringing book which becomes under the statute the property of the proprietor of the copyright, shows a strange confusion of thought, or indicates that, as the suit for damages is purely remedial, the forfeiture of infringing copies is also to be held remedial. Consequently, we are well fortified in the proposition that it was necessary to remove any implication that the authorization of one proceeding which was in effect remedial, or regarded as such, would bar other remedial proceedings under the rules of the common law. However, this section is limited to copyrighted books, it has no relation to maps, and its precise purpose, construction and effect are doubtful; so that for these particular

reasons, as well as for the general reasons which we have already given, neither this section nor any other provision of statute to which our attention has been called, has sufficient pertinency to take away, directly or indirectly, by implication or otherwise, the substantial rights of a plaintiff as they existed according to the rules of the common law under the Statute of 1790. We may, however, well repeat that we might safely have passed by all this discussion of the history and particular features of the various Statutes which we have examined, and relied on the general proposition with which we commenced, that the substantial rights at common law which existed under the original Act of 1790 are not to be held to have been taken away by implication arising from other subsequent legislation, unless, after the circumstances and purposes under and for which the legislation was enacted have become thoroughly understood, it is clearly seen that the implication is of so necessary a character that it must be yielded to.

The defendant asserts some narrow grounds of demurrer. The first is, that there is an insufficient lack of allegation because the declaration does not state that the map in question was made from data, or information, worked out by its author. The declaration alleges originality substantially in the language of the statute, which is the ordinary form of pleading and is all that is necessary. The defendant also maintains that the pleadings are in the alternative, to the effect

[*140 Fed. 315]

that the plaintiffs are "authors, designers, inventors or proprietors." This objection was not specifically assigned. Therefore, inasmuch as the declaration contains sufficient matter informally alleged, it probably could

not be taken advantage of at common law under this demurrer, in which this alleged defect is not specially pointed out. It certainly is not available under the Massachusetts Practice Acts. Rev. Laws (1902), Chap. 173, § 14, page 1552.

The judgment of the Circuit Court is reversed; the case is remanded to that court for further proceedings according to law; and the plaintiffs in error recover their costs of appeal.

AMERICAN COPYRIGHT ACTS.

Colonial Congress and the Several States.

1783, Resolution of the Colonial Congress.

1783 to 1786, Copyright Acts of the Several States.

State.	Subject.	Remedy.
Connecticut, Janury Session, 1783.	Books and maps.	"Forfeit" double the value of the copies sold or exposed for sale. "Damages" provided for unauthorized publication of a manuscript.
Massachusetts, March 17, 1783.	"Books and other literary works."	"Forfeit" and pay a sum not exceeding 3000 £s.; nor less than 5 £s. recoverable by "action of debt."
Maryland, April 21, 1783.	"Books" or writings.	"Forfeit" copies and forfeit 2 pence for every sheet which shall be "found" in custody or exposed for sale.
New Jersey, May 27, 1783.	"Book or pamphlet."	"Forfeit and pay" "double the value," recoverable in any court.
New Hampshire, Nov. 7, 1783.	"Books" and other literary works.	"Forfeit and pay," not exceeding 1000 £s., nor less than 5 £s. by action of debt.
Rhode Island, December Session, 1783.	"Books and other literary productions."	"Forfeit and pay" not exceeding 3,000 £s., nor less than 5 £s., recoverable by action of debt.
Pennsylvania, March 15, 1784.	"Book or pamphlet."	"Forfeit and pay," "double the value of the copies introduced, sold or exposed for sale, recoverable in any court.
South Carolina, March 26, 1784.	"Books."	Shall forfeit books and sheets and make waste paper of them. Forfeit one shilling for every sheet found in his custody, to be recoverable by action of debt. Inventors given exclusive right, 14 years under privileges and restrictions provided for books.
Virginia, October,	"Book and pamphlet."	"Forfeit double the value of the copies sold or exposed for

STATE.	SUBJECT.	REMEDY.
1785.		sale, to be recoverable at the suit of the owner, in "any court of record."
North Carolina, Nov. 19, 1785.	"Book, Map or Chart."	"Forfeit books, maps or charts published or offered for sale, together with double the value of the articles. Court authorized to regulate the price to which authors should sell copyrighted books."
Georgia, Feb. 3, 1786.	"Books and maps."	"Forfeit and pay" double the value of copies printed, sold, or exposed for sale, to be recovered in due course of law."
New York, April 29, 1786.	"Books or pamphlets."	"Forfeit and pay" double the value of copies sold or exposed for sale, to be recovered in any court.
Delaware.		No Copyright Act.

(See Copyright Enactments, Solberg, pages 11 to 57.)

UNITED STATES.

	SUBJECT.	REMEDY.
May 31, 1790, Federal Copyright Act.	"Maps, Charts and Books."	"Shall forfeit all copies and shall forfeit and pay 50 cts. for every sheet 'found.'"
April 29, 1802.	"Prints"—Designing, Engraving and Etching.	Forfeit one dollar for every print "found" in his . . . custody.
Feb. 15, 1819.		Circuit Courts given jurisdiction at law and in equity in cases arising under copyright and patent law. Review by writ of error or appeal to the Supreme Court of the United States.
Feb. 3, 1831.	First Revision.	Books separated from maps. Original forfeiture retained for books. Forfeiture of copies and $1.00 a sheet for copies of maps "found."
Feb. 18, 1861.		Extending the right of appeal in copyright and patent cases from the Circuit Courts to the Supreme Court.
July 8, 1870.	Consolidation Act.	Amendment of statutes relating to patents and copyrights.
1873.	Revised Statutes.	Second Revision.

False Marking "Patented."

1870.	Consolidation Act, Sec. 39.	Penalty $100.

Prior Statutes.

1842.	Patent Act, Sec. 5.	Penalty $100.

False Marking "Copyright."

1873.	Revised Statutes, Sec. 4963.	Penalty $100.

Prior Statutes.

1870.	Consolidation Act, Sec. 98.	Penalty $100.
Feb. 3, 1831.	First Revision, Sec. 11.	Penalty $100.

UNITED STATES CASES.

Supreme Court of the United States.

Evans *v.* Eaton, 16 U. S. (3 Wheaton), 454, 518 (1818).
Wheaton *v.* Peters, 33 U. S. (8 Peters), 591, 662, 663 (1834).
Pollard *v.* Bailey, 87 U. S. (20 Wall), 520 (1874).
Farmers' & Mechanics' Nat'l Bank *v.* Dearing, 91 U. S. 29 (1875).
Barnet *v.* Nat'l Bank, 98 U. S. (8 Otto), 555 (1878).
Dennick *v.* Railroad Co., 103 U. S. 11 (1880).
Arnson *v.* Murphy, 109 U. S. 238, 243 (1883).
Fourth Nat'l Bank of N. Y. *v.* Francklyn, 120 U. S. 747 (1887).
Thornton *v.* Schreiber, 124 U. S. 612, 614 (1888).
Banks *v.* Manchester, 128 U. S. 244, 252 (1888).
Texas & Pacific R. R. Co. *v.* Cox, 145 U. S. 593, 604 (1891). Mr. Chief Justice Fuller.
Holmes *v.* Hurst, 174 U. S. 82 (1898).
Bolles *v.* Outing Co., 175 U. S. 262, 266 (1899).
Middletown Nat'l Bank *v.* Toledo, Ann Arbor & N. Mich. Ry. Co., 197 U. S. 394 (1904).

State Courts.

Roberge *v.* Burnham, 124 Mass. 277, 278 (1878).
Smith *v.* Drew, 5 Mass. 513 (1809).
Barden *v.* Crocker, 27 Mass. (10 Pick.), 383, 389 (1830).
Coffin *v.* Field, 61 Mass. 355 (1851).
Pollock *v.* Eastern Railroad Co., 124 Mass. 158, 159 (1878).
Palmer *v.* DeWitt, 47 New York, 532, 536.
Jewellers Mercantile Agency *v.* Jewellers Weekly Pub. Co., 155 N. Y. 241.
Grover *v.* Morris, 73 New York, 473, 478.
In re Barker, 56 Vermont, 14, 20.

U. S. Circuit Court of Appeals.

Bennett *v.* Boston Traveler Co., 101 Fed. 445, 448, C. C. A., 1st Cir. (1900).

Werckmeister *v.* Amer. Lithographic Company, 134 Fed. 321, C. C. A., 2d Cir. (1904).

Walker *et al. v.* Globe Newspaper Co., 140 Fed. 305, C. C. A., 1st Cir. (1905).

Circuit Court.

Chapman *v.* Ferry, 12 Fed. 693 (1882).

Banks *v.* Manchester, 23 Fed. 143 (1885).

Carte *v.* Duff, 25 Fed. 183, 187 (1885).

Sarony *v.* Ehrich, 28 Fed. 79, 80 (1886).

Black *v.* Allen Co., 42 Fed. 618, 625 (1890), Shipman, J.

ENGLISH COPYRIGHT ACTS.

1710 A.D., 8 Anne, Chap. 19	Subject, "Books." Remedy, Forfeiture to "informer."
1734 A.D., 8 George, 2, Chap. 13	Subject, "Prints."
1766 A.D., 7 George, 3, Chap. 38	Subject, "Maps."
1775 A.D., 15 George, 3, Chap. 53	Subject, "Perpetual copyright as to books in certain universities."
1777 A.D., 17 George, 3, Chap. 57	Subject, "Prints" and "Maps." Remedy, "Damages" in action on the case.
1814 A.D., 54 George, 3, Chap. 56	Subject, "Sculpture." Remedy, "Damages" in action upon the case.
1833 A.D., 3 and 4 William IV.	Subject, "Dramatic Productions."
1835 A.D., 5 and 6 William IV., Chap. 65	Subject, "Lectures."
1842 A.D., 5 and 6 Victoria, Chap. 45	General Copyright Act. All prior Acts repealed, including 8 Anne, Chap. 19. Section 2 includes maps with books. Remedy, Action on the case for damages, Section 15.

Early English Cases.

(1769) Millar *v.* Taylor, 4 Burrows Reports, 2303.

(1774) Donaldson *v.* Becket, 4 Burrows Reports, 2408.

(1798) Beckford *v.* Hood, 7 T. R. 620.

(1791) The King *v.* James Harris, 4 T. R. 202.

(1884) Vallance *v.* Falle, 13 L. R. Queen's Bench Division, 109.

(1769) Millar *v.* Taylor, 4 Burrows, 2303.

This was an action on the case for the infringement of a book entitled "The Seasons." The book had not been entered at Stationers' Hall, as required by 8 Anne, Chap. 19, and the term of the copyright under said section had expired.

The jury at the trial had rendered a special verdict (page 2306) as follows: —

"That before the reign of her late Majesty, Queen Anne, it was *usual* to purchase from authors the *perpetual* copyright of books," etc.

A majority of the court held: —

1. That perpetual right of copy existed at common law prior to the passage of 8 Anne, Chap. 19, and was not taken away by said Act.

2. That the right of copy being perpetual at common law prior to 8 Anne, and not taken away by said Act, that the plaintiff could recover, notwithstanding that the term of the copyright under said Act had expired.

The following justices of the Court of the King's Bench participated in the decision of the case and gave an opinion: —

Mr. Justice Welles, pages 2310 to 2335.

Mr. Justice Ashton, pages 2335 to 2354.

Mr. Justice Yates (dissenting), pages 2354 to 2395.

Lord Mansfield, pages 2395 to 2407.

Mr. Justice Yates, in his dissenting opinion, concluded (page 2395) with the statement "that the plaintiff who claims a perpetual and unbounded monopoly has no legal right to recover."

Lord Mansfield, at the beginning of his opinion (page 2395), called attention to the fact that this was the first

instance in his experience wherein the justices had failed to give a unanimous opinion.

Lord Mansfield predicated his position strictly on the "special verdict." (Page 2407.)

The action of the Court was — "Judgment for the plaintiff." (Page 2407.)

This judgment was overruled in Donaldson *v.* Becket (1774). (MacGillivray, Law of Copyright, page 6.)

(1774) Donaldson *v.* Becket, 4 Burrows, 2408.

On appeal to the House of Lords from a decree of the Court of Chancery, founded upon the judgment in Millar v. Taylor.

The opinion of the judges was ordered by the House of Lords upon the following questions:—

"*Q.* 1. Whether at common law an author of any book or literary composition had the sole right of first printing and publishing the same for sale, and might bring an action against any person who printed, published, and sold the same without his consent?"

"*Q.* 2. If the author had such right originally did the law take it away upon his printing or publishing such book or literary composition, and might any person afterward reprint and sell for his own benefit such book or literary composition against the will of the author?"

"*Q.* 3. If such action would have lain at common law, is it taken away by the Statute of 8 Anne. And is an author by the said statute precluded from every remedy except on the foundation of the said statute and on the terms and conditions prescribed thereby?"

"*Q.* 4. Whether the author of any literary composition and his assigns had the sole right of printing and publishing the same in perpetuity by the common law?"

"*Q.* 5. Whether this right is in any way impeached or taken away by the Statute of 8 Anne?"

It appears from said report and also from MacGillivray, Law of Copyright, page 7, that eleven consulted judges answered the foregoing questions as follows:—

Q. 1. Eight answered yes; one answered no. Two restricted their answer to manuscript.

Q. 2. Seven answered no. Four answered yes.

Q. 3. Six answered yes. Five answered no.

Q. 4. Seven answered yes. Four answered no.

Q. 5. Six answered yes. Five answered no.

(Page 2417) "The Lord Chancellor seconding Lord Camden's motion to reverse," the decree was reversed.

Beckford *v.* Hood, 7 T. R. 620 (1798).

This was an action upon the case to recover damages for the infringement of a copyrighted book, entitled "Thoughts Upon Hunting." The question for the opinion of the Court was, whether the plaintiff was entitled to recover in that action. Page 621:—

Reader for the plaintiff. Three questions arise in this case: First, Whether an action on the case for damages will lie, since the Statute 8 Anne, Chap. 19?

The other two points named by the Reader are unimportant. Page 623:—

"It might even be admitted that the rule may be carried further, and that wherever a new right is conferred by statute and a particular remedy given to the party grieved to enforce the observance of it, no other remedy can be resorted to. But here there is no remedy given to the party grieved." . . .

After referring to the forfeiture of copies as being no compensation for the injury previously sustained, Reader proceeds. Page 623:—

"But besides, there is this decisive answer to it, that the remedy, inefficient as it is, and inapplicable in some cases, is not given to the party grieved but to a common informer. Neither is the supposed remedy commensurate with the duration of the right conferred; for the penalties only attach upon persons pirating copies 'within the times granted and limited by this act *as "aforesaid"*'; the only times before specified being the term of twenty-one years for books then before printed, and the term of fourteen years for books thereafter to be printed; whereas by a subsequent clause (the 11th), if the author be living at the expiration of the first fourteen years the sole right of publishing reverts to him for a further term of fourteen years. Therefore, if the party grieved has not this remedy, he has no remedy whatever to protect his right against invasion during the latter period." . . .

Page 624: —

"It is admitted that injunctions are granted of course in the Court of Chancery to restrain printers from publishing the work of another person; which practice can only be sustained on the ground that the penalties given by the statute are not the only remedy which can be resorted to." . . .

"MARRYAT, for the Defendant. It is admitted that this action is not maintainable at common law independently of the statute; if so, that statute having pointed out a particular remedy, no other can be pursued. It is a settled rule that where a statute creates a new offence or gives a new right, and in the same clause either prescribes a particular mode of punishment or a particular remedy for the infringement of it, no other can be resorted to. But it is otherwise where a statute is merely confirmatory of a pre-existing right; in which case the new remedy is considered only as accumulative. It is said that this rule is confined to criminal proceedings or actions for penalties, and does not extend to cases of civil remedies for injuries sustained by the party grieved. Yet it appears that the Legislature thought otherwise in respect to property of a similar kind, namely, that of engravings. The 8 Geo. 2, Chap. 13, Sect. 1, gives the exclusive right in their works for a similar term to engravers as the 8 Anne had before given to authors, and affixes the same penalties upon the breach of it. The 7 Geo. 3, Chap. 38, extends the right to other persons, and enlarges the term of the monopoly to twenty-eight years. Then the 17 Geo. 3, Chap. 57, reciting the two former Acts, and their insufficiency for the protection of the artists, and the necessity there was for making further provision for securing their property, gives to the party injured a special action upon the case to recover damages against the party pirating the work. It is evident, therefore, that the Legislature thought that no such remedy as this now attempted lay by virtue of the statutes vesting the exclusive right in the engravers. Next it is objected that the remedy given by the Statute of Anne is inadequate, and that, such as it is, it is given to a common informer, and not to *the party grieved*. The inadequacy of it was a matter for the sole con-

sideration of the Legislature. The party grieved may sue, if he please, for the penalties. But at any rate the part of the Act which requires the forfeiture of the copies themselves that have been pirated is entirely for the benefit of the author. And as the penalties are given against every offender in whose custody any part of the work pirated shall be found, '*contrary to the true intent and meaning of the Act*,' that must be taken to include the further term of fourteen years granted by the subsequent part of the Act, as well as because in the former part of the same section all other persons than the author or proprietor are prohibited from publishing the work within the *times* granted and limited by this Act as aforesaid. [The Court said that the words '*as aforesaid*' confine the meaning to the two terms of twenty-one years and fourteen years mentioned in the preceding part of the clause, and cannot extend to the second term of fourteen years which is granted by a subsequent clause.]"

Page 627: —

"Lord Kenyon, Ch. J. All arguments in support of the rights of learned men in their works must ever be heard with great favor by men of liberal minds to whom they are addressed. It was probably on that account that when the great question of literary property was discussed, some judges of enlightened understanding went the length of maintaining that the right of publication rested exclusively in the authors and those who claimed under them for all time; but the other opinion finally prevailed, which established that the right was confined to the times limited by the Act of Parliament. And that, I have no doubt, was the right decision. Then the question is whether, the right of property being vested in authors for certain periods, the common law remedy for a violation of it does not attach within the times limited by the Act of Parliament. Within those periods the Act says that the author *shall have the sole right and liberty* of printing, etc. Then, the statute having vested that right in the author, the common law gives the remedy by action on the case for the violation of it. Of this there could have been no doubt made, if the statute had stopped there. But it has been argued

that, as the statute in the same clause that creates the right has prescribed a particular remedy, that and no other can be resorted to. And if such appeared to have been the intention of the Legislature, I should have subscribed to it, however inadequate it might be thought. But their meaning in creating the penalties in the latter part of the clause in question certainly was to give an accumulative remedy; nothing could be more incomplete as a remedy than those penalties alone, for without dwelling upon the incompetency of the sum, the right of action is not given to the party grieved, but to any common informer. I cannot think that the Legislature would act so inconsistently as to confer a right, and leave the party whose property was invaded without redress. But there was good reason for requiring an entry to be made at Stationers' Hall, which was to serve as a notice and warning to the public, that they might not ignorantly incur the *forfeitures or penalties* before enacted against such as pirated the works of others; but calling on a party who has injured the civil property of another for a remedy in damages cannot properly fall under the description of *a forfeiture or penalty*. Some stress was attempted to be laid on the Acts passed for preserving the property of engravers in their works, in which a special provision is made to meet such a case as the present, and to give the same right of action as is here contended for. But it is well known that provisions of that kind are frequently inserted in Acts of Parliament *pro majori cautelâ*; and no argument can be drawn from them to affect the construction of other Acts of Parliament. On the fair construction of this Act, therefore, I think it vests the right of property in the authors of literary works for the times therein limited, and that consequently the common law remedy attaches if no other be specifically given by the Act; and I cannot consider the action given to a common informer for the penalties, which might be preoccupied by another, as a remedy to the party grieved within the meaning of the act."

"Ashurst, J. In the case alluded to of Donaldson *v.* Becket, in the House of Lords, I was one of those who thought that the invention of literary works was a foun-

dation for a right of property independently of the Act of Queen Anne. But I shall not enter into the discussion of that point now, as the question in the present case is much narrowed. And upon the construction of that Act I entirely concur with my Lord that, the Act having vested the right of property in the author, there must be a remedy in order to preserve it. Now I can only consider the action for the penalties given to a common informer as an additional protection, but not intended by the Legislature to oust the common law right to prosecute by action any person who infringes this species of property, which would otherwise necessarily attach upon the right of property so conferred. Where an Act of Parliament vests property in a party, the other consequence follows, of course, unless the Legislature make a special provision for the purpose; and that does not appear to me to have been intended in this case. I am the more inclined to adopt this construction, because the supposed remedy is wholly inadequate to the purpose. The penalties to be recovered may indeed operate as a punishment upon the offender, but they afford no redress to the injured party; the action is not given to him, but to any person who may get the start of him and sue first. It is no redress for the civil injury sustained by the author in the loss of his just profits."

"GROSE, J. The principal question is whether within the period during which the exclusive right of property is secured by the statute to the author he may not sue the party who has invaded his right for damages up to the extent of the injury sustained; and of this I conceive there can be no doubt. In the great case of Millar *v.* Taylor, Mr. Justice Yates gave his opinion against the common law right contended for in authors; but he was decisively of opinion that an exclusive right of property was vested in them by the statute for the time limited therein. No words can be more expressive to that effect than those used by him. But it is to be observed that the penalties given by the Act attach only during the first fourteen years of the copyright; and during that time only is the offender liable for such penalties if he invade the author's right; but he is liable

during the whole period prescribed by the Act to make good in an action for damages any civil injury to the author. If this construction were not to prevail, dur-

author. If this construction were not to prevail, dur-

ing the last fourteen years of the term the author would be wholly without remedy for any invasion of his property. But there must be a remedy; otherwise it would be in vain to confer a right. I was at first struck with the consideration that six to five of the judges who delivered their opinions to the House of Lords in the case of Donaldson *v.* Becket were of opinion that the common law right of action was taken away by the Statute of Anne; but upon further view it appears that the amount of their opinions went only to establish that the common law right of action could not be exercised beyond the time limited by that statute."

"LAWRENCE, J. I entirely concur with the opinions delivered by my brethren upon the principal point, and the case of Tonson *v.* Collins, 1 Blac. Rep. 330, is an additional authority in support of it; for there Lord Mansfield said that it had been always holden that the entry in Stationers' Hall was only necessary to enable the party to bring his action for the penalty, but that the property was given absolutely to the author, at least during the term."

Postea to the plaintiff.

Office Supreme Court, U. S.
FILED.
MAR 9 1908
JAMES H. McKENNEY,
CLERK

Supreme Court of the United States.

OCTOBER TERM, 1907.

No. 210.

GLOBE NEWSPAPER COMPANY,

PLAINTIFF IN ERROR,

v.

GEORGE H. WALKER AND OSCAR W. WALKER,

CO-PARTNERS, DOING BUSINESS UNDER THE FIRM NAME AND STYLE OF GEORGE H. WALKER & COMPANY.

Brief for Plaintiff in Error.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF MASSACHUSETTS.

WILLIAM QUINBY, ESQ.,
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ALFRED MUDGE & SON INC., 24 FRANKLIN STREET, BOSTON, MASS.

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INDEX

	Page
Statement	1
Specification of Error	2
Common Law Rights of Authors	2
Statutory Rights and Remedies	4
Statutory Remedies—Maps	10
The Rule	11
Discussion of Opinion of the United States Circuit Court of Appeals for the First Circuit	16
Conclusion	30
Revised Statutes Relating to Copyrights	34

Supreme Court of the United States.

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v.

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BRIEF FOR PLAINTIFF IN ERROR.

STATEMENT.

This is a copyright case and comes up on a writ of error from the Circuit Court of the United States for the District of Massachusetts upon the sole question of jurisdiction. The plaintiff in error was the defendant below, and the defendants in error herein were the plaintiffs below.

The action was brought at law by the defendants in error, in the Circuit Court of the United States for the District of Massachusetts, to recover damages for an alleged infringement of a copyrighted "map." On demurrer, judgment was rendered for the plaintiff in error. (130 Fed. 593.) Thereupon the defendants in error herein took out a writ of error to the United States Circuit Court of Appeals for the First Circuit, which court reversed the judgment of the Circuit Court. (140 Fed. 305.)

Thereafter the action was tried in the Circuit Court and the jury returned a verdict in favor of the defendants in error herein, upon which judgment was entered

for said defendants in error. Thereupon the plaintiff in error took out this writ of error.

In the demurrer (Transcript of Record, page 5, paragraph 1 of the Demurrer) and in the answer (Transcript of Record, page 13, paragraph 1 of the Answer) and in the course of the trial (Transcript of Record, page 16, paragraphs 1, 2, 5; page 17, next to the last paragraph) the plaintiff in error, among other matters not now in controversy, raised the precise point raised and presented by this writ of error (Transcript of Record, page 18), to wit: Is not the owner of a copyrighted map in the enforcement of his rights under his monopoly restricted to the remedies specified in Section 4965, to wit, the recovery of the specified forfeitures and penalties?

I.

Specification of Error.

But one question is raised in these proceedings and complained of, and that is the ruling by the Circuit Court contrary to the request of the plaintiff in error: —

"That the present action for damages for the infringement of a copyrighted map could be maintained under the copyright laws of the United States, and that said court had jurisdiction of said suit." (Transcript of Record, page 22.)

ARGUMENT.

II.

Common Law Rights of Authors.

The common law rights of authors run only to publication; thereafter their sole protection is under the copyright statute.

A copyright cannot be maintained as a right existing at common law, but depends *wholly* upon the copyright statutes.

All common law rights of authors are superseded by the copyright statute after copyright.

Banks *v.* Manchester, 23 Fed. 143, State Reports (1885), Sage, J.

Banks *v.* Manchester, 128 U. S. 244, 252 (1888), Mr. Justice Blatchford.

Wheaton *v.* Peters, 33 U. S. (8 Peters), 591, 662, 663 (1834), Mr. Justice McLean.

"Wheaton Reports" affirmed and followed in Holmes *v.* Hurst, 174 U. S. 82, 85 (1898), Mr. Justice Brown.

As stated by Judge Townsend in Werckmeister *v.* American Lithographic Company, 134 Fed. 321, C. C. A., 2d Cir. (1904), page 324:—

"The statute supersedes the common law right and subject to certain conditions extends its protection after publication. The author of a work of art has at common law a property therein until it is published with his consent. . . . The right to make copies before publication and the right of first publication are common law rights. The right to multiply copies after publication to the exclusion of others is a statutory right."

Palmer *v.* De Witt, 47 New York, 532, 536.

"Compliance with a statutory provision of publication deprives the owner of his common law right." . . .

The defendants in error have surrendered their common law rights.

Jewellers Mercantile Agency *v.* Jewellers Weekly Publishing Co., 155 N. Y. 241.

The Colonies at no time treated copyright as a *common law* right. Further, after the Declaration of Independence and before the adoption of the Federal Constitution several of the States made special statutory

provisions on the subject of copyright, — *Massachusetts*, and all except Delaware, — (*Wheaton* v. *Peters*, 33 U. S. 591, 627). (Copyright Enactments by Thorvald Solberg, Register of Copyrights.)

Massachusetts, where the present right of action arose, as a Colony or a State never had any common law *right of copy* — multiplication of publications. No such right was known at common law. The right of *first publication* was the only common law right of authors. Thus, even the original States, including Massachusetts, did not by their Copyright Act provide a *remedy* for an *existing perfect* right, but *created a new* right. This same course was followed by the National Congress, except as to "manuscripts." Indeed, the original Federal Copyright Act is apparently but a "*composite*" of the Copyright Statutes of the several original States.

The Colonial Congress of 1783 recommended the several States to pass suitable legislation to "secure" to authors or publishers of any new book not hitherto published "copy right of such books," etc. Maps were not specified in this resolution. Thereupon, all of the orginal States, from time to time, dating from January, 1783, to April, 1786, with the exception of Delaware, passed Copyright Acts. In some of the States maps were included as a subject of copyrights, while in others, including Massachusetts, maps were not included.

III.

Statutory "Rights" and "Remedies."

Section 4952 of the Copyright Act sets forth the several subjects of copyrights corresponding to Section 4886 of the Patent Act. Section 4884 of the Patent Act declares the scope of the patent franchise corre-

sponding to the like declaration in Section 4952 of the Copyright Act. Section 4884 and Section 4952 declare the "exclusive" or "sole" character of the grant covered thereby. Neither specifies any right of action. Indeed, if the language of said sections — "exclusive," "sole" — were considered, it points to equity, injunction, rather than to an action at law, damages, sought in the present action.

Sections 4919, 4920 and 4921 of the Patent Act specifically provide for remedies, both at law and equity, for the infringement of the patent monopoly, including recovery of damages as well as profits. In like manner, —

Section 4964 of the Copyright Act specifies the remedy — civil action for damages in case of infringement of a copyright relating to a *book;* while

Section 4965 specifies the remedy — forfeiture — in case of the infringement of a copyrighted *map* where the copies are "found," etc. This section also provides the remedy for the infringement of other subject-matters. In the case of paintings the section provides for a cash forfeiture for each copy "found," etc., and also for each copy "*sold or offered for sale.*"

Section 4966 provides the remedy for the unauthorized representation or performance of a dramatic or musical composition.

Section 4967 provides the remedy for printing a manuscript without authority.

Section 4970 provides for equity jurisdiction to restrain by injunction the infringement of copyrights, but does not include any recovery of damages in connection with the exercise of such jurisdiction.

Section 4901 creates the offence of improper marking of patented or unpatented articles and fixes the penalty, $100, for each offence. Said section provides that one half of said penalty shall go "to the person who shall

sue for the same." In like manner Section 4963 makes unlawful a false publication of notice of copyright and fixes the penalty at $100, one half to go to "the person who shall sue for the same." In each case an offence is created and a specific penalty provided. In neither case is the owner of the monopoly considered, the recovery under each section running to the "informer." These sections provide for strictly *qui tam* actions.

See Grover *v.* Morris, 73 New York, 473, 478, and Roberge *v.* Burnham, 124 Mass. 277, 278, for the distinction between cases where the forfeiture runs to an "informer," as in Section 4963, and cases where the "forfeiture" runs "to the party aggrieved," as in Section 4965, the latter being in the nature of a remedial suit.

Section 4963 provides for a cause of action distinctly and fundamentally different from the cause of action provided for in Sections 4964, 4965, 4966, 4967 and 4970, which latter sections provide remedies whereby *only the owner of the copyright* may restrain infringement of his monopoly, strip the market of *infringing copies*, and secure a cash indemnity from the infringer, the Act fixing the rate of damages or indemnity and requiring proof only of the number of infringing copies.

The attention of the Court is especially directed to the fact that the remedy specified in Section 4965 runs to the owner of the copyright and for the full term of the copyright.

The attention of the Court is further directed to the provision of Section 4965, specifying the remedy in the case of an infringement of a painting. In such case a recovery can be had for each copy "sold or offered for sale," as well as for copies "found," etc. It is clear from this that Congress intended to restrict the remedies for infringement of maps to copies "found." Such provision is a reasonable one.

Bolles *v.* Outing Co., 175 U. S. 262, at 266 (1899), Mr. Justice Brown. "Photograph."

The adequacy or inadequacy of such a provision is unimportant.

It is not the judicial function to remedy alleged defects of the Copyright Act.

Inconveniences and insufficiencies of rights and remedies can only be adjusted by "amendment to the law."

Holmes *v.* Hurst, 174 U. S. 82, 90 (1898), Mr. Justice Brown. "Book."

See, also,

Arnson *v.* Murphy, 109 U. S. 238, at 243 (1883), Mr. Justice Matthews.

Bennett *v.* Boston Traveler, 101 Fed. 445, 448, C. C. A., 1st Circuit (1900), Colt, C. J. "Cut."

Chapman *v.* Ferry, 12 Fed. 693, at 696 (1882), Deady, D. J. "Map."

Carte *v.* Duff, 25 Fed. 183, at 187 (1885), Wallace, J. "Opera, the Mikado."

Sarony *v.* Ehrich, 28 Fed. 79, at 80 (1886), Coxe, J. "Print."

By the Act of Feb. 18, 1861, 12 Statutes at Large, 130, it was provided that, in the case of owners of Letters Patent, or of copyrights, . . . "a writ of error or appeal, as the case may require, shall lie at the instance of either party to the Supreme Court of the United States, . . ." The Act of March 3, 1891, took away such right from the owners of Letters Patent, making the judgments or decrees of the Circuit Court of Appeals final in such cases, thereby continuing to the owners of copyrights a right denied the owners of Letters Patent.

Further, Sections 4964 and 4965, by positive terms, give the owner of the copyright the right to seize and destroy infringing copies, a right not given a patentee by statute at least, and seldom by the courts. Such distinction in favor of copyright was fixed by the Act of 1790, and has continued to the present time. Congress has from the very beginning fixed the classes of statutory rights and their remedies, which must continue and be exclusive until changed by further legislation by Congress.

The first Federal Copyright Act, of May, 1790, joined "books" and "maps" together as subjects of copyrights and specified for each the same remedy, to wit, "forfeiture." This and subsequent Acts, down to the "Consolidation Act" of 1870, made no provision for an action for damages in connection with either maps or books, but did provide such action in the case of the unauthorized publication of "manuscripts."

In the Act of 1831 "books" were separated from "maps." This Act retained the cash forfeiture, 50 cents, for books fixed by the Act of 1790, but increased the cash forfeiture for "maps" to $1.00.

Under the "Consolidation Act" of 1870, Section 99, "books" were given an independent remedy, to wit, an action for damages. Section 100 of said Act relating to "maps" retained the remedy of "*forfeiture.*" This separation of books from maps in regard to the class of remedy has continued to the present day. The Revision Act of 1873, Section 4964, provided a remedy for damages in connection with books, while Section 4965, which takes the place of Section 100 of the "Consolidation Act," retained *forfeiture* as a remedy for "maps."

Sections 4964 and 4965 have been twice amended since 1873, to wit, in 1891 and 1895. In neither of

these amendments, however, has Congress made any change in the remedy for maps or the remedy for books, the remedy for books remaining as provided by the Act of 1870, and the remedy for maps remaining as established in 1790, to wit, "forfeiture."

Feb. 14, 1891, a bill was introduced in the House of Representatives as an amendment to the then existing copyright law. This bill put books and maps together in the same section as in Act of 1790. This bill provided that an infringer should be "liable in damages" and subject to a fine of $1,000.

(Copyright in Congress, Solberg, page 304.)

Feb. 28, 1891. By resolution the House conferees were instructed as to the form of a copyright bill which provided in case of books and maps that the infringer "shall forfeit and pay such damages as may be recovered in a civil action."

(Copyright in Congress, Solberg, pages 312, 313.)

The history of Section 4965 and its several amendments and proposed amendments shows clearly the intent of Congress to restrict the remedies for infringement of maps to the remedy of forfeiture, and negatives any presumption or suggestion that the omission by Congress to provide a remedy for "damages" for "maps," as has been done for books, was due to an oversight.

IV.

Statutory Remedies — Maps.

The Copyright Act provides no remedy by a civil action either at law or in equity for damages on behalf of the owner of a copyright of a map.

R. S. U. S., Section 4965. "Forfeiture."

Thornton *v.* Schreiber, 124 U. S. 612, 614 (1888), Mr. Justice Miller. "Photograph."

MacGillivray, Law of Copyrights, page 290.

Chapman *v.* Ferry, 12 Fed. 693, 695 (1882), Deady, J.

Sarony *v.* Ehrich, 28 Fed. Rep. 79 (1886), Coxe, J. "Photograph."

The sole and only remedy provided by Section 4965 for the infringement of a copyrighted "map" is the forfeiture to the owner of the copyright of infringing "copies" and one dollar for each copy "found," etc.

Section 4970 gives to the owner of a copyrighted "map" in common with owners of other classes of copyrighted property a remedy by injunction.

The owner of a "cut" or a "map" cannot avail himself of the remedies, damages and forfeitures for copies "sold or offered for sale," provided for a book or a painting.

Bennett *v.* Boston Traveler, 101 Fed. 445, C. C. A., 1st Circuit (1900), Colt and Putnam, C. Js., Webb, D. J. "Cut."

"Maps" may be copyrighted as an atlas or book.

Black *v.* Allen, 42 Fed. 618, 625 (1890), Shipman, J.

V.

The Rule.

"A general liability created by statute, without a remedy, may be enforced by an appropriate common law action, but where the provision for the liability is coupled with the provision for a special remedy, that remedy, and that alone, must be employed."

Pollard *v.* Bailey, 87 U. S. (20 Wall.) 520 (1874), Chief Justice Waite.

This was a suit at law by a creditor of a bank against a stockholder to recover the full amount of his debt, without regard to claims of other creditors, or the ability of the other stockholders to respond to their obligations under the charter which provided that the stockholders were "bound respectively, for all the debts of the bank in proportion to their stock holden therein."

The defendant in the court below filed a demurrer, which was overruled.

Held, That the plaintiff should have proceeded at equity.

The cause was remanded with instructions to sustain the demurrer. This Court said at page 526:—

"The individual liability of the stockholders in a corporation for the payment of its debts is always a creature of statute. At common law it does not exist. The statute which creates it may also declare the purposes of its creation, and provide for the manner of its enforcement." . . .

Farmers' & Mechanics' National Bank *v.* Dearing, 91 U. S. 29 (1875), Mr. Justice Swayne.

The real question in this case was whether the discount by a national bank of a note at a greater rate of

interest than allowed by the statute of the State where such bank was located rendered the bank liable to the penalty for usury provided by the State statute, which, in that instance, was the forfeiture of the entire debt, whereas, under the Federal Act, a penalty was provided in the case of usury to the effect that the entire interest should be forfeited, and only the principal be recoverable. Judgment of Circuit Court of Appeals of the State of New York was reversed. This Court said at page 35: —

"Where a statute creates a new offence and denounces the penalty, or gives a new right and declares the remedy, the punishment or the remedy can be only that which the statute prescribes. Stafford *v.* Ingersoll, 3 Hill, 38. First National Bank of Whitehall *v.* Lamb, 57 Barb. 429."

Barnet *v.* National Bank, 98 U. S. (8 Otto) 555 (1878), Mr. Justice Swayne.

This was a suit brought by a bank upon a bill of exchange. The defendant sought to take advantage of the statute relating to usury by setting up the amount recoverable by the defendant in such cases as a counter-claim. These counter-claims were demurred to and the demurrer sustained by the Circuit Court for the Southern District of Ohio and judgment entered for the plaintiff. This judgment was affirmed by the Supreme Court.

Page 558: —

"Where a statute creates a new right or offence, and provides a specific remedy or punishment, they alone apply. Such provisions are exclusive. Farmers' & Mechanics' Nat'l Bank *v.* Dearing, 91 U. S. 29." . . .

"In the first defence the payment of the usurious interest is distinctly averred, and it is sought to apply it by way of offset or payment to the bill of exchange in suit. In our analysis of the statute we have seen

that this could not be done. Nothing more need be said upon the subject."

Arnson *v.* Murphy, 109 U. S. 238 (1883), Mr. Justice Matthews.

Syllabus:

"1. The common law right of action against a collector to recover back duties illegally collected is taken away by statute, and a remedy given based on statutory liability, which is exclusive."

This was an action at law by the plaintiff to recover money alleged to have been illegally exacted by the collector for customs duties.

This court held (page 239) that the cause of action arose under what is now Section 2931 of the United States, and that the remedy therein provided was exclusive and that the common law right of action followed before the passage of that Act based on an implied promise had been converted into an action based on an entirely different principle, that of statutory liability. The specific error of the lower court was in applying the statute of limitations of the State of New York.

Fourth Nat'l Bank of New York *v.* Francklyn, 120 U. S. 747 (1887), Mr. Justice Gray.

This was an action at law against stockholders. This Court, after quoting the rule stated in Pollard *v.* Bailey, 20 Wallace, 520, said, page 758: —

"The present suit, therefore, not being a bill in equity, or an action upon a judgment against the corporation, which are the only forms of remedy authorized by these statutes, but being an independent action at law upon the original liability of the stockholder, cannot be maintained, and the Circuit Court rightly so held. Judgment affirmed."

Middletown Nat'l Bank *v.* Toledo, Ann Arbor & Northern Michigan Ry. Co., 197 U. S. 394 (1904), Mr. Justice Peckham.

This case was brought to the Supreme Court by virtue of a certificate from the United States Circuit Court of Appeals for the Second Circuit.

The Circuit Court sustained the defendants' demurrers and dismissed the bill. The case came to the Circuit Court of Appeals on appeal from a decree of the Circuit Court.

This court held that the remedies provided in the Ohio statute would have to be followed.

This court said in discussing the general rule, at page 405: —

"The statute under such circumstances may be said to so far provide for the liability and to create the remedy as to make it necessary to follow its provisions and to conform to the procedure provided for therein." Citing Pollard *v.* Bailey, and others.

MASSACHUSETTS CASES.

Smith *v.* Drew, 5 Mass. 513 (1809), Parsons, C. J.

This was an action of debt to recover certain moneys from the defendant under a statute which provided that persons convicted of larceny might be punished in a prescribed way. The third section of said Act provided that in addition to said punishment the convicted person should be liable to forfeit to the owner treble the value of the goods stolen. Defendant pleaded that the plaintiff had not followed the remedy as prescribed in the statute. This plea was sustained. The Court said at page 514: —

"When a statute creates a new right, without prescribing a remedy, the common law will furnish an

adequate remedy, to give effect to the statute right. But when a statute has created a new right, and has also prescribed a remedy for the enjoyment of the right, he who claims the right must pursue the statute remedy." . . .

Coffin *v.* Field, 61 Mass. 355 (1851), Bigelow, J.

This was an action for trespass for taking and carrying away certain animals belonging to the plaintiff. The defendants were field-drivers, in Nantucket, and justified the acts alleged against them on the ground that the animals described in the several writs were going at large in the highways of Nantucket, contrary to law. The verdict was given for the plaintiff. The defendants' exceptions were based on the contention that as a remedy by replevin in such cases was given by the Revised Statutes, such remedy operated to exclude the other remedy at common law.

The Court said at page 358: —

"But this is an obvious misapprehension. When a statute confers some new right, and prescribes a remedy for a violation of that right, then the remedy thus prescribed, and no other, is to be pursued. But where a remedy existed at common law, and a statute creates a new remedy in the affirmative, without a negative, express or necessarily implied, a party may still seek his remedy at common law. 1 Chit. Pl. (6th Am. Ed.) 127, 164. Colden *v.* Eldred, 15 Johns. 220."

Exceptions were overruled.

Pollock *v.* Eastern Railroad Co., 124 Mass. 158, 159 (1878), Soule, J.

This was an action of tort for personal injury. Defendant demurred to the declaration, first, that the only remedy for the plaintiff is by a petition or bill in equity, under the provisions of the statutes. The Court held

that the defendant's contention in regard to the provisions of the particular statute was incorrect. Page 159: —

. . . "When a new right is created by a statute which provides a method in which the right may be enforced, the method thus provided is the only one which can be pursued; but when a statute merely gives a new remedy for enforcing a common law right, such new remedy is cumulative, unless, by special enactment or by implication, the common law remedy is excluded. Coffin *v.* Field, 7 Cush. 355, 358. Brown *v.* Castles, 11 Cush. 348." . . .

VI.

Discussion of the Opinion of the United States Circuit Court of Appeals for the First Circuit. (140 Fed. 305.)

The case at bar is the first instance in the history of litigation under the Federal Copyright Act where the owner of the kinds of copyright property catalogued in Section 4965 has been permitted to follow methods not specified in Section 4965, or in Section 4970.

Such substitution of remedies has been attempted in two cases and specifically denied by the Court in each case, to wit: —

I. Sarony *v.* Ehrich, 28 Fed. 79, 80 (1886), Coxe, J. "Photograph."

II. Bennett *v.* Boston Traveler Co., 101 Fed. 445 (1900), Colt, J. "Cut," C. C. A., First Circuit.

The rule applied by the United States Circuit Court of Appeals for the First Circuit in the foregoing case is apparently in flat conflict with the rule applied by the same court in the case at bar. The Bennett case was brought under Section 4965 to recover the pecuniary

penalty for the infringement of copyright of a "cut." The plaintiff had copyrighted a periodical known as the "New York Herald," containing the cut, but did not take out a copyright on the cut by itself. The Court said at page 447: —

"The plaintiff asks us to construe Section 1965 as if a book was included among the enumerated articles. This cannot be done, especially as the preceding section gives a specific remedy in the case of books. The fact is, the plaintiff has sought to take out a copyright on his paper alone, and has not seen fit to take out a separate copyright on his cut. He may be entitled to the remedy provided by statute for the infringement of the thing which he has copyrighted. He is not entitled to another remedy provided by statute for the infringement of another thing, which he has not copyrighted. Whether Congress should have extended Section 1965 to the case of books, or whether the remedy provided by Section 4964 affords an inadequate relief in the present case, are considerations which cannot affect the enforcement of the present statute as long as it remains unchanged."

The opinion of the United States Circuit Court of Appeals for the First Circuit, in the case at bar, and reported in 140 Fed. 305, is based upon the propositions quoted below, and which are believed to constitute a fair summary of the positions taken by said court, and upon which it based its conclusions.

Page 307: —

"The property right [copyright] being established, [by statute] the common law remedies attach, whether the right arises out of the common law, or under a statute, unless there is something in the statute to the contrary. This rule is so firmly established in both the Federal courts and State courts that it is not necessary that we should elaborate the topic."

Page 308: —

"We should then consider whether the penalties and forfeitures provided by the second section of the Act

of May 31, 1790, exclude such a remedy at common law as is asked in the present suit."

Page 311: —

"the right in the owner of a copyright to protect his title by all the means known to the general rules of law, by suits for damages or in equity, existed under the Statute of 1790 . . . this right is of too substantial a character to be annulled by any implication, unless so necessary as not to be done away with."

Page 314: —

"neither this section [4964] nor any other provision of statute to which our attention has been called [4964, 4965, 4966, 4970, and all provisions of the Copyright Act] has sufficient pertinency to take away, directly or indirectly, by implication or otherwise, the substantial rights of a plaintiff as they existed according to the rules of the common law under the statute of 1790."

The case of The King *v.* James Harris is cited by the Court of Appeals at page 308 apparently to support the proposition that because the Act of 1790 had several sections instead of one, that common law remedies attached to rights of Section 1 of said Act because no remedies were provided thereby, remedies being provided by Section 2 of said Act. The case cited does not support the proposition.

The King *against* James Harris, 4 T. R. 202 (1791).

This was an information by the Attorney-General under an Act passed to control the conduct of ships and persons on board, in connection with quarantine. The first section of the Act authorized the King to make orders in council. The Act recited no specific punishment for disobedience to the orders made under this section.

The fifth section of the Act was applicable to persons

who *left* the ship under inhibited conditions. The indictment was brought for the disobedience by the defendant of an order in council passed in pursuance to the first section of the Act forbidding persons *going on board* ships under inhibited conditions.

The Court held that the defendant was indicted under the first section of the Act and was not within the meaning of the fifth section. The Court held that the violation by the defendant of the King's order rendered the defendant punishable for a misdemeanor. The case does not support the proposition in connection with which it is urged by the Circuit Court of Appeals. The defendant, Harris, was not liable under the fifth section at all, but under the first section of the Act.

The rule laid down in the case of The King *v.* Harris was disputed *in re* Barker, 56 Vermont, 14, 20, citing Bishop's Statutory Crimes, Section 251. As a further differentiation, the attention of the Court is directed to the fact that Section 1 of the Act considered in the Harris case did not at all create the offence which was punishable by Section 5. Section 1 authorized the making of orders by the King in council without providing any specific remedy for the orders so made, while Section 5 created as a specific offence the leaving of vessels under inhibited conditions, for which offence a specific penalty was provided in Section 5. Page 206, Buller, J.: "I also agree with my brother Ashhurst that the defendant is not within the meaning of the fifth section." . . . This [fifth] section, therefore, wholly relates to the captain, seamen and passengers, and not to persons in the defendant's situation." So that neither the facts of the Harris case nor the working rule applied therein have any application whatever, it is submitted, to the case at bar.

The Court of Appeals evidently overlooked Section 4963, relating to false publication of copyright. This section creates what might be termed a misdemeanor. Cases like the Harris case might be applicable to Section 4963, but not to the subject-matter of Section 4965.

Further, Section 4964 and Section 4965 do not, as in the case of The King *v.* James Harris, create offences or rights separate and independent of Section 4952. The former Sections 4964 and 4965 create no rights or offences. They specifically provide remedies for the enforcement of the rights created by Section 4952. The three sections are a part of one Act, and as much a unit as if they were not subdivided.

Although in the discussion of the propositions quoted on page 17 of this brief the Circuit Court of Appeals refers to several authorities, apparently the one relied on is mentioned on page 308, to wit, Beckford *v.* Hood, 7 T. R. 616, decided in 1798, since the Court of Appeals at page 308 states, after referring to the case of Beckford *v.* Hood:—

"That arose on the statute from which the Act of May 31, 1790, was framed, that is, the original Copyright Act of Queen Anne [8 Anne, Chap. 19, A. D. 1709]. So far as this case is concerned, it [8 Anne, Chap. 19] was precisely the same as the Act of 1790." . . .

"The precise question arose in Beckford *v.* Hood which arises here."

The case of Beckford *v.* Hood was the third copyright case of importance after the passage of the Act of 8 Anne, Chap. 19 (A. D. 1709), relating to copyrights. The first two cases were Millar *v.* Taylor, decided in 1769, and Donaldson *v.* Beckett, decided in 1774.

A consideration of the facts in the Beckford *v.* Hood case will show to a demonstration that said facts are entirely unlike those of the case at bar.

1798 — Beckford *v.* Hood, 7 T. R. 620.

This was an action on the case for infringement of a copyrighted book entitled "Thoughts upon Hunting."

The defendant pleaded the general issue.

The jury found for the plaintiff.

The book had not been entered at Stationers' Hall previous to publication. The plaintiff had published the book without affixing his name to the copies. The term of the copyright had not expired.

The question considered by the Court was whether an action on the case would lie since the Statute of 8 Anne, Chap. 19.

The Court held: —

1. That the Statute of 8 Anne, Chap. 19, gave no remedy at all to the owner of the copyright.

2. That the only remedy provided by said Act was "not given to the party aggrieved, but to any common informer," and that such action for penalties by a common informer was not "a remedy to a party aggrieved within the meaning of the Act."

3. That even the provision as to a penalty to a common informer was restricted to the first part of the term. That during the latter part of the term of the copyright, the statute provided no remedy whatever, even to a common informer.

4. That the entry of the book at Stationers' Hall was material only in connection with a suit for the penalty provided for in the Act.

5. That the action of the case was available, since the Statute of 8 Anne, Chap. 19, provided no remedy at all to the owner of the copyright.

Attention is called to the following statements in the decision: —

Lord Kenyon (page 627): —

"But it has been argued that as the statute in the same clause that creates the right has prescribed a particular remedy, that and no other can be resorted to. And if such appeared to have been the intention of the Legislature, I should have subscribed to it however inadequate it might be thought."

Ashurst, J. (page 628): —

"Where an act of parliament vests property in a party, the other consequence [attaching of common law remedy] follows, of course, unless the Legislature makes a special provision for the purpose; and that does not appear to me to have been intended in this case."

"*Postea* for the plaintiff."

Section 4965 gives the right of action directly and exclusively to the party aggrieved, or the owner of the infringed copyright, and gives such remedy for the entire term in respect to the subject-matters of copyright mentioned therein. It is submitted that the facts of the case at bar bring it squarely within the rule as stated by Lord Kenyon and by Justice Ashurst, that where the statute creates a right and provides a remedy for the party aggrieved, no other can be resorted to, however inadequate such statutory remedy "might be thought."

The case of Vallance *v.* Falle, 13 L. R. 109, cited by the Court of Appeals at page 310, does not support the ruling of the Court of Appeals as to the effect of an alleged inadequacy of a statutory remedy.

Vallance *v.* Falle, 13 L. R., Queen's Bench Division, 109 (1884).

This was an action by the plaintiff, a seaman, to recover from the master of a vessel damages for

improperly withholding and detaining a certificate of discharge. At the hearing it was contended on behalf of the defendant that there being no common law duty or obligation imposed upon the master of a vessel to give such certificate, and that as the statute had imposed a penalty of ten pounds for withholding a certificate, a common law action could not be maintained. The county judge decided in favor of the contention and non-suited the plaintiff. This ruling was held to be correct. Judgment was affirmed and leave to appeal was refused. The Court said at page 110: —

"STEPHEN, J. I think the judgment of the county court judge was correct and must be affirmed."

It is true that this case does comment on the ruling of Beckford *v.* Hood. But what of that? Neither the case of Vallance *v.* Falle nor the case of Beckford *v.* Hood are authorities to the proposition that an alleged inadequacy of a statutory remedy, referred to by the Court of Appeals on page 309 and 310, authorizes a court to permit the substitution of another remedy.

Further, in Beckford *v.* Hood the common law action was not justified, because the statutory remedy to the owner of the copyright was inadequate, but specifically because 8 Anne, Sect. 19, *did not provide any remedy at all* running in favor of the owner of the copyright. The case of Vallance *v.* Falle appears to be on all fours with the case of Arnson *v.* Murphy, 109 U. S. 238, and supports the claim of the plaintiff in error.

The ruling by the Circuit Court of Appeals (page 309) that when a court considered a statutory remedy inadequate, such statute is not exclusive as to remedies, is in conflict with the decided cases.

Further, in Bolles *v.* Outing Co., 175 U. S. 262,

this Court discussed the reasons why in Section 4965 the remedy is properly restricted, so far as maps are concerned, to copies "found" in the defendant's possession.

The Court of Appeals say at page 310:—

"In fact the observation of Mr. Justice Miller in Dennick *v.* Railway Co., 103 U. S. 11, states what we have shown to be the governing rule, 'It is difficult to understand how the nature of the remedy, or the jurisdiction of the courts enforcing it, is in any manner dependent on the question whether there is a statutory right, or a common law right.'"

Dennick *v.* Railroad Co., 103 U. S. 11 (1880), Mr. Justice Miller.

The opinion of the Circuit Court of Appeals, after observing that most cases in support of the position of the plaintiff in error herein were cases relating to the rights of stockholders of national banks, and, therefore, not fairly applicable to the case at bar, quotes the extract from the Dennick case, *supra*, to show that the rule of the Supreme Court harmonizes with the position taken by the Circuit Court of Appeals for the First Circuit.

But the Dennick case does not deal at all with the question at bar. That was an action by an administratrix brought in the Circuit Court in the Southern District of New York against the defendant company, to recover damages for the wrongful death of A, by reason of the provisions of the statutes of New Jersey, where A died. It was contended that the suit could only be enforced in the State of New Jersey, and, in discussing this point, the Supreme Court made use of the language quoted by the Circuit Court of Appeals as an anthority in support of the rule, as stated by the Circuit Court of Appeals.

In Texas, etc., Railway Co. *v.* Cox, 145 U. S. 593, 604 (1891), Mr. Chief Justice Fuller, the Dennick case was construed and applied, and said construction inhibits the use of said decision announced by the Court of Appeals.

The question at bar is not as to the right of plaintiff to sue in one jurisdiction and not in another. The question at issue in the case at bar is the right of the plaintiff to disregard a statutory remedy and adopt a remedy that even the case of Beckford *v.* Hood holds could only be followed in cases where the statute provided no remedy at all for the party aggrieved. The question whether the remedy provided by a statute creating the right is exclusive of other remedies was not raised or involved or discussed in the Dennick case.

It is submitted that under the terms of the Copyright Act of 1790, and under the authorities, the remedy of an owner of a map was *in and by that Act* restricted to the remedy specified in said Act which ran in his favor only and for the full term of the copyright. The fact that the lower courts and counsel (page 313) in the early litigation under the Act of 1790 may have held views inconsistent with the ruling of this Court in Bolles *v.* Outing, 175 U. S. 262, and other earlier cases, is not conclusive or even persuasive of the point in support of which such historical anecdotes are urged by the Circuit Court of Appeals.

The argument, moreover, of the Circuit Court of Appeals in support of its position is, in substance, strikingly like certain portions of the dissenting opinion of Mr. Justice Thompson in Wheaton *v.* Peters, 33 U. S. 591 (1834), wherein, at pages 696, 97 and 698, Mr. Justice Thompson states his reasons for holding the Act of 1790 merely continued common law rights that

had existed prior to that time in Pennsylvania, and for that reason did not exclude common law remedies, all of the latter being available under the Act. Mr. Justice Thompson said, at page 696: —

"But if the complainants in the court below have not made out a complete right under the Acts of Congress, there is no ground upon which the common law remedy can be taken from them. If there be a common law right, there certainly must be a common law remedy. The statute contains nothing in terms having any reference to the common law right; and if such right is considered abrogated, limited or modified by the Acts of Congress, it must be by implication; and to so construe these Acts is in violation of the established rules of construction, that where a statute gives a remedy in the affirmative without a negative expressed or implied, for a matter which was actionable at common law, the party may sue at common law, as well as upon the statute. 1 Chitty's Pl., 144. This is a well-settled principle, and fully recognized and adopted in the case of Almy *v.* Harris, 5 Johns. Rep. 175."

"Whatever effect the Statute of Anne may have had in England, as to limiting or abridging the common law right there, no such effect, upon any sound rules of interpretation, can grow out of our Acts of Congress." . . .

Again, at page 697, after referring to the right of an author to proceed by equity and injunction at common law, Mr. Justice Thompson said: —

Page 697: —

"He may, I should think, file an injunction bill to stop the printing. But I may say with more positiveness, he might bring an action to recover satisfaction for the injury done, contrary to law, under the statute." . . .

And again, at the bottom of page 697: —

"The right being thus vested [by statute] at the time, draws after it the common law remedy. And there is no more reason for contending that the remedy given by the statute supersedes the common law remedy under

the Act of Congress than under the Statute of Anne. The statute remedy is through the means of penalties in both cases."

The assumption at the basis of the dissenting opinion of Mr. Justice Thompson was that the right of copy existed at common law in the State of Pennsyvania prior to the Federal Copyright Act of 1790, and that said Act merely continued said right, thus on that assumption bringing the case within the rule stated by Mr. Justice Thompson, that where a statute gives a remedy (page 696) "in the affirmative without a negative expressed or implied, for a matter which was actionable at common law, the party may sue at common law as well as upon the statute."

The Circuit Court of Appeals, however, takes the decision of the majority of the court in the case of Wheaton *v.* Peters, to the effect that the right of copy is created by the statute, and then applies substantially the same line of argument and the same rule used by Mr. Justice Thompson to establish the totally different proposition that common law remedies attached to the Act of 1790 upon the passage of said Act, unless it can be shown either by express terminology or by inevitable implication that Congress intended the Act of 1790 to be exclusive of common law remedies.

The citation by the Circuit Court of Appeals, at page 312, of the case of Evans *v.* Eton, 16 U. S. (3 Wheaton) 454, 518, Mr. Chief Justice Marshall (1818), in connection with the proposition "that common law remedies at once attach themselves to titles which are purely statutory," is unavailing, since the case cited has nothing whatever to do with that proposition.

The case of Evans *v.* Eton was an action brought by the plaintiff in error against the defendant in error for

an alleged infringement of a patent. It happened that this particular patent was granted by a special Act of Congress. The defendant objected to the jurisdiction of the Circuit Court to try this action, on the ground that the particular patent was granted "pursuant" to the Act "for the relief of Oliver Evans," and not "pursuant" to the general Patent Act, and, therefore, infringement of that patent could not be sought under the remedies provided for patents granted pursuant to the general Patent Act. This Court said on that point, page 518: —

"But this Court is of opinion that the Act for the relief of Oliver Evans is engrafted on the general Act for the promotion of the useful arts and that the patent is issued in pursuance of both. The jurisdiction of the Court is therefore sustained."

This case does not touch the proposition referred to, nor does it touch the fundamental proposition relied on by the Circuit Court of Appeals (page 311), that "the right of the owner of a copyright to protect his title by all means known to the general rules of law by a statute for damages in equity existed under the Statute of 1790."

The ruling by the Circuit Court of Appeals at page 311 to page 313, that because, under Revised Statutes, Section 629, paragraph 9, the Circuit Courts were given jurisdiction in copyright and patent cases, therefore the owners of a copyright can and always could proceed in the aforesaid courts by any action known to the common law or equity practice, is not supported by citations, and is believed to be unsound.

Further, the Court of Appeals for the First Circuit (page 311) states that Section 629 did not originate until after the Act of 1870, so far as copyrights were concerned.

This section, therefore, is not fairly evidential of the proposition that the Copyright Act of 1790 vested the owners of copyrights with all remedies at law and equity.

The Court of Appeals for the First Circuit disregards the decisions of the Supreme Judicial Court of Massachusetts, where the present cause of action arose (page 310), as not pertinent, although they are flatly against the rule as stated by the Court of Appeals. (Brief, p. 14.)

The Court of Appeals for the First Circuit cites (page 309) a decision of the Supreme Judicial Court of Massachusetts, Barden *v.* Crocker, 27 Mass. (10 Pick.) 383, 389 (1830), in support of the application made by the Court of Appeals of the case of Beckford *v.* Hood. But the case of Barden *v.* Crocker was one where the Court held the statutory penalty to be cumulative. That was an action on the case against the defendants for erecting a dam across Taunton Great River, whereby the passage of alewives up that river was prevented. A statute of Massachusetts provided a penalty for such obstruction. Plaintiff claimed the right to maintain the action by virtue of a sale to him by the town of the right to take alewives at a certain point during the year 1829.

The plaintiff contended (page 385) that the *qui tam* action of the statute could not be considered a remedy for the injury to the plaintiff, for it was given to "any person" who might sue for it, citing Beckford *v.* Hood, 7 F. R. 620.

In the case of Barden *v.* Crocker the statute vested no right in any person, but merely prohibited a certain act under a penalty. The Court held, at page 388, that the suits for the penalties could be brought "by persons who have no exclusive rights to the fish," and then

proceed to apply the *decision* of Beckford *v.* Hood to the facts of the Barden *v.* Crocker case. In each case the owner of the right was given no remedy. In each case the penalty was in the favor of the "informer."

That Section 4965 fixes a different method of assessment on a different cash rate of forfeiture in the case of infringement of paintings than in case of maps, seems to be conclusive that Congress intended the remedy in Section 4965 to be exclusive as to the subject-matters therein specified.

In the case of maps the infringer forfeits one dollar for each copy "found," and also forfeits each copy "found" in each case. In the case of paintings the infringer forfeits ten dollars for each copy either "found" or "sold or exposed for sale."

It can hardly be argued that the remedy of Section 4965 is inadequate as to paintings. If it be regarded by any particular court as inadequate as to maps, the difficulty is one that can only be cured by "amendment to the law."

Conclusion.

The right of the defendant in error being a statutory right, it is submitted that the rule as stated in

Pollard *v.* Bailey 87, U. S. 520, 526, 527,
Barrett *v.* National Bank 98, U. S. 555,
Arnson *v.* Murphy, 109 U S. 238,

controls and that said rule is in no way modified by the decision in Dennick *v.* Railroad Co., 103 U. S. 11, 17, relied on by the United States Circuit Court of Appeals for the First Circuit.

In Arnson *v.* Murphy, 109 U. S. 238, the question whether when a statute creates a right and provides a method of enforcing that right some other method can

be followed was at issue and decided. Further, that case was not one relating to "stockholders," and, therefore, not within the limitations suggested by the Circuit Court of Appeals for the First Circuit.

In Dennick *v.* Railroad Co., 103 U. S. 11, no such question was at issue, and the statement of this Court relied on by the Circuit Court of Appeals for the First Circuit was addressed to a totally distinct and independent point, to wit, the immateriality of the origin of the right there in controversy, to wit, whether common law or statutory, so far as it concerned the right of the administrator to recover against the defendant under the circumstances of the case in the courts in the State of New York, or in the United States Circuit Court for the Southern District of New York.

Inasmuch as the Act creating the right in controversy has provided a remedy running *exclusively* to the owner of the copyright for the *entire term* of the copyright instead of to "any person" for a part only of the term, as in 8 Anne, Chap. 19, the case at bar comes within the rule as stated on page 11 of this brief and within the rule as stated in Beckford *v.* Hood, and is clearly outside of the exception to the rule and the exceptional state of facts upon which the decision in Beckford *v.* Hood was distinctly based. The "common informer," so called, and his detective service are rewarded in the Federal Copyright Act under Section 4963, and then only in connection with a specific offence, to wit, improper marking. Section 4963, together with Section 4965, show clearly the intent of Congress to exclude the "informer class" from the remedies of Section 4965, thereby restricting the remedies of said section exclusively to the owners of the copyright.

Since the defendants in error have adopted a remedy

not provided in Section 4965, the case at bar is not one arising under the copyright laws whereof the statutes gave the Circuit Courts of the United States jurisdiction, and not one that creates any cause of action against the plaintiff in error.

The plaintiff in error or defendant below, if liable at all, is entitled to require the plaintiff to follow the remedy of Section 4965 and none other. (Barnet *v.* National Bank, 98 U. S. 555, 559.)

The relief prayed for by the plaintiff in error should be granted.

Respectfully submitted,

WILLIAM QUINBY,
Attorney for Plaintiff in Error.

BOSTON, MASS., Feb. 20, 1908.

UNITED STATES REVISED STATUTES.

"SECTION 629. The circuit courts shall have original jurisdiction as follows: —

. . . . . .

Ninth. Of all suits at law or in equity arising under the patent or copyright laws of the United States."

"SECTION 4952. Any citizen of the United States or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person, shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and, in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others. And authors may reserve the right to dramatize or to translate their own works."

"SECTION 4963. Every person who shall insert or impress such notice, or words of the same purport, in or upon any book, map, chart, musical composition, print, cut, engraving, or photograph, or other article, for which he has not obtained a copyright, shall be liable to a penalty of one hundred dollars, recoverable one-half for the person who shall sue for such penalty, and one-half to the use of the United States."

"SECTION 4964. Every person who, after the recording of the title of any book as provided by this chapter, shall within the term limited, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, print, publish, or import, or knowing the same to be so printed, published, or imported, shall sell or expose to sale any copy of such book, shall forfeit every copy thereof to such proprietor, and shall also forfeit and pay such damages as may be recovered in a civil action

by such proprietor in any court of competent jurisdiction."

"SECTION 4965. If any person, after the recording of the title of any map, chart, musical composition, print, cut, engraving, or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts, as provided by this chapter, shall within the term limited, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, engrave, etch, work, copy, print, publish, or import, either in whole or in part, or by varying the main design with intent to evade the law, or, knowing the same to be so printed, published, or imported, shall sell or expose to sale any copy of such map or other article, as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied, and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale; and in case of a painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his possession, or by him sold or exposed for sale; one-half thereof to the proprietor and the other half to the use of the United States."

"SECTION 4966. Any person publicly performing or representing any dramatic composition for which a copyright has been obtained, without the consent of the proprietor thereof, or his heirs or assigns, shall be liable for damages therefor, such damages in all cases to be assessed at such sum, not less than one hundred dollars for the first, and fifty dollars for every subsequent performance, as to the court shall appear to be just."

"SECTION 4967. Every person who shall print or publish any manuscript whatever, without the consent of the author or proprietor first obtained, if such author or proprietor is a citizen of the United States, or resident therein, shall be liable to the author or proprietor for all damages occasioned by such injury."

"SECTION 4970. The circuit courts, and district courts having the jurisdiction of circuit courts, shall have power, upon bill in equity, filed by any party

aggrieved, to grant injunctions to prevent the violation of any right secured by the laws respecting copyrights, according to the course and principles of courts in equity, on such terms as the court may deem reasonable."

Office Supreme Court, U. S.
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JAMES H. McKENNEY,
CLERK.

(20,544)

Supreme Court of the United States.

No. 210. **October Term, 1907.**

GLOBE NEWSPAPER COMPANY,

PLAINTIFF IN ERROR,

v.

GEORGE H. WALKER AND OSCAR W. WALKER,

Copartners, doing business under the firm name and style of George H. Walker & Company.

In Error to the Circuit Court of the United States for the District of Massachusetts.

BRIEF OF DEFENDANTS IN ERROR.

H. L. BOUTWELL,
A. W. LEVENSALER,
Counsellors for Defendants in Error.

BOSTON:
THE ROCKWELL AND CHURCHILL PRESS.
1908.

TABLE OF CONTENTS.

	PAGE
STATEMENT OF CASE	1
ASSIGNMENT OF ERRORS	4
BRIEF OF ARGUMENT	4
I. Jurisdiction	4
1. *a.* U.S. Courts	4
b. "Arising" under Copyright Laws .	4
2. Damages not Provided by Statute . .	6
3. Damages at Common Law . . .	6
a. Text Writers	6
b. English Cases	7
c. Canadian Cases	11
d. U.S. Cases	11
*e*1. Statutory Construction . . .	13
*e*2. Cumulative Remedy	15
4. Damages under Section 4964 . . .	17
5. Damages in Equity	18
6. Copyright Statute does not Create new Right	18
7. Only Adjudication in U.S. . . .	19
8. *a.* Federal Common Law . . .	21
b. Massachusetts Common Law . .	23
9. Copyright Statutes of England, Canada, and U.S.	24
10. Remedy (?)	28

PAGE

II. Decision in 140 F. R. 305 Controls . . 28

1. 26 Statutes at Large 827, Sect. 5 . . 29
2. Interpretation 29
3. Procedure 31
4. Effect of Judgment on Demurrer . . 32
5. Waiver 32
6. Laches 32
7. Needless Expense and Delay . . . 32
8. Trial Justice Controlled by 140 F. R. 305. 32
9. Jurisdiction of Appellate Court; how raised 33
10. Power not Jurisdiction 33

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In Error to the Circuit Court of the United States for the District of Massachusetts.

BRIEF OF DEFENDANTS IN ERROR.

STATEMENT OF CASE.

The declaration alleges that the plaintiffs (defendants in error here) are the owners of a certain map known as "Map of the Electric Railways of the State of Massachusetts, Accompanying the Report of the Railroad Commissioners, 1899;" that they have complied with all the requirements of the statutes in relation to copyrights and have obtained a copyright of the United States for said map; that the defendant (plaintiff in error here), well knowing the premises, and without the consent of the plaintiffs (defendants in error here), printed and sold a large number of copies of

said map, and the plaintiffs (defendants in error here) were greatly damaged thereby. By this action the plaintiffs (defendants in error here) seek to recover damages in an action at law for an infringement of their said copyright. To this declaration the defendant (plaintiff in error here) demurred.

The causes of demurrer were in part as follows:

1. "That the statutes relating to copyrights provide no remedy by a civil action on behalf of the owner of the copyright of a map."

2. "That the declaration confuses two separate and distinct causes of action, neither of which is authorized by the statutes relating to the copyright of maps."

3. "That the declaration contains no allegation that any copy or copies of the alleged infringing map complained of was or were found in the possession of the defendant."

4. "That the declaration contains no allegation that the alleged infringing map complained of, or any copy thereof, was published with the knowledge or consent of the defendant, or any of its officers, or with any intent to evade the statutes for the protection of the copyright for a map."

8. "That the declaration fails to set out any cause of action whatever" (Record, p. 5).

This demurrer was argued before the Circuit Court of the United States for the First Circuit holden at Boston within and for the District of Massachusetts at the February Term, 1904, and the demurrer was sustained (Record, p. 6). Judgment was duly entered for the defendant (plaintiff in error here). The plaintiffs (defendants in error here) duly excepted thereto (Record, p. 6) and the judgment of said Circuit Court was reversed by the Circuit Court of Appeals for the First Circuit (Record, p. 12).

The case came on for trial before the Hon. Frederic Dodge, District Judge for the District of Massachusetts, and a jury at the October Term, 1906 (Record, p. 15).

On Nov. 14, 1906, the jury found for the plaintiffs and assessed the damages in the sum of $250 (Record, p. 18).

At the close of the reading of the declaration to the jury, the defendant (plaintiff in error here) moved that the action be dismissed and the jury instructed to return a verdict for the defendant (plaintiff in error here) on the ground that the Court has no jurisdiction of the action (Exceptions, Record, p. 18). Both motions were denied and the defendant (plaintiff in error here) duly excepted. At the close of the plaintiffs' (defendants in error here) evidence in chief, the defendant (plaintiff in error here) moved that the jury be directed to render a verdict for the defendant (plaintiff in error here) on the ground that the Court has no jurisdiction to hear and determine the present action, the Copyright Act making no provision for a civil action for damages for infringement of a copyrighted map. The Court overruled this motion and the defendant (plaintiff in error here) excepted (Exceptions, Record, p. 19).

At the close of all the evidence the defendant (plaintiff in error here) again renewed its motion that the jury be instructed to return a verdict for defendant (plaintiff in error here) on the ground that the Court has no jurisdiction to hear and determine the present action. The Court overruled the motion and the defendant (plaintiff in error here) excepted (Exceptions, Record, p. 19).

"Denial by the Court of the defendant's said motion to dismiss and the said motion to direct a verdict, was in each case based solely by the Court on the ground that the cause set forth in the declaration was, in the opinion of the Court, one that arose under the Copyright Law of the United States, whereof this Court had jurisdiction, and, in any event, such action and opinion of the Court was controlled by the decision of the Circuit Court of Appeals, for the First Circuit (140 F.R. 305)," (Exceptions, Record, p. 19).

This Bill of Exceptions raises the sole question of the

jurisdiction of the United States Circuit Court to hear and determine this action (Exceptions, Record, p. 19).

This case comes before this Court upon a Writ of Error from the said Circuit Court of the United States and the only ASSIGNMENT OF ERROR is: "Said errors consisting in the holding by the Court, contrary to defendant's requests, that the present action for damages for the infringement of a copyrighted map could be maintained under the copyright laws of the United States, and that said Court had jurisdiction of said suit" (Record, p. 22).

BRIEF OF ARGUMENT.

I.

JURISDICTION.

U.S. Courts.

1. *a*. Original and exclusive jurisdiction in copyright and patent cases is vested in the Circuit Courts of the United States.

U.S. Rev. Stat., Sect. 629, Par. 9.
U.S. Rev. Stat., Sect. 711, Par. 5.
See also Walker *et al. v.* Globe Newspaper Co., 140 F. R. 305, 315.

"Arising" under copyright laws.

b. U.S. Rev. Stat., Sect. 629 provides: "Section 629. The Circuit Courts shall have original jurisdiction as follows: *Ninth*. Of all suits at law or in equity *arising* under the patent or copyright laws of the United States."

Drone on Copyright, p. 546, says: "Any action or suit for the violation of a right *secured* by the statute can be brought *only* in the federal court."

In Harrington *v.* Atlantic & Pacific Telegraph Co., 143 F. R. 329, the Court says: "Where a suit involves the question of infringement of patents, it is one *arising* under the patent laws and within the jurisdiction of a circuit court of the United States by virtue of Rev. St., Sect. 629, cl. 9,

although it also involves the question of the ownership of the patents or other contract rights."

In Falk *v.* Curtis Pub. Co., 100 F. R. 77, 79, the Court states: "Any case which does involve the validity or the infringement of a patent or of a copyright, is to be regarded as *arising* under the patent or copyright laws," etc.

In Excelsior Wooden Pipe Co. *v.* Pacific Bridge Co., 185 U.S. 282, 291, the Court states: "The natural and practically the only remedy, as it seems to us, was for the plaintiff to assert his title under the license and to prosecute the defendants as infringers. In doing this he does what every plaintiff is bound to do, namely, set forth his title either as patentee, assignee or licensee, and *thereby puts that title in issue.*"

Citing Littlefield *v.* Perry, 21 Wall, 205.

"They, the plaintiffs, certainly had the exclusive right to the use of the patent for certain purposes within this territory. They thus held a right under the patent. The claim is that this right has been infringed. To determine the suit, therefore, it is necessary to inquire whether there has been an infringement, and that involves a construction of the patents. . . . Such a suit may involve the construction of a contract as well as of a patent, but that will not oust the court of its jurisdiction. If *a patent is involved*, it carries with it the whole case."

"While we do not intend to allow the jurisdiction of the Federal Courts to be invoked primarily for the determination of the respective rights of parties to a contract concerning patents, yet when the bill is an ordinary one for an infringement, *and the answer puts in issue the title of the plaintiff to sue*, we think the jurisdiction is not ousted by a mere allegation that the license has been revoked," etc.

c. In the case at bar, the validity of title to copyright is put in issue, both by declaration and by the answer of the defendant.

Damages not provided by statute.

2. U.S. Rev. Stat., Sect. 4965 (relating to copyrights), does not give any action for damages for the piracy of any article therein mentioned and Section 4964 provides such remedy only in case of books, and the plaintiffs frankly admit that this form of action is not expressly given by the statutes of the United States relating to copyrights.

Damages at common law.

3. The plaintiffs (defendants in error here) proceeded upon the recognized principle of statutory construction that where a right, previously existing by the common law, is secured by a statute which provides no remedy for its protection the common law remedies are available, and where the statute prescribes penalties and forfeitures, but does not provide a remedy for damages, the common law action for damages will lie. This rule has been applied in the interpretation of copyright statutes.

Drone on Copyright, pp. 473, 493, 494.
Sutherland on Statutory Construction, p. 509.

Text writers.

a. This construction of our law is favored by the text writers.

Drone on Copyright, p. 473.
Am. & Eng. Ency. of Law, 2 Ed., Vol. 7, pp. 592–593.
Curtis on Copyright, p. 313.
Copinger Law of Copyright, pp. 247–252.
Slater on Copyright, pp. 168, 169.

The defendant (plaintiff in error here) will probably cite to the contrary MacGillivray, "Law of Copyrights," p. 290, the language being: "In respect of maps, musical and dramatic compositions, works of art, etc., there is no right of action to recover damages merely as such; the remedy is limited to the prescribed forfeiture and penalties." In this connection MacGillivray is treating of statutory rights, and his language as applied to United States statutes is correct. His language, however, does not purport to apply to common law remedies, hence has no bearing on the case at bar. The

whole chapter deals with the American statutes. The cases cited are Thornton *v.* Schrieber, 7 How. App. 614, and Springer *v.* Folk, 20 U.S. App. 296, both of which deal with rights under the statute and not with the "Common Law Rights or Remedies."

English cases.

b. This rule was admirably stated by Lord Kenyon in 1798 in the case of Beckford *v.* Hood, 7 T. R. 620. Beckford v. Hood.

This was an action on the case. The declaration contained two counts. Defendant pleaded general issue, and on trial the jury found a verdict for the plaintiff subject to the opinion of the Court on the following case.

The plaintiff is the author of the book entitled "Thoughts upon Hunting," and in May, 1781, published the first edition without any name prefixed. In 1782 he published a second edition, and in 1784 a third edition with his name prefixed to the title-page. Neither the original nor the subsequent editions were ever entered in Stationers' Hall as required by statute. In August, 1796, the defendant published the same work under the title of "Thoughts upon Hare and Fox Hunting," with the plaintiff's name prefixed to the title-page.

Reader for plaintiff. Admitting that since the case of Donaldson *v.* Becket an author cannot after publication of his works set up a common law right to the exclusive printing and republishing of it, yet such a right is expressly vested in him by the Stat. 8 Anne, Chap. 19, for the term therein specified, which is not yet expired in the present case. The first section of that act, after reciting that printers and others have taken the liberty of publishing books, etc., enacts that the author of any book already printed who has not transferred to any other the copy of such book, etc., or the persons who have acquired or purchased the same, *shall have the sole right and liberty* of printing such book, etc., for twenty-one years and no longer, and that the author of any book not published and

his assigns *shall have the sole liberty of printing and reprinting* such book for fourteen years, to commence from the day of first publishing the same and no longer. It then proceeds to affix the penalties for transgressing the law. By this act, therefore, the property in literary works is exclusively vested in the authors for the period assigned, independently of the penalties which are afterwards inflicted on those who infringe the property, and the maxim of law attaches that the law confers no right without a remedy to secure it, which in this instance can only be an action on the case for damages, etc. Secondly: It is true that the second section of the act requires that an entry be made in Stationers' Hall, but only in order to subject a defendant to the forfeitures and penalties of the act; but it is only necessary for that purpose.

Lord Kenyon, C.J.: "All arguments in support of the rights of learned men in their works must be heard with great favor by men of liberal minds to whom they are addressed. It was probably on that account that when the great question of literary property was discussed some judges of enlightened understanding went the length of maintaining that the right of publication vested exclusively in the authors and those who claimed under them for all time, but the other opinion finally prevailed, which established that the right was confined to the times limited by the act of Parliament. And that I have no doubt was the right decision. Then the question is whether, the right of property being vested in authors for certain periods, the common law remedy for a violation of it does not attach within the times limited by the act of Parliament. Within those periods the act says that the author *shall have the sole right and liberty* of printing, etc. Then, the statute having vested the right in the author, the common law gives the remedy by action on the case for the violation of it. Of this there could have been no doubt made if the statute had stopped there. But it has been argued that, as the statute

in the same clause that creates the right has prescribed a particular remedy, that and no other can be resorted to. And if such appeared to have been the intention of the legislature, I should have subscribed to it however inadequate it might be thought.

"But their meaning in creating the penalties in the latter part of the clause in question certainly was to give an accumulative remedy; nothing could be more incomplete as a remedy than those penalties alone, for without dwelling upon the incompetency of the sum the right of action is not given to the party aggrieved, but to any common informer.

"I cannot think that the legislature would act so inconsistently as to confer a right and leave the party whose property was invaded without redress. But there was good reason for requiring an entry to be made at Stationers' Hall, which was to serve as a notice and warning to the public that they might not ignorantly incur the *forfeitures or penalties* before enacted against such as pirated the works of others, but calling on a party who has injured the civil property of another for a remedy in damages cannot properly fall under the description of a *forfeiture or penalty*. Some stress was attempted to be laid on the acts passed for preserving the property of engravers in their works, in which a special provision is made to meet such a case as the present and to give the same right of action as is here contended for. But it is well known that provisions of that kind are frequently inserted in acts of Parliament. On the fair construction of this act, therefore, I think it vests the right of property in the authors of literary works for the times therein limited, and that consequently the common law remedy attaches if no other be specifically given by the act, and I cannot consider the action given to a common informer for the penalties which might be pre-occupied by another as a remedy to the party grieved within the meaning of the act."

Ashhurst, J., Grose, J., and Lawrence, J., concurring.

Postea to the plaintiff.

Prior to this time (1792) an action on the case for damages by the assignee of a copyright has been sustained.

Thompson v. Symonds.

Thompson *v.* Symonds, 5 T. R. 41.

The opinion of the Court was given by Grose, J., who said: "When the print was originally published the requisites of the statutes were complied with. Then the exclusive right was vested in Bowyer, and the instant he assigned to the plaintiff the latter had every right that Bowyer had before. This short title is stated in the declaration and that defendant pirated it, all of which was proved, and consequently the plaintiff has a good cause of action."

Cadell v. Robertson.

Cadell *v.* Robertson, Paton's Appeal Cases, Vol. 5, p. 493, July 11, 1811.

This was a case of an interdict and action for damages brought by the appellants, in right to the copyright of the works of Burns the poet, which, after the publication of Dr. Currie's edition, had been pirated and published by the respondent. The book had not been entered at Stationers' Hall, and the Court of Session held that the only protection lay in the statutory penalties, and if the book was not entered in Stationers' Hall no action was competent at common law for indemnification or protection. In the House of Lords this judgment was reversed by a special declaration, stating that though the work was not so registered, yet that the parties had for the time specified in the statute a right vested in them entitling them to maintain a suit for damages, and also to interdict in case of the violation of that right.

Beckford *v.* Hood was cited with approval.

Roworth v. Wilkes.

In Roworth *v.* Wilkes, 1 Camp. 94, where a part of a book had been pirated, Lord Ellenborough said: "I have always acted on the case of Beckford *v.* Hood, in which the Court of King's Bench held that an author whose work is pirated may maintain an action on the case for damages, although the work was not entered at Stationers' Hall and

although it was first published without the name of the author affixed."

In Sheriff *v.* Coates, 1 Russ & M. 159, the Court held that "Equitable jurisdiction upon 54 G. 3 c. 23 is not excluded by the special remedy therein provided. Independent of that remedy the statute vests in the inventor a right of property which equity . . . will protect by injunction." Sheriff *v.* Coates.

See also Tennyson *v.* Forrester, 43 Scottish Jurist, 278, 1871.

c. Courts of Canada have followed the English decisions. Canadian cases.

Bernard *v.* Bertoni, 14 Quebec, 219. Bernard *v.* Bertoni.

This is an action for $500 damages. The plaintiffs allege that a sculptor named Dunbar made a bust of Cardinal Taschereau, had his copyright duly recorded at Ottawa, and assigned it to them. Defendants made copies, etc. The Court: "The defendant's first plea and contention at bar is that this is an action for damages at common law. That no such action lies. That the only remedy that the plaintiffs have is the action for penalty under the copyright act. I think this defence unfounded. I am of opinion that property in works of art, such as the bust in question, is recognized by our common law, and that a trespass upon it gives rise to a claim for damages. The rule that the ordinary remedy is not taken away because a special one is given by statute therefore applies, and I hold the action to be well brought."

d. With the exception of the decision in this action (140 F. R. 305) no United States case has been found bearing directly upon this rule. It has been held that the passage by Congress of the copyright statutes has not abrogated the common law right of an author to his unpublished manuscript. U.S. cases.

Press Pub. Co. *v.* Monroe, 38 U.S. App. 410 (73 F. R. 196, 199).

NOTE. — The manuscript in question was a poem prepared for the World's Fair at Chicago. The case arose in the Circuit Court of Appeals, Second Circuit, 1896.

Walker et al. v. Globe Newspaper Co.

It is said, however, by Putnam, J., in giving the decision of the Circuit Court of Appeals for the First Circuit above referred to: "Meanwhile, it is plain from Atwill *v.* Ferrett, 2 Blatch. 39, 40, 41, 47, 48 (1846), that suits at common law for infringements of copyrights were advised and brought by the legal profession, and that, in the opinion of judges of such unquestioned experience and ability as Mr. Justice Nelson and Judge Betts, such suits might be maintained if laid in case, which is the substance of the suit at bar, and its form so far as under the Massachusetts Practice Act a question of form of that character can arise."

Walker *et al. v.* Globe Newspaper Co., Ibid., p. 317.

Mr. Justice Putnam further says on page 308: "The property right being established, the common law remedies attach whether the right arises out of the common law or under a statute, unless there is something in the statute to the contrary."

At page 312 of the same opinion the following language appears: "Dealing thus with the act of 1790, it seems to us the conclusion is clear that its second section did not exclude any suitable remedy, either according to the course of equity or of the common law. The corresponding provisions of the Revised Statutes, Sections 4952 and 4965, as we have seen, are in substance the same as those of the statute of 1790, and are only parts of a general codification. It is true, as we have said, that there are amendatory acts with reference to remedies. So far as copyrighted maps are concerned, all there is in that direction is the statute of 1819, already referred to, now found in Section 4970 of the Revised Statutes. This names a bill in equity in the usual course. The result of that is merely an injunction against future infringements, and an account of profits."

After an exhaustive discussion of the various enactments of Congress relative to copyright Mr. Justice Putnam con-

cludes that the original Copyright Act of 1790 did not prevent the owner of a copyright to protect his title by all the means known to the general rules of law, and that this rule has not been modified by subsequent legislation.

*e*1. The foregoing principle of statutory construction is now elementary and is as old as the common law. Statutory construction.

Lord Coke said (2 Inst. 200): "It is a maxim in the common law that a statute made in the affirmative without any negative expressed or implied doth not take away the common law."

In Arthur *v.* Bokanham, 11 Mod. 148, it was said: "The general rule in the exposition of all acts of Parliament is this — that in all doubtful matters, and where the expression is in general terms, they are to receive such a construction as may be agreeable to the rules of the common law in cases of that nature, for statutes are not presumed to make any alteration in the common law further or otherwise than the act does expressly declare, and therefore in all general matters the law presumes the act did not intend to make any alteration, for if the Parliament had had that design they would have expressed it in the act."

Kent says (1 Kent's Com., Sect. 464, 14th Ed.): "Statutes are likewise to be construed in reference to principles of the common law, for it is not to be presumed that the legislature intended to make any innovation upon the common law further than the case absolutely required. *This has been the language of the Courts in every age*, and when we consider the constant, vehement, and exalted eulogy which the ancient sages bestowed upon the common law as the perfection of reason and the best birthright and noblest inheritance of the subject, we cannot be surprised at the great sanction given to this rule of construction."

Black on Interpretation of Laws, p. 233, says: "Again, the common law must be allowed to stand unaltered as far as is consistent with a reasonable interpretation of the new law."

Lewis' Sutherland Statutory Construction, 2d Ed., pp. 861, 862, uses this language: "When a statute gives an action it does not abrogate a common law remedy unless made exclusive." It is not presumed that the Legislature intended to make any innovation upon the common law further than the necessity of the case required.

Hardcastle on Statutory Law, page 310, says: "Thus if a statute provides a new remedy for infringing a common law right, and the new remedy is not at variance with the previous common law remedy, a person may elect whether to proceed in the way pointed out by the statute or by common law."

The case of Greenwood *v.* Greenwood, 28 Md. 369, was an action by a father for the seduction of his daughter, under twenty-one years of age. Daughter, who was nineteen years of age, was working out at time of seduction. It was contended that the legislation of the State had changed the common law, and that a female was to be considered as of full age so as to be entitled to her own services, free from any legal control or restraint by her father, at the age of eighteen years. The language of the code reading: "Any father may bind out his child as an apprentice on reasonable terms for any time not longer than the full age of such child — that is to say, boys till twenty-one and girls till *eighteen years of age*."

Court: "As a rule of exposition, statutes are to be construed in reference to the principles of the common law. For it is not to be presumed that the legislature intended to make any innovation upon the common law further than the case absolutely required. The law rather infers that the act did not intend to make any alteration other than what is specified and besides what has been *plainly pronounced*," etc.

In Balant *v.* Brown, 78 Mich. 294, the headnote is: "Giving a statutory action different in form from that at the common law for the same grievance does not abrogate the right to proceed at common law unless the new remedy is declared to be exclusive."

In McRoberts *v.* Lyon, 79 Mich. 25, it was held that "while our statute does not in terms authorize the issuing of a writ of *scire facias* from the Circuit Courts, yet it nowhere forbids it, and it may issue as a common law writ."

In Johnson *v.* Southern Pacific Co., 117 F. R. 462, it was held that "a statute changing the common law modifies or abrogates it no farther than the clear import of its language necessarily requires."

In Shaw *v.* Railroad Co., 101 U.S. 557, 565, the Court said: "No statute is to be construed as altering the common law farther than its words import. It is not to be construed as making any innovation upon the common law which it does not fairly express."

In Ryalls *v.* Mechanics' Mills, 150 Mass. 190 (opinion by Holmes, J.), it was held that the adoption of the Employers' Liability Act did not take away any common law right of action.

The New York courts have laid down the same rule in language exceedingly broad.

Rosin *v.* Lidgerwood Mfg. Co., 86 N.Y. Sup. 49.

See also Cadwallader *v.* Harris, 76 Ill. 370.
Smith *v.* Laatsch, 114 Ill. 271.
Almy *v.* Harris, 5 John, 175.
Edwards *v.* Gaulding, 38 Miss. 118.
Howe *v.* Peckham, 6 How. Pr. 229.
Rice *v.* Railroad Co., 1 Black, 358.
Scaife *v.* Stovall, 67 Ala. 237.
Keech *v.* Baltimore R.R. Co., 17 Md. 32.
Hooper *v.* Mayor, etc., 12 id. 464.

*e*2. The plaintiffs also contend that where a remedy is provided by statute, one having existed at common law, such remedies thereby become cumulative, and the plaintiff may elect between them. "That affirmative statutes do not take away the common law is a maxim of the law itself" (2 Inst. 200). Cumulative remedy.

In Tennyson *v.* Forrester, *supra*, Lord Gifford lays down the rule that "the statute of 1842 recognizes and declares the right of copyright in an author and his assigns in the early clauses of the statute, and that the special remedies which the subsequent clauses provide are cumulative with, and not exclusive of, the remedies competent at common law." "Where a civil right is given or protected, there is a principle pretty generally applicable that the imposition of a penalty is cumulative with and not subversive of the common law remedies of the party wronged. See Rowning *v.* Goodchild, 2 W. Black, 910; Beckford *v.* Hood, 7 T. R. 627; Couch *v.* Steel, 3 Ellis, and Blackburn, 414. Especially is this the case if the penalty in whole or in part is to go to a third party or where it may be sued for and recovered by somebody other than the party wronged."

1 Kent's Com., Sect. 464, 14th Ed., states: "The Court of K. B., in Rex *v.* Robinson, laid down this distinction, that where a statute created a new offence, by making unlawful what was lawful before, and prescribed a particular sanction, it must be pursued and none other, but where the offence was punishable at common law and the statute prescribed a particular remedy, without any negative words, express or implied, the sanction was cumulative and did not take away the common law punishment, and either remedy might be pursued."

Sutherland on Statutory Construction, p. 509, uses the following language: "Statutes affirmative of the right and prescribing other than the usual remedies for its enforcement, or conferring cognizance of it upon other tribunals, not negativing the preëxisting remedies or jurisdiction, in their very nature are merely *cumulative and not exclusive.*"

Mr. Justice Thompson in the case of Wheaton *v.* Peters, 33 U.S. 591, at p. 690, says: "Where a statute gives a remedy, where there was one by the common law, and does not imply a negative of the common law remedy, there will be two concurrent common law remedies. In such case the

statute remedy is accumulative. 2 Bac. 803, 805; 2 Inst. 209; Com. Dig. Action upon Statute, 6."

In Rosin *v.* Lidgerwood Mfg. Co., 86 N.Y. Sup. 49, the Court says that "where a remedy existed at the common law for a wrong or injury against which a remedial statute is directed, if such statute provides a more enlarged or summary or more efficient remedy for the party aggrieved, but does not in terms or by necessary implication deprive him of the remedy which existed at common law, the statutory remedy is considered as merely cumulative, and the party injured may resort to either at his election."

For other authorities and decisions upholding this rule of law, see,

Hardcastle on Statutory Law, p. 312.
Ency. of Law, Vol. 6, p. 270.
People *v.* Craycroft, 2 Cal. 243.
Candee *v.* Haywood, 37 N.Y. 653.
Wetmore *v.* Tracy, 14 Wend. 250, 255, and cases cited.
Clark *v.* Brown, 18 Wend. 213, 220.
Cadwallader *v.* Harris, 76 Ill. 370, 372.
Almy *v.* Harris, 5 John, 175.
Bernard *v.* Bertoni, *supra*.

Damages under Sect. 4964.

4. The damages recoverable under Section 4964 relative to infringement of copyright of books have been construed as in the nature of penalties and forfeitures.

Wheeler *v.* Cobbey, 70 F.R. 487.
See also Walker *et al. v.* Globe Newspaper Co., *supra*, p. 310.

This is an action for damages for infringement of a copyright. Defendant demurred to petition. The case is based upon Sect. 4964, Rev. Stat. It appears that the acts of printing, publishing, etc., were all done more than two years before the present action at law. In support of the

demurrer it was said that an action for damages based upon Section 4964 must be deemed to be in nature of a forfeiture within the meaning of Section 4968.

Held, that the damages recoverable in a civil action based upon Section 4964 are a forfeiture within the meaning of Section 4968, and such an action is barred if brought more than two years after the cause of action arose.

See Daly *v.* Brady, 69 F. R. 285.

Damages in equity.

5. Damages for infringement of copyright cannot be recovered by a bill in equity.

Chapman *v.* Ferry *et als.*, 8 Sawyer, 191.

Bill in equity for an injunction, accounting of sales, damages and surrender of plates, etc. On demurrer.

HEADNOTE. — The penalties and forfeitures given by Section 4965 of the Revised Statutes (17 Stat., 214) for an infringement of a copyright cannot be enforced in a suit in equity, and a prayer in the bill that the plates and unsold copies of a printed map be delivered up to an officer of the Court for cancellation and destruction is demurrable as asking the enforcement of such forfeiture. *Damages* as well as profits may be recovered in a suit in equity for an infringement of a patent, but not a copyright.

Same rule applied to patents until 1870, when the statute was amended (16 Stat., 206; Sect. 4921, Rev. Stat.).

Copyright statute does not create new right.

6. The right of literary property rests upon the common law. The statute "is the securing of an existing right and not the creation of a new one for which it makes provision. A corollary to this proposition is that the law shall liberally protect and not fetter, hamper, or by possibility defeat, the right."

Our Archaic Copyright Laws, by Samuel J. Elder, p. 8.

The Constitution of the United States, Article I., Section *VIII.*, reads as follows:

"To promote the progress of science and useful arts by *securing* for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

7. In the opinion of Hale, J. (Record, p. 11), the following language appears: Only adjudication in U.S.

"It will thus be observed, then, that in this great case (Wheaton *v.* Peters, *supra*) the Supreme Court has fully passed on all questions of common law rights under the copyright law. . . . We must therefore come to the conclusion that the courts of this country have long ago passed adversely upon the right to bring a common law action under the section of the copyright law which is now before us" (Section 4965).

A close inspection of the above-named case leads us to the conclusion that Mr. Justice Hale confounded the establishment of a *common law right in literary property* with the application of a *common law remedy*, the right having been established by a compliance with the Copyright Statutes of the United States. Wheaton v. Peters.

In the case at bar the defendants in error allege that they have complied with all the provisions of the statute and have obtained a copyright of the map described in their declaration. Their rights as thus secured to them by Section 4952 of the Revised Statutes of the United States have been infringed by the plaintiff in error and they ask for damages. The statute is silent as to the question of damages. The real question is, Are common law *remedies*, not rights, available?

In Wheaton *v.* Peters, the plaintiffs having failed, as the defendants claimed, to comply with the statutes in respect to the publication of notice and the deposit of a copy of their publication with the Secretary of State as was then required, sought to establish at common law an exclusive right to

print, publish and sell Wheaton's Reports. The case came before the Supreme Court of the United States on appeal from the Circuit Court of the United States for the Eastern District of Pennsylvania. The proceeding was a bill in equity in which the complainants prayed for an injunction to restrain the defendants from publishing and selling a volume called "Condensed Reports of Cases in the Supreme Court of the United States," it being complained that the defendants' publication contained Wheaton's Reports. The defendants in their answer denied that their publication was an infringement of the plaintiffs' rights, and also stated that the plaintiffs had not complied with the provisions of the statutes relating to copyrights and had no valid copyright. The decision was rendered in 1834, the majority opinion being written by McLean, J., who said (on p. 653): "The complainants assert their right on two grounds: First, under the common law; second, under the acts of Congress." The opinion declared that there was no federal common law as distinct from the common law of the several States; that whether or not the complainants had any right at common law of Pennsylvania depended upon whether or not Pennsylvania had adopted the common law of England; that the State of Pennsylvania had not adopted the common law of England relative to the exclusive right of an author to his literary productions after publication. The case was remanded to the Circuit Court to have the question of whether or not the plaintiffs had complied with the provisions of the copyright statutes of the United States tried by a jury.

We therefore confidently but respectfully assert that in Wheaton *v.* Peters the Supreme Court did not fully pass upon all the questions of common law raised by the case at bar, and that the Supreme Court has never yet passed upon the fundamental question, viz.: Are the common law remedies available for the protection of the copyright of a map secured to the author, etc., by the statutes of the United States?

8. *a*. The plaintiff in error contends that the common law remedies are not available in the case at bar. The defendants in error do not deny the rule that there is no common law of the United States as contra distinguished from the individual State, and the courts of the United States, instead of administering the common law or any particular system, conform to the law of the State where the controversy originated. It is now well settled that the courts of the United States adopt the statutory or common law of the State where the cause of action arose, and, so far as the remedy is concerned, the statutory or common law of the State where the litigation is pending. Federal Common Law.

Walker *et al. v.* Globe Newspaper Co., *supra*, p. 308.

In Murray *v.* North Western Railway Co., 62 F. R. 24, the question at issue was the discrimination in rates on shipments of cattle from Belle Plaine, Iowa, to Chicago. Here the defendant urged that it was a corporation engaged in interstate commerce; that there was no national common law by which it could be controlled in the matter of rates, and as there was no act of Congress at that time governing the same the Court was without jurisdiction. But the Court held that there was a federal common law which regulated it in the matter of rates, and proceeded to hold the railroad company liable in damages for unjust discrimination. Murray v. N.W.R.R.

At page 26 (1894) Shiras, J., says: "It will not be questioned that before the Revolution the common law was in force, so far as applicable, in the several colonies then existing. . . . The adoption of the Constitution did not deprive the people of the several colonies of the protection and advantages of the common law. The Constitution itself recognizes the continued existence of the common law, and indeed it is based upon the principles thereof, and its correct interpretation requires that its provisions shall be read and construed in the light thereof."

This decision was affirmed on appeal in 1899 in 92 F. R., p. 869, where Caldwell, J., at p. 870, says: "For more than a century the federal courts, in the absence of a statute or other obligatory rule of decision, have had recourse to the common law for rules of decision in the trial of causes in those courts, and have, in cases where the law furnished an appropriate rule of decision, rested their judgments upon it. The same may be said of the admiralty law, the law merchant, the principles of equity jurisprudence, and in a restricted and qualified sense of the civil law. It never was supposed that the federal courts were denied the privilege of resorting to any or all of these sources of information for the purpose of enlightening their judgment upon any question presented for their determination in the trial of a cause. It has always been assumed that the federal courts were endowed with a power and jurisdiction adequate to the decision of every cause and every question in a cause presented for their consideration, and of applying to their solution and decision any rule of the common law, admiralty law, equity law, or civil law applicable to the case, and that would aid them in reaching a just result, which is the end for which courts were created."

Judge Brewer in Western Union Tel. Co. *v.* Call Pub. Co., 181 U.S. 92, 101, decided in 1900, says: "There is no body of federal common law separate and distinct from the common law existing in the several States in the sense that there is a body of statute law enacted by the several States. But it is an entirely different thing to hold that there is no common law in force generally throughout the United States."

Western Union Tel. Co. v. Call Pub. Co.

This case was begun in the State courts of Nebraska by the Call Pub. Co. against the Western Union Tel. Co. for damages for a discrimination in rates for Associated Press Reports.

The defendant (Western Union Tel. Co.) contended that the services rendered to the plaintiff were matters of inter-

state commerce; That Congress has sole jurisdiction of such matters and can alone prescribe rules and regulations therefor; that Congress had failed to make such rules and regulations; that there was no national common law; that the statutes and common law of Nebraska did not apply, and that therefore the State Court erred in holding the Telegraph Company liable for the alleged discrimination. The judgment of the lower court was affirmed by the Supreme Court of Nebraska. Upon removal to the federal courts the judgment of the State Court was finally affirmed by the Supreme Court of the United States. In arriving at its decision, the Supreme Court of the United States applied the common law of Nebraska.

Mass. common law.

b. The constitution of Massachusetts (adopted 1780) declared that "all laws which have heretofore been adopted, used, and approved in the colony, province, and State of Massachusetts Bay, and usually practised in the courts of law, shall still remain and be in full force until altered or repealed by the legislature, such parts only excepted as are repugnant to the rights and liberties contained in this constitution."

Shaw, C.J.: "This constitution has been construed as adopting the great body of the common law with those statutes made before the emigration of our ancestors, which were made in amendment of the common law, so far as these rules and principles were applicable to our condition and form of government."

Com. *v.* Churchill, 2 Met. 118, 123, citing
Com. *v.* Leach, 1 Mass. 59, and
Com. *v.* Knowlton, 2 Mass. 534.

It is not necessary in order to show that a principle or rule of the common law had been adopted, etc., to show that such principle or rule had been adjudicated before the constitution went into operation.

Com. *v.* Churchill, *Ibid.*

This case is cited with approval in

Tyler *v.* Sturdy, 108 Mass. 196.
Presbrey *v.* Presbrey, 13 Allen, 281.

Dana, C.J., in Commonwealth *v.* Leach, *supra*, said (at p. 60): "The term 'common law' ought not to be construed so strictly as is contended for by the counsel for defendant. Generally when an English statute has been made in amendment of the common law of England it is here to be considered as part of our common law. For instance, the Statute of 7 James I., Chap. 5, and 21 James I., Chap. 12, giving double costs to an officer who is sued out of his county for anything done by him in the execution of his office, being made in amendment of the common law, is adopted here, and is part of our common law. So also the Statute of Anne respecting negotiable notes."

Holmes, J., in Richards *v.* Barlow, 140 Mass. 218, 220, says: "In the absence of any evidence to the contrary, we must assume that the question whether the note in suit was negotiable is governed by the common law as amended or declared by the Statute of 3 and 4 Anne, Chap. 9."

Commonwealth *v.* Leach, *Ibid*, has been cited with approval many times, and the rule therein laid down touching the common law is to-day the law of this Commonwealth.

See Earle *v.* Wood, 8 Cush. 430, 445.
See also, citing Com. *v.* Leach, *supra:*
Sackett *v.* Sackett, 8 Pick. 316, 319.
Boynton *v.* Rees, 9 Pick. 532.
Going *v.* Emery, 16 Pick. 116.
Burden *v.* Thayer, 3 Met. 78.

Copyright statutes. England.

9. The Statute 8 Anne, Chap. 19, passed in 1709, gave to the author of any book or books already printed the "sole Right and Liberty of printing such Book and Books for the term of one and twenty years," and to the author of any book or books "already composed, and not printed and

published, or that shall hereafter be composed," etc., the "sole Liberty of printing and reprinting such Book and Books for the term of fourteen years." The remedy provided for the infringement of such right being as follows: "that if any other Bookseller, Printer or other Person whatsoever, from and after the tenth day of April, one thousand seven hundred and ten, within the Times granted and limited by this Act as aforesaid, shall print, reprint, or import, or cause to be printed, reprinted, or imported, any such Book or Books, without the Consent of the Proprietor or Proprietors thereof first had and obtained in Writing, signed in the Presence of two or more credible Witnesses; or knowing the same to be so printed or reprinted, without the Consent of the Proprietors, shall sell, publish, or expose to Sale, or cause to be sold, published or exposed to Sale, any such Book or Books, without such Consent first had and obtained as aforesaid; Then such Offender or Offenders shall forfeit such Book or Books, and all and every Sheet or Sheets, being part of such Book or Books, to the Proprietor or Proprietors of the Copy thereof, who shall forthwith Damask and make Waste Paper of them; and further, That every such Offender or Offenders shall forfeit one Penny for every Sheet which shall be found in his, her or their Custody, either printed or printing, published or exposed to Sale, contrary to the true Intent and Meaning of this Act; the one Moiety thereof to the Queen's most Excellent Majesty, her Heirs and Successors, and the other Moiety thereof to any Person or Persons that shall sue for the same, to be recovered in any of her Majesty's Courts of Record at Westminster, by action of Debt, Bill, Plaint or Information, in which no Wager of Law, Effoin, Privilege or Protection, or more than one Imparlance shall be allowed."

Relying upon this statute for his right, the plaintiff in the case of Beckford *v.* Hood, *supra*, sought to recover damages at law for its infringement. The Court allowed such

damages, although penalties and forfeitures were provided by said statute for such infringements.

Canada. The Revised Statutes of Canada, 1886, Vol. I., Chap. 62, Sect. 31, reads as follows: "Every person who, after the registration of any painting, drawing, statue, or other work of art, and within the term or terms limited by this act, reproduces in any manner, or causes to be reproduced, made, or sold, in whole or in part, any copy of any such work of art, without the consent of the proprietor, shall forfeit the plate or plates on which such reproduction has been made, and every sheet thereof so reproduced to the proprietor of the copyright thereof; and shall also forfeit for every sheet of such reproduction published or exposed for sale, contrary to this act, such sum, not exceeding one dollar and not less than ten cents, as the Court determines, which forfeiture shall be enforceable or recoverable in any court of competent jurisdiction; and a moiety of such sum shall belong to Her Majesty for the public uses of Canada, and the other moiety shall belong to the lawful owner of such copyright. 38 V., Chap. 88, Sect. 12."

The case of Bernard *v.* Bertoni, *supra*, decided in 1888, was brought in like manner as Beckford *v.* Hood, relying upon this statute for the right and seeking damages at law for its infringement. The Court allowed such damages, using the following language in its opinion: "The rule that the ordinary remedy is not taken away because a special one is given by statute therefore applies, and I hold the action to be well brought."

The defendants in error in the case at bar, having complied with all the requirements of the statute and having obtained a copyright, have relied upon the copyright law of the United States for their *right* and, as in the two preceding cases, seek their *remedy* for its infringement at common law.

United States. The Revised Statutes of the United States, Section 4952, provide that "the author, inventor, designer, or proprietor

of any book, map, chart, etc., and the executors, administrators, or assigns of any such person shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same, etc." Section 4965 provides penalties and forfeitures, in case of the infringement of the copyright of a map, as follows: "If any person, after the recording of any map, chart, etc., as provided by this act, shall, within the term limited, contrary to the provisions of this act, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, engrave, etch, work, copy, print, publish, dramatize, translate, or import, either in whole or in part, or by varying the main design, with intent to evade the law, or, knowing the same to be so printed, published, dramatized, translated, or imported, shall sell or expose to sale any copy of such map or other article, as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied, and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale, and in case of a painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his possession or by him sold or exposed for sale, etc. One-half of all the foregoing penalties shall go to the proprietors of the copyright and the other half to the use of the United States."

The English and Canadian cases cited have relied for their rights upon statutes which provide practically the same penalties and forfeitures as the United States statute, upon which the plaintiffs in the case at bar have relied for their *right*.

Irrespective of these penalties and forfeitures provided by the statutes, the courts have held in the English and Canadian cases that since the statutes provide no remedy in an

action at law for damages, the common law remedies are available. The defendants in error in the case at bar, relying upon the United States Statute, Section 4952, for their *right*, seek their *remedy* at common law in the form of damages.

Remedy.

10. The plaintiff in error published a copy of the map of the defendants in error in a single issue of its paper. Immediately upon publication substantially the whole issue was distributed. When the infringement was brought to the attention of the defendants in error no substantial number of copies could be "found in the possession" of the plaintiff in error. Equity furnished no relief, for the purpose of the plaintiff in error had been accomplished. If this action cannot be maintained, then a copyright of a map affords the map-makers of this country no protection as against the publishers of newspapers. Are the defendants in error without a remedy?

That the law confers no right without a remedy to secure it is a maxim of the law.

Beckford *v.* Hood, *supra.*
Ency. of Law, Vol. 11, p. 179.
1 Pom. Eq. Jur. (2 Ed.), Sect. 423.
Miller *v.* Jefferson College, 5 Smed. & M. (Miss.), 661.
Stanley *v.* Earl, 5 Litt. (Ky.), 282.
Robinson *v.* Steamboat Red jacket, 1 Mich. 175.

II.

Decision in 140 F. R. 305 Controls.

The defendants in error further contend that the decision of the Circuit Court of Appeals for the First Circuit (140 F. R. 305) controls the question raised by the Assignment of Error.

1. The statute (26 Stat. at L. 827, Sect. 5) provides that "Appeals or writs of error may be taken from District Courts or from the existing Circuit Courts direct to the Supreme Court in the following cases: In any case in which the jurisdiction of the Court is in issue; in such cases the question of jurisdiction alone shall be certified to the Supreme Court from the Court below for decision." 26 Stat. at L. 827, Sect. 5.

2. *a.* It has been held that the Circuit Courts of Appeals have no jurisdiction over appeals and writs of error where the only assignments of error are jurisdictional questions. Interpretation.

The Annie Faxon, 87 F. R. 961.
Davis & R. Mfg. Co. *v.* Barber, 60 F. R. 465.

b. Where, however, the assignments include other errors, it has been held that the Circuit Courts of Appeals can determine the whole case, including the question of jurisdiction.

The Alliance, 70 F. R. 273.
U.S. *v.* Sutton, 47 F. R. 129.
Cabot *v.* McMaster, 65 F. R. 533.

c. And that it may certify the jurisdictional question to the United States Supreme Court, which will then consider it.

Rust *v.* United Water Works Co., 70 F. R. 129.
Amer. S. R. Co. *v.* Johnston, 60 F. R. 503.
U.S. *v.* Jahn, 155 U.S. 109.

d. Circuit Courts of Appeals have jurisdiction over questions touching the jurisdiction of the Circuit Courts, unless the issue has been made in the Court below and certified to the Supreme Court.

Cabot *v.* McMaster, 65 F. R. 533, 534.
Limited in King *v.* McLean, 64 F. R. 325, 327.

e. The provisions of the statute permit in the alternative, two methods of procedure to bring before the United States Supreme Court the question of jurisdiction, namely:

(1) To have the question certified from the Circuit Court direct to the Supreme Court.

(2) To carry the whole case to the Circuit Court of Appeals and the question of jurisdiction then certified by that court to the Supreme Court.

f. When the unsuccessful party wishes to have the judgment or decree reviewed upon jurisdictional grounds and other grounds as well he cannot appeal to both the Supreme Court and the Circuit Court of Appeals.

U.S *v.* Jahn, *supra.*
Columbus Const. Co. *v.* Crane, 174 U.S. 600.

g. Robinson *v.* Caldwell, 165 U.S. 359.

This was an appeal from a decree of the Circuit Court of the United States for the district of Idaho adjudging the plaintiff Caldwell to be the owner of certain land. Defendant was allowed an appeal to this court and also procured an appeal to the Circuit Court of Appeals which determined the case Feb. 4, 1895, in favor of plaintiff, opinion by Mr. Justice Harlan.

HEADNOTE. — "An appeal to this court from the Circuit Court on the ground that the jurisdiction of the Circuit Court is in question cannot be maintained where the appellant has also taken an appeal to the Circuit Court of Appeals and the whole case on its merits has been determined by it, although the construction of a treaty and the constitutionality of an Act of Congress were drawn in question in the Circuit Court; *such case can be taken to this court only upon certiorari* after final decree upon the merits in the Circuit Court of Appeals." Appeal dismissed.

In the case at bar the record shows that an Appellate Court (Circuit Court of Appeals for the First Circuit) has passed upon the question of jurisdiction and the jurisdiction of the Circuit Court for the District of Massachusetts thereby became vested (Record, p. 12).

How can the question be raised again in the same case except by means of certiorari?

3. *a.* In U.S. *v.* Jahn (*supra*) Chief Justice Fuller said: "If the question of jurisdiction is in issue and the jurisdiction sustained and judgment on the merits is rendered in favor of the plaintiff, then the defendant can elect either to have the question certified and come directly to this court or to carry the whole case to the Circuit Court of Appeals and the question of jurisdiction can be certified by that court." Procedure.

In McLish *v.* Ruff, 141 U.S. 661-667, Mr. Justice Lamar said: "The true purpose of the act, as gathered from its context, is that the writ of error or the appeal may be taken only after final judgment except in the cases specified in Section 7 of the act. When that judgment is rendered, the party against whom it is rendered must elect whether he will take his writ of error or appeal to the Supreme Court upon the question of jurisdiction alone or to the Circuit Court of Appeals upon the whole case; if the latter, then the Circuit Court of Appeals may, if it deem proper, certify the question of jurisdiction to this court."

b. In the case at bar, after final judgment upon demurrer in the Circuit Court, the whole case was carried to the Circuit Court of Appeals (Record, p. 7). The demurrer (Record, p.), raised the question of jurisdiction and that question was passed upon and decided by the Circuit Court of Appeals (Record, p. 12).

See also Walker *et al. v.* Globe Newspaper Co., *supra*.

Effect of judgment on demurrer.

4. *a.* "Judgment on a demurrer to a complaint is as conclusive and binding on the parties to the action as to all matters well pleaded therein, as though it was given on a verdict on an issue arising on a denial of the allegations of the complaint."

Or. Ry. Co. *v.* Or. Ry. & Nav. Co., 27 F. R. 277.

b. It was the duty of the plaintiff in error if it desired to carry the question of jurisdiction to this court to request said Circuit Court of Appeals to certify the question of jurisdiction.

U.S. *v.* Jahn, *supra*.
McLish *v.* Ruff, *supra*.

Waiver.

5. Not having availed itself of the right given it by the statute it must be deemed to have waived such right and to have elected to have the question of jurisdiction finally determined by said Circuit Court of Appeals.

No. Pa. R. Co. *v.* Amato, 144 U.S. 465.

Laches.

6. At least the neglect of the plaintiff in error amounts to laches upon its part.

Needless expense and delay.

7. The plaintiff in error by seeking a review by proceeding as it has, is causing needless expense and delay.

In McLish *v.* Ruff, *supra*, the Court states that "From the very foundation of our judicial system the object and policy of the Acts of Congress in relation to appeals and writs of error have been to save the expense and delay of repeated appeals in the same suit, and to have the whole case and every matter in controversy in it decided in a single appeal."

Trial justice controlled by 140 F. R. 305.

8. The trial justice in denying the motions made by the plaintiff in error during trial (Record, pp. 16, 17) did so on the ground that he was controlled by the decision of the Circuit Court of Appeals for the First Circuit (140 F. R. 305), (Record, p. 19).

The plaintiff in error raised the question of jurisdiction by his demurrer to the declaration of the defendant in error. The demurrer was sustained by the Circuit Court and judgment entered accordingly. The case was taken to the Circuit Court of Appeals and the judgment of the Circuit Court reversed. Both the Circuit Court and the Circuit Court of Appeals passed upon the question of jurisdiction. The decision of the Circuit Court of Appeals was final and binding upon the Court at the time of trial before the jury. What right had the plaintiff in error to raise the question of jurisdiction when it had already been adjudicated by the same court in the same case ?

Jurisdiction of Appellate Court; how raised.

9. Want of jurisdiction of the Appellate Court may be raised by motion to dismiss.

Foster's Federal Practice, Sect. 512.
Hayes *v.* Fischer, 102 U.S. 121.

But Waite, C.J., in Hilton *v.* Dickinson, 108 U.S. 165, 168, said: " . . . if on looking into a record we find we have no jurisdiction, it is our duty to dismiss on our own motion without waiting the action of the parties."

See also New Orleans Nat. Banking Ass'n. *v.* New Orleans Mut. Ins. Ass'n, 102 U.S. 121.

Power not jurisdiction.

10. The right of the Court to allow an action for damages involves their *power* to grant such a remedy rather than their *jurisdiction* over the entire case.

See Van Wagenen *v.* Sewall, 160 U.S. 369, 373.

The plaintiff in error in its said several motions states that the "act makes no provision for a civil action" (Record, pp. 16, 17, 18). By this the question of jurisdiction is not primarily raised but rather of the power of the Court to exercise a jurisdiction already vested.

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